TRANSCRIPT OF RECORD.

SUPREME COURT OF THE UNITED STATES.

OCTOBER TERM, ~~1922.~~ 1923

No. ~~918.~~ 257

THE UNITED STATES OF AMERICA *EX RELATIONE* THE BALDWIN COMPANY, APPELLANT,

vs.

THOMAS E. ROBERTSON, AS COMMISSIONER OF PATENTS, AND R. S. HOWARD COMPANY.

APPEAL FROM THE COURT OF APPEALS OF THE DISTRICT OF COLUMBIA.

FILED MARCH 22, 1923.

(29,468)

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1 **Caption.**

COURT OF APPEALS OF THE DISTRICT OF COLUMBIA.

No. 3854.

THOMAS E. ROBERTSON, as Commissioner of Patents, and R. S. HOWARD COMPANY, Intervener, Appellants,

vs.

UNITED STATES OF AMERICA ex Relatione THE BALDWIN COMPANY.

Supreme Court of the District of Columbia.

In Equity.

No. 39010.

UNITED STATES OF AMERICA ex Relatione THE BALDWIN COMPANY, Plaintiff,

vs.

THOMAS E. ROBERTSON, as Commissioner of Patents, and R. S. HOWARD COMPANY, *Intervener*, by leave of Court, Defendants.

UNITED STATES OF AMERICA,
District of Columbia, ss:

Be it remembered, That in the Supreme Court of the District of Columbia, at the City of Washington, in said District, at the times hereinafter mentioned, the following papers were filed and proceedings had, in the above entitled cause, to wit:

Supreme Court of the District of Columbia.

Equity. No. 39010.

[Title omitted.]

Amended Bill of Complaint.

[Filed October 13, 1921.]

Now comes plaintiff The Baldwin Company, by leave of Court first had and obtained, and files this its amended bill of complaint
2 in the above cause, and for cause of action respectfully shows unto this Honorable Court, and alleges as follows:

1. Plaintiff, The Baldwin Company, is a corporation of the State of Ohio, having its principal place of business at Cincinnati, in said

State, and brings this suit in its own right and on its own behalf for the matters and things hereinafter set forth.

Defendant, Thomas E. Robertson is Commissioner of Patents and is sued herein because of certain acts and things threatened to be undertaken and done by him by virtue of the powers of his office and in course of the alleged performance of his duties as Commissioner of Patents.

R. S. Howard Company, Intervenor herein by virtue of its own motion, is named and sued herein as a party defendant because permitted, by order of this Honorable Court passed in this cause on the 27th day of May, A. D. 1921, to intervene in this cause with like effect as if named in the original bill as a party defendant.

2. Plaintiff is owner of a certain Trade Mark Registration for Pianos, being numbered 46,993 and dated October 17, 1905, consisting of the word "Howard" printed or impressed in a particular and distinctive manner, that is, in old English letters, and is also the owner of a certain other Trade Mark Registration for Pianos numbered 31,411 and dated March 8, 1898, consisting of the word "Howard" accompanied by the initials V. G. P. Co. arranged in a monogram,—the word "Howard" therein likewise being written or impressed in a particular and distinctive manner,—that is, in old English letters. Certificates of Registration of each of said trade marks were duly issued by the United States Patent Office on the several dates above written and plaintiff The Baldwin Company is the sole owner both of such certificates of Registration and of each of said trade marks so registered.

3. During the year 1896 predecessors in business of plaintiff The Baldwin Company who subsequently became its assignors, in a department of their manufactory specially set aside for such purpose, began the manufacture of high-grade, medium-priced, commercial pianos, and on the 15th day of December, 1896, in advance of all others, one or other of such predecessors and assignors adopted, applied and used the name "Howard" written or impressed in a particular and distinctive manner, to wit, in old English letters as shown in said Certificate of Registration as and for a trade mark for such pianos.

Plaintiff and its predecessors and assignors have continuously since said 15th day of December, 1896, conspicuously marked said trade mark "Howard" as so registered upon the fall-board of all such pianos (the fall-board being the front of the piano, or that part of the instrument above the key-board whereon is usually placed the name by which the instrument is known), and stenciled such trade mark as so registered and shown upon the piano boxes in which such pianos have been and are sold and shipped both in interstate and foreign commerce.

3 The trade mark consisting of the word "Howard" printed or impressed in old English letters as registered in the United States Patent Office became at once and has continued ever since to be of great value as identifying pianos so marked to be the product of The Baldwin Company and of its predecessors, and from said De-

cember 15, 1896, to the present time The Baldwin Company and its predecessors in business have continuously used the word "Howard" as so printed or impressed and registered as a trade mark in connection with the sale of its pianos, and is still so using the same, whereby the trade mark "Howard" as so registered has served and still serves to indicate the origin and primary ownership of pianos manufactured and sold by plaintiff and its predecessors in business, and to distinguish same from the pianos manufactured or sold by any other piano manufacturer or dealer.

4. At the date of the adoption by plaintiff's predecessors in business of said word "Howard" so distinctively printed as a trade mark as aforesaid, no other person, firm, corporation or association engaged in the business of manufacturing, selling or dealing in pianos, was using the name "Howard" in any respect as a trade mark, trade name or designation for the purpose of distinguishing their pianos from those of other manufacturers or dealers, and plaintiff's predecessors had the legal right to appropriate and use the word "Howard" when written or impressed in a particular and distinctive manner as aforesaid as a trade mark for pianos; and The Baldwin Company as successor in business has the exclusive right to use the word "Howard" when written or impressed in a particular and distinctive manner—to wit, in old English letters—as its lawful trade mark for pianos manufactured and sold by it.

5. Plaintiff and its predecessors in business have invested and expended large sums of money for the purpose of introducing to the public pianos bearing its trade mark "Howard," so registered as aforesaid, and making the manufacture and sale of pianos so marked and identified profitable; and its said trade mark "Howard" as registered has been of great benefit and advantage to plaintiff, the trade and the public for the purpose of indicating the origin and primary ownership of pianos manufactured and sold by the plaintiff and its predecessors in business.

The gross sales of said pianos bearing said trade mark "Howard" during the past five years have aggregated more than one million dollars annually, and there are now many thousands of "Howard" pianos, manufactured by plaintiff or its predecessors in business, in use in the United States and in foreign countries, which are and always have been marked upon the fall-board and upon the piano boxes with the word "Howard" written or impressed in the distinctive manner aforesaid. Each and every of such pianos is a continuing advertisement of the type "Howard" pianos heretofore manufactured and sold by plaintiff's predecessors in business, and now manufactured and sold by plaintiff, and the good-will which has been so developed of the business in connection with which the trade mark "Howard" for pianos has been and is used, is of the value of at least one million dollars.

4 6. In August 1914 proceedings were brought in the United States Patent Office by R. S. Howard Company, a corporation of New York, located and doing business in New York City, N. Y., and intervenor herein, to obtain cancellation of said certificate of

registration No. 46,993 dated October 17, 1905, issued to plaintiff The Baldwin Company, and at the same time like proceedings also were brought in said Patent Office by said R. S. Howard Company against The Valley Gem Piano Company in which latter proceeding The Howard Piano Company was substituted and The Baldwin Company was added as defendant, to cancel Certificate of Registration No. 31,411, dated March 8th, 1898, in favor of the Valley Gem Piano Company.

7. While such proceedings for cancellation were still pending in the United States Patent Office a suit in equity was begun in the District Court of the United States for the Southern District of New York by The Baldwin Company as plaintiff against the R. S. Howard Company, which resulted in a final decree which was duly entered in said United States District Court for the Southern District of New York in favor of The Baldwin Company, which said final decree, together with its appropriate journal caption, is in the words and figures following, to wit:

"At a term of the United States District Court for the Southern District of New York held at court rooms thereof, in the Borough of Manhattan, City of New York, on the 23rd day of May, 1916.

"Present: Honorable Charles M. Hough, Judge.

"In Equity.

No. 13-75.

THE BALWIN COMPANY, Plaintiff,

vs.

R. S. HOWARD COMPANY, Defendant.

"This cause came on to be heard at this term, and was argued by counsel; and thereupon, upon consideration thereof it was

"Ordered, adjudged and decreed, as follows, viz:

"First. That the name "Howard" without prefix or suffix, on pianos, or contained in advertisements or otherwise used in connection with pianos, indicates that the pianos bearing or referred to by said name, are the product of the plaintiff, The Baldwin Company, and said name "Howard" distinguishes plaintiff's pianos from the pianos of all other manufacturers; and that the plaintiff, The Baldwin Company, and its predecessors in business, have been ever since December, 1896, and The Baldwin Company now is the true, lawful and sole owner of said word "Howard" as a name for its pianos, and it alone is entitled to use the said word (simpliciter) on pianos, or in advertising matter relating thereto.

5 "Second. That the defendant, R. S. Howard Company, has infringed upon and violated the rights of the plaintiff in its

said name "Howard" by threatening to use the said word on pianos not the product of the plaintiff, and by using the same in advertisements and otherwise in connection with the sales of its said pianos, and by placing said name on the back of its pianos.

"Third. That an injunction issue out of and under the seal of this court restraining and enjoining said defendant, R. S. Howard Company, its officers, agents, servants, clerks, employees and workmen, and all persons claiming or holding through or under it or in privity with it, and each and every of them, perpetually and forever from directly or indirectly making or causing to be made, selling or causing to be sold or offering for sale pianos bearing the said word "Howard" and not the product of the plaintiff except with the initials "R. S." or the name "Robert S." prefixed and the word "Company" affixed to said word "Howard" wherever the said word appears on said pianos or boxes or packages containing the same, and from marking or advertising or describing in any manner by said word, pianos not the product of the plaintiff except with the initials "R. S." or the name "Robert S." prefixed to said word and with the word "Company" affixed thereto, in as conspicuous and prominent a manner as the word "Howard," and from marking, advertising or describing pianos manufactured or sold by it with any name or in any manner calculated or liable to confuse or deceive purchasers into the belief that said pianos are the product of the plaintiff.

"Fourth. Plaintiff having waived its rights to recover any profits and damages to which it may be entitled by reason of the aforesaid infringement and violation of its rights, there will be no accounting for profits or damages by the defendant.

"Fifth. That the plaintiff has the right to use the name "The Howard Piano Company" as a name for one of the corporations owned and controlled by it, and it alone is entitled to use the word 'Howard' without prefix or suffix in the name of any company, firm or corporation that manufactures pianos bearing said name; and that the defendant's counter-claim be, and it hereby is, dismissed with costs.

"Sixth. That the plaintiff recover costs from the defendant. C. M. Hough, D. J."

and said decree of said United States District Court for the Southern District of New York on appeal duly prayed for and allowed to the United States Circuit Court of Appeals for the Second Circuit, after full hearing was in all things affirmed, and thereafter The Baldwin Company duly filed in the United States Patent Office a full and complete certified copy of the transcript of the record in said United States District and Circuit Court of Appeals with the result that the Examiner of Interferences first, and later, on appeal to the Commissioner of Patents, held and declared that the adjudication be-

6 tween said The Baldwin Company and said the R. S. Howard Company as evidenced in and by said decree of the United States District Court for the Southern District of New York, duly affirmed as it was by the United States Circuit Court of Appeals

for the Second Circuit, constituted a bar to any favorable action by them or either of them upon the pending applications by the R. S. Howard Company for cancellation of said Certificates of Registration Nos. 46,993 of October 17, 1905, and 31,411 of March 8, 1898, respectively, and therefore said the Commissioner of Patents ordered said pending applications and each of them so filed as aforesaid by said R. S. Howard Company for the cancellation of said registered trade-marks to be dismissed.

8. From such decisions of the Commissioner of Patents appeals were duly prayed by the R. S. Howard Company and allowed to the Court of Appeals of the District of Columbia, and said appeals and the causes to which they appertained were heard together before and by the said Court of Appeals of the District of Columbia, which Court, disregarding the several findings, opinions, conclusions and final decrees of said United States District Court for the Southern District of New York and of the United States Circuit Court of Appeals for the Second Circuit, as the same were in proper manner and method made known to it, and utterly failing and refusing to give full faith and credit thereto as it should have done and as it was and is required to do by the terms of Article IV, Section 1, of the Constitution of the United States, and notwithstanding that it expressly found as matter of fact that the plaintiff herein, The Baldwin Company, was the first to make a trade-mark use of the word "Howard," which fact however it erroneously stated to be "of no importance," said Court of Appeals concluded and held contrary to the actual facts and as plaintiff is informed and believes also contrary to the law and right of the matter, that the registration by The Baldwin Company and its predecessors in interest of said trade-marks involved and constituted a registration of a competitor's (corporate) name, although the true corporate name of the supposititous competitor was and is the R. S. Howard Company,—not "Howard" and, therefore, further held that said registrations had been "Sought and secured in direct violation of the express terms of the Statute,"—to wit, Section 5 of the Trade-Mark Act of February 20th, 1905, as amended March 2, 1907, which, among other things, forbids the registration of a "mark which consists merely in the name of an individual, firm, corporation or association, not written, printed, impressed or woven in some particular or distinctive manner or in association with a portrait of the individual," and thereupon declaring the decision of the Commission of Patents to be reversed, directed the Clerk of said Court of Appeals of the District of Columbia "to certify these proceedings as by law required."

9. To review such conclusions and action of said Court of Appeals of the District of Columbia, The Baldwin Company duly filed its appeals to the Supreme Court of the United States and also prayed allowance of writs of certiorari to be addressed to said Court of Appeals of the District of Columbia, but by an opinion and judgment announced and entered on the 11th day of April, 1921, said Supreme Court of the United States dismissed plaintiff's said appeal for want of jurisdiction and denied plaintiff's petition for writ of certiorari for the reason as stated in its opinion

7

that Section 13 of the Trade-Mark Act of February 20, 1905, as amended, does not authorize the Court of Appeals of the District of Columbia to enter final judgments in cases of such sort which might come before it on appeal from decisions of the Commissioner of Patents; but only authorizes

"the return by the Court of Appeals of a certificate to the Commissioner of Patents, to be there entered of record to govern further proceedings in the case,"

but said Supreme Court of the United States in its said opinion (The Baldwin Company, et al., appellants, vs. R. S. Howard Company, No. 139 O. T. 1920 and The Baldwin Company, Petitioner, vs. R. S. Howard Company, No. 113 O. T. 1920, decided April 11, 1921; Vol. 41, (No. 14) Sup. Court Reporter, 405) further said that

"In Atkins v. Moore, 212 U. S. 285, application for registration of a trademark was refused by the Examiner, which action was approved by the Commissioner and affirmed on appeal by the Court of Appeals of the District of Columbia, an appeal and writ of error were allowed, both of which were dismissed in this court. The previous decisions of this court were reviewed by Chief Justice Fuller, speaking for the court, and in concluding the opinion he said:

'In the light of the various details of the Act of February 20, 1905, and of the specific provisions of Section 9, we were of opinion (Gaines v. Knecht, 212 U. S. 561) that proceedings under the act were governed by the same rules of practice and procedure as in the instance of patents, and the writ of error was accordingly dismissed. The same result must follow in the present case.

'Under Section 4914 of the Revised Statutes no opinion or decision of the Court of Appeals on appeal from the Commissioner precludes 'any person interested from the right to contest the validity of such patent in any court wherein the same may be called in question,' and by Section 4915 a remedy by bill in equity is given where a patent is refused, and we regard these provisions as applicable in trade-mark cases under Section 9 of the act of February 20, 1905."

further and finally declaring that the principle so announced "controls this case."

10. Plaintiff avers that by reason of the issuance of a permanent injunction by the United States District Court for the Southern District of New York, affirmed as it was by the decision of the United States Circuit Court of Appeals for the Second Circuit, both being courts of competent jurisdiction and having jurisdiction both over the subject matter and of the respective parties which restrained the intervening defendant herein "the R. S. Howard Company" from making or selling pianos bearing the word "Howard," without prefix or suffix, said "the R. S. Howard Company" is not damaged and cannot be damaged within meaning of Section 13 of said
8 Trade-Mark Act of February 20, 1905 by the continued registration of the word "Howard" printed or impressed in a

distinct and particular manner as shown in the drawings accompanying and forming part of the applications for registration subsequently allowed as registrations numbered 46,993 dated October 17, 1905, and 31,411, dated March 8, 1898 above referred to and therefore it is without status or standing to justify or support any application by it to the Commissioner of Patents to cancel the registrations in question.

11. Plaintiff, The Baldwin Company, has applied for and obtained registration of the trade-mark "Howard" above described for use in connection with its pianos in a number of foreign countries, such applications and registrations being based on certified copies of said trade-mark No. 46,993, dated October 17, 1905, as registered in the United States Patent Office. In some of such foreign countries title to trade-marks is derived from and based upon registration alone, and the cancellation in the United States Patent Office of the base trade-mark constitutes ground for the cancellation of the same mark in certain of such foreign countries, so that the foreign business of The Baldwin Company which has been built up at considerable expense and is largely based upon registrations of said trade-mark as above described would be seriously threatened and greatly and irreparably injured by the cancellation of either or both of said trade-marks in the United States Patent Office. The R. S. Howard Company could not legitimately derive a direct benefit from the cancellation of either or both of said registered trade-marks should same be cancelled, as the Commissioner of Patents avers he is about to do, inasmuch as said Company cannot use or register the trade-mark for pianos, but citizens of foreign countries in which The Baldwin Company has secured registrations on the basis of the existing registrations in the Patent Office of the United States, if such registrations of marks were cancelled, would be enabled thereby to register the name "Howard" however written or impressed at the instigation and behest of the R. S. Howard Company, and said R. S. Howard Company would thereby be enabled to reap and would reap much of the benefits of the business which plaintiff, The Baldwin Company, has built up at much expense in such foreign countries;

Wherefore plaintiff avers that it has acquired and is possessed of a vested property interest and right in the continued maintenance of record in the United States Patent Office of the above registered trade-marks hereinbefore particularly described and that the cancellation of such registered trade-marks by said defendant the Commissioner of Patents would greatly impede and embarrass the plaintiff in the continued prosecution of its business of manufacturing and selling, both in the United States and in the foreign countries above referred to, pianos of the type, class and style hereinbefore particularly described and bearing the registered trade-mark "Howard" printed or impressed on the fall-board and on the box in a distinctive manner, namely, in Old English letters; that under the circumstances and conditions narrated, the defendant Com-
9 missioner of Patents is without true and lawful authority and power to cancel said above described trade-marks because the cancellation thereof under the circumstances hereinbefore narrated

and set forth would constitute a deprivation of the plaintiff's property without due process of law contrary to the provisions and prohibition of the Fifth Article of Amendment to the Constitution of the United States.

12. Plaintiff is informed and believes and here avers that by Section 4915 of the Revised Statutes of the United States as construed and directed to be applied by the Supreme Court of the United States, remedy by bill in equity is provided and afforded to all who in like circumstances with plaintiff here desire to avail themselves thereof, and plaintiff furthers avers that such remedy so given and so applicable in the present instance and case would prove futile and constitute no remedy at all if pending the disposition of these proceedings on their merits the defendant, the Commissioner of Patents should proceed or be permitted to proceed to cancel the registrations of trade-marks above specified as he now threatens to do and unless restrained by this Honorable Court will do, to the great and irreparable injury and damage of plaintiff.

Wherefore, inasmuch as plaintiff is without remedy otherwise than in such proceedings in equity as are now here pending, such proceedings being instituted under and in accordance with the provisions of said Section 4915 of the Revised Statutes of the United States, and inasmuch as plaintiff has heretofore exhausted all other remedies under the existing statutes of the United States and the rules and regulations and practice of the Patent Office in such cases made and provided, plaintiff, The Baldwin Company, respectfully and humbly prays:

1. That pending the final disposition of this cause, and after full hearing, then permanently, said defendant Thomas E. Robertson, both individually and as Commissioner of Patents, be restrained and enjoined from cancelling and purporting to cancel on and erasing and purporting to erase from the records of the United States Patent Office the notations heretofore at any time made thereon evidencing or tending to evidence the registration in pursuance of the law of the Trade-Marks in the above bill of complaint particularly described and averred to have been duly registered in said United States Patent Office, said Trade-Marks being conveniently identified as follows, to wit:

(*a*) Trade-Mark Registration for Pianos, consisting of the word "Howard" accompanied by the initials V. G. P. Co. arranged in a monogram,—the word "Howard" therein being also printed or impressed in a particular and distinctive manner,—that is in Old English letters, such Registration being numbered 31411 and bearing date March 8, 1898;

(*b*) Trade-Mark Registration for Pianos consisting of the word "Howard" printed or impressed in a particular and distinctive manner,—that is, in Old English letters, such Registration being numbered 46993, and bearing date October 17, 1905.

10 2. That upon full consideration of the facts and circumstances disclosed by the pleading and the proofs heretofore

and which may hereafter be submitted, this Honorable Court will determine and declare that the R. S. Howard Company, Intervenor in the above entitled cause, is without any such right to or interest in the use as a trade-mark in connection with pianos of the word "Howard," standing alone, without prefix or suffix, as is or can or may be damaged by the continued maintenance of record in the United States Patent Office of either one or both of the registered Trade-Marks next above described.

3. That pending the final disposition of this cause upon its merits and thereafter permanently said Intervenor, R. S. Howard Company, its officers, agents, attorneys, servants and employees, and its successors and assigns, be restrained and enjoined from bringing, maintaining or further prosecuting in the United States Patent Office or before the Examiner of Interferences or the Commissioner of Patents any application, petition or proceedings whatever for the cancellation of the Certificates of Registration of the Registered Trade-Marks next above particularly described.

4. That this Honorable Court will accord and grant unto plaintiff such other and further relief as it may deem appropriate and in accord with law and the very right of the matter. The Baldwin Company, By Thomson De Serisy, Secretary. John E. Cross, McKenney & Flannery, Attorneys for Plaintiff, The Baldwin Company.

DISTRICT OF COLUMBIA, *ss:*

I, Thomson De Serisy, being first duly sworn, depose and say that I am the Secretary of The Baldwin Company, the Corporation named as plaintiff in the foregoing and annexed Bill of Complaint; that I have read said Bill of Complaint and have signed and do here verify the same as Secretary of said The Baldwin Company; that I well know the statements of fact contained in said bill of complaint and verily believe the facts stated therein to be true. Thomson De Serisy.

Subscribed and sworn to before me this 13th day of October, A. D. 1921. Morgan H. Beach, Clerk of the Supreme Court of the District of Columbia, By W. E. Williams, Assistant Clerk.

Memoranda.

May 27, 1921.—Petition of R. S. Howard Company to intervene as a defendant granted and answer of R. S. Howard Company to the bill filed and served on the plaintiff.

11 In Supreme Court of the District of Columbia.

Rule to Show Cause.

[Filed May 17, 1921.]

On reading the verified Bill of Complaint filed in the above entitled suit, and other good cause shown, it is this 17th day of May, 1921, ordered that the defendant in this case be and appear in this Court at the Court-room thereof, in the City of Washington, District of Columbia, on the 20th day of May, 1921, at 10 A. M. then and there to show cause, if any he can, why a writ of injunction should not issue in this case enjoining and restraining said defendant from cancelling certificate of registration No. 46993 dated October 17, 1905, and certificate of registration No. 31411 dated March 8, 1898, until the further order of the Court pursuant to the determination of the cause of action set up in the Bill of Complaint herein.

And on the order to show cause plaintiff may use, read and refer to the Bill of Complaint in this case, copy of said Bill of Complaint having been served upon the defendant on the 7th day of May, 1921, provided a copy of this order is served on the defendant in this case at least two (2) days before the 20th day of May, 1921. William Hitz, Justice.

In Supreme Court of District of Columbia.

Answer of Commissioner of Patents.

[Filed May 20, 1921.]

To the honorable the Judges of the Supreme Court of the District of Columbia:

1. Defendant answering the Bill of Complaint as far as he has any concern in the matters of the bill, admits the allegations of paragraph 1.

2. Defendant admits that the trade-marks referred to in paragraph 2 have been registered in the U. S. Patent Office, but has no knowledge as to the ownership of said marks.

3, 4, 5. Defendant has no knowledge as to the allegations of paragraphs 3, 4, 5.

6. Defendant admits that proceedings were brought in the Patent Office as stated in paragraph 6.

7. Defendant admits that the Examiner of Interferences and the Commissioner of Patents made the rulings specified in paragraph 7.

8. Defendant admits that appeal was taken to the Court of Appeals of the District of Columbia, which court reversed the decision of the Commission of Patents (48 App. D. C., 437).

9, 10. Defendant admits the allegations of paragraphs 9 and 10.

11, 12. Defendant has no knowledge of the allegations set forth in paragraphs 11 and 12.

And further answering Defendant states that he is bound by the decision of the Court of Appeals of the District of Columbia
12 referred to in paragraph 8 of the bill and reported in 48 App. D. C., 437, and therefore prays—

(1) That the petition for a decree that the Defendant be enjoined and restrained from canceling said registrations or either of them be denied, and

(2) That he be dismissed with his costs and expenses in the proceedings. Thomas E. Robertson, Commissioner of Patents, Defendant. Theodore A. Hostetler, Attorney.

WASHINGTON,
District of Columbia, ss:

I, Thomas E. Robertson, depose and say that I have read the annexed answer by me subscribed and know the contents thereof; and that the statements of facts therein made as upon personal knowledge are true, and those made upon information and belief I believe to be true. Thomas E. Robertson.

Subscribed and sworn to before me this 20th day of May, 1921. R. J. Strong, Notary Public, D. C. [Seal.]

In Supreme Court of District of Columbia.

Answer of R. S. Howard Company to the Amended Complaint.

[Filed October 13, 1921.]

R. S. Howard Company, for its answer to the amended bill of complaint herein, shows and alleges to this Honorable Court:

1. Said R. S. Howard Company admits that plaintiff, The Baldwin Company, is a corporation of the State of Ohio, admits that defendant, Thomas E. Robertson, is Commissioner of Patents, admits that said R. S. Howard Company, a New York corporation, has intervened by leave of Court as a party defendant with like effect as if named in the original bill as a party defendant.

2. Said R. S. Howard Company admits that the marks referred to in paragraph marked "2" of the amended bill of complaint have been registered in the United States Patent Office, but denies that in either of said marks the name or word "Howard" is written, printed or impressed in a particular or distinctive manner, and denies, upon information and belief, that the plaintiff is the owner thereof or entitled to have said marks registered as trade-marks for pianos.

3. Said R. S. Howard Company does not know, and is without knowledge or information sufficient to form a belief as to the truth, or otherwise, of the allegations contained in paragraph marked

"3" of the amended bill of complaint, except that said R. S. Howard Company denies, upon information and belief, that said
13 The Baldwin Company, or any of its predecessors or assignors in business, did, in advance of all others, adopt, apply or use the name "Howard" as a mark for pianos; denies, upon information and belief, that said The Baldwin Company, or any of its predecessors or assignors in business, have continuously used since December 15, 1896, the Trade-marks shown in said registrations sought to be canceled, or either of them, as or for a trade-mark for pianos, and also denies, upon information and belief, that the name or word "Howard," in any form of lettering has served, at any time, to indicate the origin or ownership of pianos as those manufactured or sold by said The Baldwin Company, or any of its predecessors or assignors in business, or has served to distinguish pianos manufactured or sold by said The Baldwin Company, or any of its predecessors or assignors, from those made or sold by other piano manufacturers and dealers; but on the contrary said R. S. Howard Company alleges, upon information and belief, that Robert S. Howard, the predecessor in business of said R. S. Howard Company, beginning in the year 1889 and continuously for seven or eight years thereafter, sold many hundreds of pianos marked on their fall-boards variously (some one way, some another) "Howard," "R. S. Howard & Co.," and "Howard & Co.," which pianos were manufactured by the New England Piano Company, of Boston, Massachusetts, of an improved grade, character, "scale," size and finish suggested and indicated by said Robert S. Howard, and that said pianos were generally and commonly known, described and spoken of in the retail trade by the users and the general public as "Howard" pianos, and that said pianos were sold by the said Robert S. Howard during said period in many of the principal cities of the United States, including Charleston, S. C.; Atlanta, Ga.; Detroit, Mich.; St. Louis, Mo.; Burlington, Iowa; Lincoln, Neb.; Salt Lake City, Utah; San Francisco, Calif.; Los Angeles, Calif.; Portland, Oregon; and in said cancellation proceedings about thirty five witnesses (including retail dealers who bought said pianos, the manufacturers, superintendent and workmen of the factory where said pianos were made) testified that they had sold, or handled, or had been familiar with pianos marked with "Howard," or "R. S. Howard & Co.," "Howard & Co.," which had been sold or dealt in by Robert S. Howard prior to the year 1896.

4. Said R. S. Howard Company, upon information and belief, denies each and every allegation contained in paragraph marked "4" of the amended bill of complaint.

5. Said R. S. Howard Company does not know, and is without knowledge or information sufficient to form a belief as to the truth, or otherwise, of the allegations contained in paragraph marked "5" of the amended bill of complaint, except that said R. S. Howard Company, upon information and belief, denies that plaintiff, or any of its predecessors or assignors in business, are now marking or ever

have marked pianos, or the boxes in which they have shipped pianos, with the name or word "Howard" written, printed or impressed in a distinctive or particular manner.

14 6. Said R. S. Howard Company admits the allegations contained in paragraph marked "6" of the amended bill of complaint, and alleges that it is the same R. S. Howard Company which brought said cancellation proceedings, as alleged in said paragraph marked "6."

Said R. S. Howard Company further alleges that the grounds for cancellation set forth in said applications to cancel were in substance as follows:

As to Trade-Mark Registration No. 31,411, that:

(1) Registrant or its predecessors in business were not the first to adopt and use the name "Howard" as a trade name and mark for pianos, but that applicant's predecessor in business, Robert S. Howard, was the first to adopt and use the name "Howard" as a trade name and mark for pianos, and that applicant and its said predecessor in business have continuously used the name "Howard" as a trade name and mark for pianos since such first adoption and use, which was long prior to the time when registrant claims to have first adopted and used said mark.

(2) Registrant, prior to its application to register same, had never used the mark in commerce between the United States and foreign nations or Indian tribes.

(3) Registrant had never used the mark prior to its application to register same, or at any time.

(4) The principal feature of the mark is the word "Howard," an individual or proper name, a common surname, and also a common geographical term, which was not registrable under the Trade-Mark Act in force at the date of its registration.

(5) That the name "Howard" is the predominating and dominant feature of applicant's corporate name, and registrant or its successors in business had never made use of the name "Howard" as a trade-mark for pianos prior to the date of applicant's incorporation.

R. S. Howard Company also applied to cancel registration No. 31411, on the grounds that:

(*a*) The mark is not used by the registrant or its successors in business.

(*b*) The mark has been abandoned by registrant and its successors in business.

As to Trade-Mark Registration No. 46,993, that:

(1) Registrant or its predecessors in business were not the first to adopt and use the name "Howard" as a trade name or mark for pianos, but that applicant's predecessor in business was the first to adopt and use the name "Howard" as a trade name and mark for pianos, and applicant and its predecessor in business have continuously used the name "Howard" as a trade name and mark for pianos since such first adoption and use, which was long prior to the time when registrant or its predecessor in business claims to have first adopted and used said mark.

(2) The mark consists merely in the name of an individual, a common surname, not written, printed, impressed or woven in some particular or distinctive manner, or in association with the portrait of the individual, is also a geographical term, and not
15 registrable under the Trade-Mark Act in force at the date of its registration.

(3) The statement and declaration forming a part of the application to register the mark was false, in that:

(*a*) The mark had not been continuously used in the business of registrant and its predecessor since December, 1896.

(*b*) The name "Howard" was never at any time used by registrant, or its predecessors in business, printed or impressed in a particular, distinctive or peculiar manner.

(*c*) Registrant or its predecessors in business had never made a statutory use of the mark prior to its registration; and

(*d*) The name "Howard" is the predominating and dominant feature of applicant's corporate name, and registrant or its predecessors in business had never made use of the name "Howard" as a trade-mark for pianos prior to the date of applicant's incorporation.

Said R. S. Howard Company further alleges that The Howard Piano Company, an Ohio corporation, appeared and answered in said cancellation proceedings, alleging that its name was formerly said The Valley Gem Piano Company whose name had been changed in 1912 to The Howard Piano Company; said The Baldwin Company also appeared and answered in said cancellation proceedings, the said The Baldwin Company alleging (among other things) that it was the owner of both of said Trade-Mark registrations and the Trade-Marks registered thereby.

Said R. S. Howard Company further alleges that the answers of said The Baldwin Company and The Howard Piano Company were both in the nature of general denials, the said The Howard Piano Company alleging that said The Valley Gem Piano Company was the first to adopt and use said registered mark as a mark for pianos, and first adopted and used same about December 15, 1896, and had continuously used same since about December 15, 1896, the said The Baldwin Company claiming title exclusively, through an assignment from said The Valley Gem Piano Company, and as the successor of said The Valley Gem Piano Company.

Said R. S. Howard Company further alleges that, in the answers in both cancellation proceedings, both said The Baldwin Company and The Howard Piano Company (substituted for said The Valley Gem Piano Company) specially and expressly denied that said "R. S. Howard Company has been injured by the registrations sought to be cancelled," and in both cancellation proceedings specially alleged that said R. S. Howard Company had failed to show such an interest in the registrations sought to be canceled as entitled it to be heard in the cause; that the defense that said R. S. Howard Company had not been, and could not be, injured or damaged by the registrations sought to be canceled was expressly litigated and determined in said cancellation proceedings relating to both said Trade-Mark registra-

tions; that testimony was duly taken and filed in said cancellation proceedings upon said issues thus made, including the question of damage and injury to said R. S. Howard Company, final hearings had before the Examiner of Interferences, and on appeal to
16 the Commissioner of Patents, and on appeal by the Court of Appeals of the District of Columbia, the said Court of Appeals of the District of Columbia deciding and adjudging that both said Trade-Mark registrations be canceled by decisions made, entered and filed on or about March 3, 1919, and officially reported in Reports of the Court of Appeals of the District of Columbia, Volume 48, page 437.

7. Said R. S. Howard Company admits that a suit was brought against it as alleged in paragraph marked "7" of the amended bill of complaint, in which a decree was entered (expressly on the ground of unfair trade competition) restraining the R. S. Howard Company from making or selling pianos bearing the word "Howard" alone, without prefix or suffix, but said R. S. Howard Company alleges that said Courts affirmatively decreed that said R. S. Howard Company could use, and was entitled to use, the name "Howard" as a mark for pianos with the initials "R. S.," or the name "Robert S" prefixed, and the word "Company" or "Co." affixed, and denies that the Examiner of Interferences or the Commissioner of Patents held that said adjudication or decree was a bar to the claim of R. S. Howard Company to cancel said registrations. Said R. S. Howard Company admits that copies of the pleadings, the decree, writ and opinions in said suit in said Federal Courts in New York, certified by the Clerks of said Courts, were filed in and made a part of the record in said cancellation proceedings.

8. Said R. S. Howard Company admits that it duly prosecuted appeals from said decisions of the Commissioner of Patents to the Court of Appeals of the District of Columbia, which appeals were duly allowed, and said appeals and said causes to which same appertained were heard together before and by said Court of Appeals of the District of Columbia, which Court, after due consideration, reversed said decisions of the Commissioner of Patents in both cases, and affirmatively adjudged that both said trade-mark registrations should be canceled.

9. Said R. S. Howard Company denies each and every allegation contained in paragraph marked "9" of the amended bill of complaint, except that said R. S. Howard Company admits and alleges that, in both of said causes, plaintiff appealed to the Supreme Court of the United States to review and reverse said decisions and adjudications of the Court of Appeals of the District of Columbia, and also prayed the issuance of a writ of certiorari by the Supreme Court of the United States addressed to said Court of Appeals of the District of Columbia to the end that the Supreme Court of the United States would review and reverse said decisions of the Court of Appeals of the District of Columbia in both causes; and that by an opinion and judgment announced and entered on the 11th day of April, 1921, the Supreme Court of the United States dismissed both said appeals

and denied both said petitions for a writ of certiorari, as appears from the opinion of the Supreme Court of the United States reported in Volume 41 of the Supreme Court Reporter, at pp. 405-7, and the R. S. Howard Company further alleges that thereafter, and
17 on or about the 16th day of May, 1921, and pursuant to the decision, adjudication and order of the Court of Appeals of the District of Columbia, the Clerk of the Court of Appeals of the District of Columbia duly certified the decision and adjudication of the Court of Appeals of the District of Columbia in both said Trade-Mark registration cancellation proceedings to the Honorable Commissioner of Patents and said certification was duly delivered to the Honorable Commissioner of Patents on or about the 16th day of May, 1921. .

10. Said R. S. Howard Company denies the allegation contained in paragraph "10" of the amended bill, to the effect that said R. S. Howard Company has no interest within the meaning of Section 13 of the Trade-Mark Act of February 20, 1905, in the name "Howard" as a mark for pianos, but on the contrary alleges that it has a substantial, material and valuable interest in the name "Howard" with the prefix "R. S." and the suffix "Co." as a mark for pianos, and is damaged and injured by said Trade-Mark registrations No. 46,993 and No. 31,411, and further alleges that it has been finally and affirmatively determined and adjudicated by the Court of Appeals of the District of Columbia that said R. S. Howard Company has a substantial, material and valuable interest within the meaning of Section 13 of the Trade-Mark Act of February 20, 1905, in said name as a mark for pianos, and that said R. S. Howard Company is damaged and injured by said registrations No. 46,993 and No. 31,411, and that said determination and adjudication is res adjudicata, a bar and an estoppel as to said The Baldwin Company as to any further or different determination and adjudication, and that said The Baldwin Company is estopped from further litigating, asserting or alleging anything to the contrary of said determinations and adjudications.

Said R. S. Howard Company files herewith, and as a part hereof, a true and complete copy of the record and proceedings had in the Court of Appeals of the District of Columbia respecting the cancellation of said Trade-Mark registrations No. 46,993 and No. 31,411, together with a copy of the decision and adjudication of the said Court respecting the same, as said record and proceedings were certified by the Clerk of said Court of Appeals of the District of Columbia to the Supreme Court of the United States; and prays that the same be made and taken as a part of this answer as if set out in full herein, and same is annexed hereto and marked "Exhibit A" (in three Volumes, pages numbered 1 to 2661).

11. Said R. S. Howard Company admits that said The Baldwin Company has registered the name "Howard" as a mark for pianos in a number of foreign countries based on certified copies of said trade-mark registration No. 46,993, and alleges, upon information and belief, that said The Baldwin Company has registered said name

"Howard," as aforesaid, in several of the foreign countries in which said R. S. Howard Company is now and for a number of years has been doing an extensive business, and that in many cases said registrations in said foreign countries where said R. S. Howard Company is now and for a long period of years has been doing business, have been based upon said Trade-Mark registration No. 46,993,
18 and that said foreign registrations could not have been obtained except upon submitting, as a part of the application to register, certified copies of the said registration now of record in the United States Patent Office. Upon information and belief, said R. S. Howard Company further alleges that the effect of registration of the name "Howard" as a mark for pianos in several of said foreign countries in which it has for a number of years, and still is, doing business will prevent it from selling pianos of its manufacture bearing the name "R. S. Howard Co.," because in said countries "R. S. Howard Co." will be adjudged to be similar to and an infringement of "Howard;" that what may be considered a "similar" marking in said foreign countries is quite indefinable and undeterminable, but that any mark bearing any dominant features of a registered mark would probably be adjudged "similar," and that "R. S. Howard Co." would be adjudged an infringement of the mark "Howard;" that the penalties for infringement of a registered Trade-Mark in several of said foreign countries in which said The Baldwin Company has registered the name "Howard," as aforesaid, and in which said R. S. Howard Company is now and has been doing an extensive business for a long period of years, are criminal, subjecting the dealer and seller to imprisonment and fine and the stock of pianos to confiscation; that the official standing which a registered Trade-Mark in said foreign countries gives, results in great injury and damage to a concern using any similar business name or mark for its goods, with the practical certainty of a ruined trade and business in said foreign countries.

Said R. S. Howard Company further denies that said The Baldwin Company would be, or could be, injured or damaged by the cancellation of said foreign trade-mark registrations, and further alleges that said The Baldwin Company was never legally entitled to obtain said foreign registrations.

Said R. S. Howard Company further alleges, upon information and belief, as to Trade-Mark registration No. 31,411, that the registrant, said The Valley Gem Piano Company, was not entitled to the use of the mark or to register the mark at the date of its application for registration, in that:

(1) Registrant (or its predecessor in business) was not the first to adopt and use the name "Howard" as a name and mark for pianos.

(2) Registrant had never made statutory use of the mark registered prior to its application to register the same, and that prior to its application to register the same had never used the mark in commerce between the United States and foreign nations or Indian tribes.

(3) Registrant had never used the mark prior to its application to register the same, or at any time.

(4) One of the principal features of the mark is the name "Howard," a common surname, and also a common geographical term, which was not registrable under the Trade-Mark Act in force at the date of its registration.

(5) The name "Howard" is the predominating and dominant feature of a corporate name, R. S. Howard Company, and registrant or its successors in business had never made use of the name
19 "Howard" as a mark for pianos prior to the date of the incorporation of said R. S. Howard Company.

(6) The mark registered is not used by the registrant or its successors in business, and has not been so used since 1912, but said registered mark was abandoned by registrant and its successors in business in 1912.

Said R. S. Howard Company denies, upon information and belief, that said The Valley Gem Piano Company had any Trade-Mark rights, or rights of any kind, to the name "Howard" or to the mark shown in said Trade-Mark registration No. 31,411, which it did or could transfer, assign or convey to said The Baldwin Company, and said R. S. Howard Company further alleges, upon information and belief, that if any transfer, assignment or conveyance was made, or attempted to be made, it was an assignment and transfer "in gross."

Said R. S. Howard Company further alleges, upon information and belief, as to Trade-Mark registration No. 46,993, that the registrant was not entitled to the use of the mark, or to register the mark, at the date of its application for registration hereof, in that:

(1) Registrant (or its predecessor in business) was not the first to adopt and use the name "Howard" as a name or mark for pianos.

(2) The mark registered consists merely in the name of an individual, a common surname, not written, printed, impressed or woven in some particular or distinctive manner, or in association with the portrait of the individual, is also a geographical term, and not registrable under the Trade-Mark Act in force at the date of its registration.

(3) The registration was obtained by fraud upon the United States Patent Office because the statement, declaration and affidavit of title, forming a part of the application to register said mark, were false, in that:

(*a*) The mark had not been continuously used in the business of registrant and its alleged predecessor in title since December 1896.

(*b*) The registrant had never made statutory use of the mark prior to the date of its application for registration thereof.

(*c*) The name "Howard" was never at any time used by registrant or its predecessors in business, printed or impressed in a particular, distinctive or peculiar manner.

(4) The name "Howard is the predominating and dominant feature of the corporate name of said R. S. Howard Company, and registrant or its predecessors in business had never made use of the name "Howard" as a Trade-Mark for pianos prior to the date of the incorporation of said R. S. Howard Company.

Said R. S. Howard Company further alleges that it was incorporated and organized in April 1902, forthwith succeeded to the business, good-will, trade-marks and name of Robert S. Howard who had been in the piano business since 1877, forthwith acquired a going piano factory in New York City, and began the manufacture and sale of pianos marked "R. S. Howard Co." on their fallboards and on the boxes in which they were shipped, which since said date have been sold extensively throughout the United States and in many foreign countries, particularly in Cuba, Argentine Republic,
20 Brazil, Chili, Colombia, Panama, Spain, Portugal, France, Italy, Belgium, Australia, New Zealand, India, Japan, and others, in many of which countries a large business has been carried on; that said business of manufacturing, selling and marking pianos, as aforesaid, has been continuously carried on since April, 1902.

12. Said R. S. Howard Company denies that Section 4915 of the Revised Statutes of the United States affords, provides or gives any remedy whatsoever to plaintiff in the premises, and said R. S. Howard Company further alleges that said Section 4915 has no application, and is entirely irrelevant, to any issue in this action.

That said R. S. Howard Company respectfully shows and alleges that this Honorable Court is without power or authority in the premises, and is without authority or power to grant the relief prayed for in the amended bill, or to enjoin or restrain the Honorable Commissioner of Patents from cancelling said Trade-Mark registrations No. 46,993 and No. 31,411, or either of them, or to grant or order any different or other decree or judgment in the premises, except as hereinafter prayed by said R. S. Howard Company.

Wherefore, said R. S. Howard Company prays that the relief prayed for in the amended bill be denied and the amended bill dismissed, and that judgment be entered in favor of said R. S. Howard Company against said The Baldwin Company for its costs and disbursements in this action.

And said R. S. Howard Company as in duty bound will ever pray, etc. R. S. Howard Company, by Louis Bromberg, Secretary. Samuel S. Watson, Office and Post Office Address: 2 Rector Street, New York City, N. Y., Solicitor and Attorney for R. S. Howard Company.

STATE OF NEW YORK,
County of New York, ss:

Louis Bromberg, being duly sworn, deposes and says, that he is the Secretary of the R. S. Howard Company named in the foregoing answer; that he has read said answer and knows the contents thereof, and that he verily believes the facts therein stated to be true;

That said R. S. Howard Company is a corporation, and the reason why this verification is not made by said R. S. Howard Company is because of that fact; that deponent's knowledge and the grounds of his information and belief are derived from his active participation in the business of said R. S. Howard Company for several years last past, from information imparted to deponent by said R. S. Howard Company's attorney in said cancellation proceedings, and by

Robert S. Howard, mentioned in the answer, and from the testimony, proceedings and court opinions mentioned in the above answer. Louis Bromberg.

21 Subscribed and sworn to before me, a Notary Public, this 11th day of October, 1921. May Frevert, Notary Public, Suffolk Co. [Notarial Seal.] Certf. filed in New York Co. #103.

EXHIBIT A TO ANSWER OF R. S. HOWARD CO.

Annexed to the answer of the R. S. Howard Company is the consolidated record of the two cancellation proceedings in the Patent Office and the Court of Appeals of the District of Columbia, as said record and proceedings were certified to the Supreme Court of the United States by the Clerk of the Court of Appeals of the District of Columbia, and shows the following:

On or about August 6, 1914, the R. S. Howard Company filed in the United States Patent Office its applications to cancel said two trade-mark registrations No. 31,411 and No. 46,993. The grounds for cancellation alleged are summarized in paragraph 6 of -he answer of the R. S. Howard Company to the amended bill of complaint herein.

The Baldwin Company (the above-named plaintiff) and The Howard Piano Company, both Ohio corporations, answer. (The Howard Piano Company was formerly The Valley Gem Piano Company, its name having been changed to The Howard Piano Company in 1912). The answers of said The Baldwin Company and The Howard Piano Company are summarized in paragraph marked "6" of the answer of the R. S. Howard Company to the amended bill of complaint herein.

In cancellation No. 302 the answer of The Baldwin Company contains the following:

"1. That The Baldwin Company * * * is the owner of the trade-mark registered in the United States Patent Office on March 8, 1898, certificate of registration No. 31,411, consisting of the word 'Howard' for pianos, by virtue of a general conveyance on or about the 6th day of December, 1901, from The Valley Gem Piano Company to The Baldwin Company * * *."

"8. Further answering, this respondent alleges that, in or about the year 1896 or 1897 The Valley Gem Piano Company began to manufacture a high grade cheap piano, and desiring to identify and distinguish its said pianos * * * did, on or about the 15th day of December, 1896, and in advance of all others, devise, originate, appropriate, adopt, apply, and use as a trade-mark for the said pianos manufactured and sold by it, the word 'Howard' printed in distinctive, ornamental type, resembling Old English, * * * which word was accompanied by the initials V. G. P. Co. of The Valley Gem Piano Company, in the form of a monogram; and that * * * The Valley Gem Piano Company on the 15th day of November, 1897, filed * * * an application for the registration of said trade-mark * * *."

22 "9. That * * * said pianos became known to the public by the trade-mark 'Howard' solely through the manufacture of The Valley Gem Piano Company which was continued until said company was succeeded by The Baldwin Company, as hereinafter set forth, and the said trade-mark indicated the manufacture of said The Valley Gem Piano Company to the trade * * *, the said The Baldwin Company being the owner of the trade-mark 'Howard' for pianos, by virtue of an assignment thereof including the business and good-will from the Valley Gem Piano Company, * * *."

"11. Further answering, this respondent says that the trade-mark 'Howard' for pianos has been continuously used by The Valley Gem Piano Company and its successor in business, The Baldwin Company, in interstate and foreign commerce, from the 15th day of December, 1896, down to and including the present time, said trade-mark having been duly assigned, transferred and conveyed by The Valley Gem Piano Company to The Baldwin Company on the 6th day of December, 1901, by a general conveyance of all the business of The Valley Gem Piano Company to The Baldwin Company * * *."

In cancellation No. 301 the answer of The Baldwin Company contains the following:

"8. Further answering, this registrant, The Baldwin Company, alleges that, in or about the year 1896 or 1897, its predecessor in business, The Valley Gem Piano Company, began to manufacture a high grade, cheap piano, and desiring to identify and distinguish its said pianos * * * did, on or about the 15th day of December, 1896, and in advance of all others, devise, originate, appropriate, adopt, apply and use as a trade-mark for the said pianos manufactured and sold by it, the word 'Howard' printed in distinctive, ornamental type, resembling Old English * * * which word was accompanied by the initials 'V. G. P. Co.' of The Valley Gem Piano Company in the form of a mon-gram * * *."

"9. That * * * said pianos became known to the public by the trade-mark 'Howard' solely through the manufacture of The Valley Gem Piano Company which was continued until said company was succeeded by The Baldwin Company, as hereinafter set forth, and the said trade-mark indicated the manufacture of said The Valley Gem Piano Company to the trade * * *, the said The Baldwin Company being the owner of the trade-mark 'Howard' for pianos, by virtue of an assignment thereof, including the business and good-will from The Valley Gem Piano Company * * *."

"11. Further answering, this registrant says that the trade-mark 'Howard' for pianos has been continuously used by The Valley Gem Piano Company and its successor in business, The Baldwin Company, in interstate and foreign commerce, from the 15th day of December, 1896, down to and including the present time, said trademark, together with the business and good-will of the business in connection with which the same has been used, having been duly assigned, transferred and conveyed by The Valley Gem Piano Company to The Baldwin Company."

23 The Baldwin Company, in its petition verified the 14th day of April, 1915, filed in said cancellation proceeding No. 301, said:

"1. That it is the owner of the trade-marks consisting of the word 'Howard' for pianos, which were registered in the United States Patent Office by its predecessor in business, The Valley Gem Piano Company, on May 8, 1898, certificate of registration No. 31,411, and subsequently registered in its own name on October 17, 1905, certificate of registration No. 46,993.

Statement of Evidence in said Cancellation Proceedings.

ROBERT S. HOWARD testified for the R. S. Howard Company substantially as follows:

I am the president and general manager of the R. S. Howard Company, which is a corporation, incorporated under the laws of the State of New York in April 1902, which has its office in New York City, and its factory in Brooklyn. I have held these offices and had the duties pertaining thereto since the incorporation of the Company.

I have been engaged continuously in the piano business since 1877. From about 1877 to 1880 I was tuning and retailing pianos on my own account in Ohio. In 1880 I was employed by Root & Sons Company, of Chicago, in charge of their piano department part of the time and travelling part of the time wholesaling pianos in the western States. In 1881, I was employed by D. S. Johnson & Co., of Cincinnati, selling pianos at wholesale. During 1882 to 1884 I was employed by Hallett & Cumston, piano manufacturers of Boston, Mass., selling their pianos throughout the United States and Canada. In the latter part of 1884, I was employed by Chickering & Sons for about a year and a half, selling their pianos at wholesale throughout the United States and Canada. I then returned to Hallett & Cumston and continued with them until the end of 1888. In 1889 I was employed by the New England Piano Company of Boston, Mass. (owned by Thomas F. Scanlan), then one of the largest piano manufacturers in the United States, to sell their product in the United States and Canada and continued with the New England Piano Company until January 1st, 1893. In 1876 I began to learn piano tuning, and prior to 1889 I learned action-regulating and tone-regulating and the details of piano construction in various piano factories.

I was employed by J. & C. Fischer, piano manufacturers of New York City, from January 1st, 1893, to December 31st, 1897, selling their product throughout the United States. From January 1st, 1898, to December 31st, 1898, I was employed by the Schuberts and Sohmer & Co., piano manufacturers of New York City, selling their product throughout the United States and Canada. From January 1st, 1899, to March 31st, 1902, I was selling "Baldwin," "Ellington," "Hamilton," "Valley Gem" and "Howard" pianos under a salary, expense and profit-sharing agreement with D. H. Baldwin

& Company, of Cincinnati, O. In April 1902 I organized
24 the R. S. Howard Company and became its president and general manager and active executive head and one of its largest stockholders, and have continued as such to the present time. I am now its largest stockholder and own a majority of its stock.

Immediately upon the incorporation of the R. S. Howard Company, I transferred to it my good-will, trade-marks, and business and forthwith the Company acquired a going piano factory in New York City, and began the manufacture of pianos which were marked "R. S. Howard Co.," and "Howard," which business the Company has carried on to the present time, selling its pianos throughout the United States and in many foreign countries.

I went with the New England Piano Company in August 1889 and before starting on my first trip, early in September, 1889, I arranged to have pianos marked by them under the "Howard" name. Starting early in September, 1889, I made a trip lasting about four months covering the Pacific Coast, and all important cities between Chicago and San Francisco, and Portland, Oregon, selling pianos made by the New England Piano Company, which included pianos marked "R. S. Howard & Co., Boston," and "Howard, New York," and during all the time that I was connected with the New England Piano Company I was selling pianos marked "Howard" and "R. S. Howard & Co." These "Howard" pianos were sold in most of the principal cities of the United States west of Chicago.

When I engaged with J. & C. Fischer, January 1st, 1893, I arranged with the New England Piano Company to manufacture "Howard" pianos at a factory price to me, arranging that I should have them billed to me if I wished them to do so, or billed direct to the customers at prices to the customers which I would stipulate. This arrangement was made with the consent of J. & C. Fischer. I guaranteed the New England Piano Company against any loss where they billed direct to the customers. This arrangement with the New England Piano Company continued from January 1st, 1893, up to and including a part of 1896, during all of which time I was selling the "Howard" pianos made by the New England Piano Company under the arrangement stated above. These pianos were marked "R. S. Howard & Co." and "Howard & Co.," and were sold in the principal cities of the United States.

In 1896 the New England Piano Company became financially embarrassed and was unable to furnish me any "Howard" pianos, and I made "practically the same" arrangement with D. H. Baldwin & Company as I previously had with the New England Piano Company. This arrangement with D. H. Baldwin & Company continued until January 1st, 1899, when I made a contract in writing with D. H. Baldwin & Company to sell "Baldwin," "Ellington," "Howard" and "Valley Gem" pianos at wholesale on a salary, expense and profit-sharing basis.

The cancellation proceedings in the United States Patent Office were begun by the R. S. Howard Company because of troubles started

in Cuba in connection with its business there. After doing business there about twelve years, shipping in several thousand instruments and having as a matter of record in the Custom House eighty per cent of the business in Cuba, the "Howard" piano was the easiest instrument to sell there, and one of my dealers' agents started in business for himself to sell the pianos manufactured by The Baldwin Company. The Baldwin Company, to prevent the R. S. Howard Company from selling its pianos in Cuba, applied in Cuba for a trade-mark on the "Howard" name for pianos, which application is still pending. The R. S. Howard Company has been advised by its attorney in Cuba that the effect of the registration of the name "Howard" as a trade-mark for pianos in Cuba would be that the pianos made by the R. S. Howard Company in possession of dealers there would be attached and the goods would be confiscated and the dealer arrested and sent to jail.

The pianos made and sold by the R. S. Howard Company were marked on their fall-boards, some "R. S. Howard Co.," and some "Howard," and the Company used markings shown in Applicant's Exhibits No. 64 and 65. The marking has always remained the same as to the wording; the monogram on Exhibit No. 65 was not used in the earlier period of the business and the form of the letters has been slightly changed.

THOMAS F. SCANLAN testified for the R. S. Howard Company substantially as follows:

I am 61 years old and was in the piano business from 1881 to 1905, and carried on the business in the name of the New England Piano Company whose factory was in Boston, Mass. Robert S. Howard was employed in that business from the fall of 1889 to 1893 as a traveling salesman, representing the Company throughout the greater portion of the United States. Pianos made by the New England Piano Company were marked with its name, also Gilbert & Co., and other names, and when Mr. Howard came with the Company the name "Howard," and as I remember it "Howard & Co.," was introduced and we made pianos marked with the name "Howard" beginning in 1889 until 1896. During this period, the New England Piano Company had retail stores in Boston, New York and Chicago. After Mr. Howard left the employ of the New England Piano Company on January 1st, 1893, the Company still continued to make "Howard" pianos which were only sold to Mr. Howard or on reorders from his customers. The New England Piano Company never carried or sold any of these "Howard" pianos in its retail stores. The New England Piano Company looked to Mr. Howard for the payment of all "Howard" pianos it made after 1893. Mr. Howard and myself got together and made our adjustment at such periods as were mutually satisfactory.

"Q. 63. Who owned the name 'Howard,' the New England Piano Company or Mr. Howard?

"A. Why, I never understood that the New England Piano Company owned it, no more than it did any other name that a man furnished me to put on.

26 "Q. 64. The New England Piano Company or you never at any time claimed to own the name 'Howard' as used for a name for pianos?

"A. No."

GEORGE W. MARKENS testified for the R. S. Howard Company substantially as follows:

I am 59 years old, and am in the export business in New York City and have been handling all the export business of the R. S. Howard Company since 1903, and have sold or arranged sales of its pianos in Argentine Republic, Brazil, Chili, Panama, Colombia, Spain, Portugal, France, Italy, Belgium, Australia, New Zealand, India, and Japan, and have been attending to all their export shipping and shipping requirements for Cuba, Mexico and Porto Rico. I have been engaged in the export business about seventeen years and the style of our business is "The Export Corporation, Limited," of which I am president. All the pianos are billed direct to the foreign buyer by the manufacturer and we attend to all details. I have been shipping pianos made by the R. S. Howard Company to Argentine Republic, Chili, Spain and Italy for ten years and have taken up other countries from year to year. Prices for the pianos are fixed by the R. S. Howard Company, and our Company has been doing an export business of $75,000 a year, or more, for the R. S. Howard Company.

JOHN L. STOWERS testified for the R. S. Howard Company substantially as follows:

I am forty-one years old, reside in Havana, Cuba. I have been in the piano business for myself in Key West, Fla., fifteen years and in Havana eleven years. For the past eleven years I have been selling pianos made by the R. S. Howard Company marked "R. S. Howard Company, New York"; some, three years or more ago, were marked "Howard." Also a limited number of pianos made by other concerns. Have sold in Cuba close to 5,000 pianos made by the R. S. Howard Company. I have twenty-two agencies that cover the Island. Ninety per cent of all the pianos which I have sold for the past eleven years have been from the R. S. Howard Company. The first shipment of pianos from the R. S. Howard Company arrived in Cuba in May 1904. An attempt has recently been made to register in Cuba the trade-mark "Howard" for pianos by The Baldwin Company. If such registration had been granted, "the effect in Cuba is criminal for selling a piano that is supposed to conflict with any other make of piano, and my stock of pianos would have been taken by the agent of the The Baldwin Company and confiscated, and I would have been subject to several years in prison."

CHARLES W. WILSON testified for the R. S. Howard Company substantially as follows:

I am sixty-seven years old, live at Worcester, Mass., and am an engraver and stencil maker, and have been in this business since 1865. I made stencils for marking pianos for the New England Piano Company of Boston, Mass., and I personally kept a record of the stencils made by me. On September 6, 1889, I made stencil for marking pianos of the words "Howard, New York," on November 14, 1889, made stencil of the words "R. S. Howard & Co., Boston," on April 11, 1892, made stencil of the words "R. S. Howard & Co., Boston," and on January 17, 1893, made stencil of the words "Howard & Co., Boston"; all these were made for the New England Piano Company, and were forwarded on the dates given to the New England Piano Company. I produce the day book in which the record of these stencils was kept (same is marked in evidence "Applicant's Exhibit No. 34").

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CHARLES H. STEINWAY testified for the R. S. Howard Company substantially as follows:

I am fifty years old, reside in New York City, and am connected with Steinway & Sons, manufacturers of pianos, and have been connected with that concern for almost forty-two years. I am the financial man for Steinway & Sons, and I have had a lot of experience selling pianos at wholesale. I have found in my experience that while initials or additions to a name may identify the makers, the general public only knows the Company by its business name, such as Steinway, Chickering, Knabe, Weber, etc., and such has been the fact since I have been in the piano business. Very little significance, if any, is given to the name of the city on the fall-boards of pianos by the purchasing public. For many years Steinway & Sons had the place of origin on its pianos, but dropped that entirely some years back, and we now simply stencil our fall-boards "Steinway & Sons."

ARTHUR W. BARBER, a witness for the R. S. Howard Company, testified substantially as follows:

I am forty-three years old, reside in Brooklyn, New York, and am a lawyer and have been engaged in the practice of law in New York City since 1897. I was graduated from Cornell University in 1895 in the Arts course, from the New York Law School in 1897 with a degree of Bachelor of Laws, and received a degree of Master of Laws from the New York University in 1899. Since 1904 I have been specially interested in trade-mark law and since that time have been Secretary of the United States Trade-Mark Association and editor of its Monthly Bulletin which is devoted to the subject of trade-mark protection throughout the world. During that period my practice has been particularly in connection with trade-mark matters, involving litigation both in the United States and foreign countries.

I have had charge of trade-mark registrations in Argentine Republic, Brazil, Panama, Colombia, Italy, Cuba, and Mexico to the number of scores and probably hundreds in each country. Prior registration in applicant's home country is required for Brazil, Panama, Colombia, and Cuba and a certified copy of such prior registration in the United States must form a part of the application for registration by an Ohio corporation of it trade-marks in Brazil, Panama, Colombia, and Cuba. In all of these countries
28 enumerated above infringement of a registered trade-mark is a criminal or penal offense, and in each of the countries enumerated above, with the possible exception of Cuba, the goods bearing the infringing marks would be subject to confiscation. I have been advised several times by Cuban attorneys that goods bearing marks infringing a registered trade-mark could be confiscated under the provisions of the Cuban Penal Code. The certificate of registration is evidence of right to invoke the protection of the laws in behalf of a registered trade-mark in all the countries enumerated above, and is conclusive evidence of the right of the registrant of the trade-mark to protection except in Italy except that in Brazil and in Mexico the rights of a prior user may be asserted against a wrongful registration if brought within six months of the registration in Brazil, and within two years of the registration in Mexico. Citizens of countries parties to the International Convention of 1883 who have commercial establishments in Brazil or Cuba may register their trade-marks there without registration at home. The following countries are members of the International Convention of 1883 as published by the International Bureau of Berne, Switzerland under date of January 1st, 1915, and there have been no changes since that date, so far as I have been informed: Austria, Belgium, Brazil, Cuba, Denmark, Dominican Republic, Germany, Spain, United States, Hungary, France, Great Britain, Australia, Ceylon, New Zealand, Trinidad, Italy, Japan, Mexico, Norway, Holland, Dutch East Indies, Surinam, Curacao, Portugal, Servia, Sweden, Switzerland, Tunis, and the German Colonies.

The provisions of Articles 6, 9, and 10 of the International Convention of 1883 are as follows:

"Article 6. Every trade or commercial mark regularly registered in the country of origin shall be admitted to registration and so protected in all the other countries of the Union.

"The country where the registrant has his principal establishment shall be considered as the country of origin.

"If its principal establishment is not located in one of the countries of the Union, the country to which the registrant belongs shall be considered the country of origin.

"The registration may be refused if the object for which it is asked is considered contrary to morals or the public order.

"Article 9. Every product unlawfully bearing a trade or commercial mark or a commercial name, may be seized upon importation into those of the States of the Union in which this mark or this commercial name has a right to the protection of the law.

"The seizure shall be made either at the instance of the public prosecutor or of the party interested, according to the domestic legislation of each State.

"Article 10. The provisions of the preceding article shall be applicable to every product falsely bearing, as an indication of origin, the name of a definite locality, when this indication is joined to a fictitious commercial name or a name borrowed with a fraudulent intent.

29 "Every manufacturer or trader engaged in the manufacture or trade in this product and established in the locality falsely indicated as the place of origin, shall be regarded as an interested party."

On cross-examination:

"I would certainly believe that the registration of the name 'Howard' in Brazil by The Baldwin Company, would give it the opportunity to do incalculable damage to the trade of the R. S. Howard Company in that country by lending countenance to threats that might be made against its agents and dealers in its goods, and by affording a basis for criminal prosecutions and suits which might be successfully defended by the R. S. Howard Company, if it could persuade Brazilian courts to accept the interpretation of the International Convention contained in my answer to Q. 39. Even in that event, however, it is clear that the R. S. Howard Company would be subjected to great expense and its business might be damaged considerably, if not irreparably, in the meantime. The idea I aim to convey is: That in all Latin-American countries the assertion of the rights theoretically clear in law is very expensive and may be made very difficult by any one who is able to entrench himself behind a shadow of right and able to command or willing to pay for political influence.

"It is, of course, always to be understood in dealing with Latin-American countries, that to have a right is one thing under their laws, and to be able to enforce it is another thing.

"I know of no way that anyone can be prevented from making threats whether with or without foundation, but the important difference between the status of The Baldwin Company and of the R. S. Howard Company in Brazil, as disclosed in this examination, is, that The Baldwin Company has a certificate of registration of a trade-mark in Brazil consisting of the name 'Howard' and can produce a certificate as proof of its right to use the name before any court or tribunal, while the R. S. Howard Company would be at a very great disadvantage without certificate of registration and forced to rely upon the provisions of the International Convention. I would consider it a very difficult proposition to find a lawyer in Brazil who could properly appreciate the difference between a trade-mark and a trade-name and recognize the rights of the R. S. Howard Company as secured by the International Convention, and having found him I would consider that he would have a very difficult task to convince a court in that country of the justice of his view.

In my experience, there is only one Latin-American country where the principles of trade-mark law are understood or the nature of trade-mark rights are adequately recognized, and that country is not Brazil, and is not along the countries referred to in my testimony.

"The registration of the name 'Howard' by The Baldwin Company might very readily be made the basis of proceedings in those countries, or any of them, against dealers in the goods of the R. S. Howard Company, which proceedings made under color of
30 trade-mark registration might be used to work great damage to the trade in the goods of the R. S. Howard Company. The timidity of dealers in the handling of goods the trade-mark on which is questioned or is the subject of dispute is very well recognized in all countries, and is quite as pronounced in Spanish-American countries as in the United States.

"The continued liability to such threats or proceedings would seem to me a very material present damage.

"There are very few decisions reported in accessible form in any of the countries of Latin-America. I have known of a case with which I was occupied for a year or two in Brazil and in many other of the Latin-American countries in behalf of a client located in the United States who was doing business under his surname as a trade name, and applying it to his goods in the form of his facsimile signature. A competitor in the United States obtained a registration in Brazil of a similar trade name, differing only from the one previously mentioned in that it terminated in the letter 'y' instead of 'ie.' By means of this registration in Brazil, the party in question was able to put my client to an expense of about $2,000. for the establishment of his rights, and to kill his trade in that country for more than a year, and to such an extent that it has never recovered."

Alice G. Donegan testified on behalf of The Baldwin Company substantially as follows:

I am stenographer and docket clerk for the firm of John E. Cross and Edwin F. Samuels, Baltimore, Md., and have been such since September 1911. I prepared and forwarded applications of The Baldwin Company for the registration of the Trade-Mark "Howard" for pianos in foreign countries, especially Brazil, Columbia, and Panama, forwarding with said applications certified copy of United States registration No. 46,993 dated October 17, 1905.

Cross-examination:

The foreign applications referred to were sent forward in September 1914. The application for Brazil was sent forward on September 8, 1914, application for Panama was sent forward on September 30, 1914, the application for Colombia was sent forward on September 22, 1914. I should judge about fifteen foreign applications to register the name "Howard" for pianos for The Baldwin

Company were sent forward. A number of these applications to register have been granted; I am unable to state how many.

LEVI D. SARGENT, a witness for The Baldwin Company, testified substantially as follows:

I am forty three years old, and am now and since 1912 have been treasurer of The Ellington Piano Company. I was secretary of The Valley Gem Piano Company from 1900 to 1912, and an officer and now treasurer of The Howard Piano Company. I have been a director of The Baldwin Company since the latter part of 1901.

31 I was employed by The Ellington Piano Company from 1892 or 1893 to 1900, doing general office work, looking after shipments and factory work and in charge of its factory under Lucien Wulsin. I assumed general management of its factory in 1900 and have been in charge of its factory ever since. I produce a register (Registrant's Exhibit No. 16) which contains a record of all "Howard" pianos made by the Baldwin concerns from May, 1895, to October 1st, 1900, and I had charge of all the manufacturing of these pianos and the entries were made under my direction and the "Howard" pianos were made by The Ellington Piano Company, in its factory, after the "scales" of the Ellington piano. The materials, including transfers and stencils for marking the Howard pianos and piano boxes, were selected, purchased and paid for by The Ellington Piano Company and the "Howard" pianos were made, inspected, shipped and sold by The Ellington Piano Company, and were shipped direct to dealers or to dealers' customers, and the money was collected by and paid to The Ellington Company.

"Q. 86. To whom were the payments made, if you know, for the bills referred to?

"A. Why, the accounts mentioned were settled either direct to The Ellington Piano Company or through D. H. Baldwin & Co. The payments made have been made to D. H. Baldwin & Co. and turned over to The Ellington Piano Company or may have been made direct."

Cross-examination:

The piano register which I have produced (Registrant's Exhibit No. 16) shows that the first shipment of a "Howard" piano to any foreign country was made to Canada on November 29, 1897.

"X Q. 36. If they (Howard pianos) were shipped to Canada, for example, it (Registrant's Exhibit No. 16) would show Canada?

"A. It would show Canada.

"X Q. 37. Or if shipped to any other foreign country, it would show that country?

"A. If shipped to any other foreign country, it would show in the record."

LEVI D. SARGENT testified for the R. S. Howard Company substantially as follows:

Registrant's Exhibits No. 26 and No. 38 are now used in marking "Howard" pianos made and sold by the Baldwin concerns, and Registrant's Exhibit No. 27 for marking its Howard player pianos, and these are the only markings used at the present time for "Howard" pianos. The monogram "VGPCo." was changed to "HPCo." in the markings No. 26 and No. 38 when the name of the corporation was changed from "The Valley Gem Piano Company" to "The Howard Piano Company" in 1912, and we ceased to use the marking "VGPCo." at that time and have not used it since. The Baldwin concerns began to use markings like Registrant's Exhibit No. 27 at the time we brought out the player piano called the "Howard Manualo," which to the best of my recollection was in 1912, or thereabouts. We have never used the monogram on the "Howard" player piano.

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Registrant's Exhibits Nos. 26, 27, 37, and 38 show all the markings which have been used at any time by the Baldwin concerns in marking "Howard" pianos and of these the only ones used at present are Nos. 26, 27 and 38.

I attended to the shipping of all "Howard" pianos made by The Ellington Piano Company during the years 1896 and 1897 under the direction of Mr. Lucien Wulsin, and attended to making out the bills of lading, seeing that the pianos were properly marked and hauled to the depot. I have no recollection of any "Howard" pianos sold or shipped to Indians or Indian tribes during the year 1896 or 1897.

"Q. 14. And when you changed the name of the corporation, did you change the marking on the fall-board from the monogram 'VGPCo.' to 'HPCo.'?

"A. The monogram was changed just as soon as we could have designs submitted and transfer made.

"Q. 15. And you ceased to use the marking 'VGPCo.' on it at that time?

"A. Yes, sir.

"Q. 17. Did you use the monogram 'VGPCo.' on any other part of the piano after you changed the name of The Valley Gem Piano Company to The Howard Piano Company?

"A. No, the monogram 'VGPCo.' was not used after that."

GEORGE W. ARMSTRONG, JR., testified for The Baldwin Company substantially as follows:

I am president of The Baldwin Company, was one of the organizers of The Baldwin Company and of The Valley Gem Piano Company, have been an officer and director of both companies since their organization. I was a member of the firm of D. H. Baldwin & Company from 1883 to its dissolution in 1907.

Cross-examination:

The Valley Gem Piano Company never had any factory or property of any kind at any time except the name "Valley Gem." It had no plant. It never sold pianos. Pianos marked "Howard" were made and sold by The Ellington Piano Company. It bought the name "Valley Gem" for $100 from a man named Early, but bought no business, good-will or tools, or other property, with the name. The members of the firm of D. H. Baldwin & Company organized The Valley Gem Piano Company with the name "Valley Gem" as its only asset. It was the only property the company ever had.

The Baldwin Company acquired all the stock of The Valley Gem Piano Company from the members of D. H. Baldwin & Company, and this was the only "transfer or taking over" which took place. The Valley Gem Piano Company was incorporated about 1894 or 1895.

"X Q. 84. The trade-mark that you have been talking about, and which you have called 'Howard,' consisted of the word 'How-
33 ard' coupled with the initials 'VGPCo.' did it not?

"A. Yes.

"X Q. 92. What did it do—what was its business?

"A. The Valley Gem Piano Company was a corporation that had the pianos made in the Ellington factory, and it was designed to have another make, or line as we call it in the piano business.

"X Q. 93. It never made any pianos itself at all?

"A. It had no active manufacturing existence.

"X Q. 96. It never had any plant?

"A. No, we always manufactured right in the Ellington piano factory.

"X Q. 97. It never sold the pianos itself?

"A. No.

"X Q. 98. The Ellington Company made the pianos?

"A. The Ellington Company made the pianos.

"X Q. 99. And they sold them to D. H. Baldwin & Company?

"A. Yes.

"X Q. 100. And The Valley Gem Piano Company never made any of the pianos, that is your understanding?

"A. Yes.

"X Q. 101. And never handled any of them? They were always made by The Ellington Company?

"A. Yes, in a department by themselves.

"X Q. 114. Did it have any physical assets of any kind?

"A. No, the trade name (Valley Gem) I consider was an asset.

"X Q. 115. That was all they ever had?

"A. Yes, and that I thought was of real value.

"X Q. 116. Was that the only thing they ever had?

"A. Well, practically speaking.

"X Q. 117. Did you buy any machinery, tools or anything else when you bought that (Valley Gem) name from Early?

"A. No.

"X Q. 118. Just the name?
"A. Yes.
"X Q. 173. When was it that you discontinued the initials 'VGPCo.'?
"A. I don't recall.
"X Q. 174. Well, ten years ago, or five years ago, or when?
"A. I don't recall. I haven't the faintest recollection.
"X Q. 175. But you don't use that any more?
"A. No.
"X Q. 176. You abandoned that?
"A. Yes.
"X Q. 177. And it has been several years since you have used them?
"A. I don't recall when the date was.
"X Q. 178. When you changed the name of The Valley Gem Company to The Howard Piano Company didn't you abandon the initials 'VGPCo.'?
"A. I suppose so; that would be the most natural thing to do.
"X Q. 179. When you did discontinue it you didn't intend ever to take it up again?
"A. The 'VGPCo.'—no."
"X Q. 143. Pianos are usually called by the principal name on them, like 'Steinway, etc.?
"A. Yes, the surnames generally.
"X Q. 144. The surname is the name commonly designating the piano?
"A. Yes.

34 H. Clarence Dickinson testified on behalf of The Baldwin Company substantially as follows:

I am forty-nine years old, live in Chicago, am vice-president and a director of The Baldwin Company and of its subsidiary corporations, and have been such since August, 1912, and have been connected with D. H. Baldwin & Co. and The Baldwin Company for the last thirty-one years.

Cross-examination:

"Our piano is known as the Howard piano and no matter what monograms or decorations might be placed around the name it would still be called a Howard piano. The piano known to all as the Steinway piano really has Steinway & Sons stenciled on the fallboard, but I have never heard any one call it the Steinway & Sons piano, but simply call it the Steinway piano."
"X Q. 63. That is, it makes no difference what the form of the letters is that form the word Howard, you claim the exclusive use of the word 'Howard' in any form of letters?
"A. We do.
"X Q. 66. I show you Applicant's Exhibit No. 11 which is a photograph of the piano, and ask you if you think the marking on that piano would be sufficient to distinguish it from your goods?

"A. I do not. The piano is marked on this exhibit Howard & Co., Boston Cabinet Grand, on the fall board. Especially in view of the fact that the name is not cast in the iron plate of this piano.

"X Q. 67. I show you Applicant's Exhibit No. 65, which is a transfer bearing the words 'R. S. Howard Co., New York,' and ask you if you think such a transfer on pianos would sufficiently distinguish those pianos from goods of your manufacture?

"A. It would to a dealer who is in the piano business and knows the different makes of pianos, but it might not to a purchaser of pianos if an unscrupulous dealer should claim it to be the original Howard piano.

"X Q. 68. I show you Applicant's Exhibit No. 27, which is a photograph of a part of a piano showing the marking on the fall board which bears the words 'R. S. Howard & Co., Boston, Cabinet Grand,' and ask you if that marking, if put on pianos, would sufficiently distinguish such pianos from those of your manufacture?

"A. They would to the dealer who knows of the different makes of pianos, but it might not to the retail purchaser if the dealer should claim that it is the original Howard piano.

"X Q. 69. Would it sufficiently distinguish pianos from those of your manufacture to the ordinary retail purchaser without any representation one way or the other by the dealer?

"A. The retail purchaser might be under the impression that he was purchasing one of the Howard pianos made by us instead of the piano described by you.

"R. D. Q. 76. So far as you are personally concerned and as an officer and director of The Baldwin Company, do you object to R. S. Howard or any other person by the name of 'Howard' using his own proper name on the fall board of pianos made by him, 35 and in giving your answer please state your reasons fully.

"A. I would object to it, because we have built up a considerable trade in the Howard pianos and the selling of any piano with the name 'Howard' on it, no matter how it may be added to or embellished, might cause some interference with our trade and the loss of some of it."

Howard E. Wurlitzer testified for The Baldwin Company substantially as follows:

I am forty three years old and am president of The Rudolph Wurlitzer Co. of Cincinnati, O., manufacturers and dealers in pianos and musical instruments with whom I have been connected since 1890; handle several makes of pianos.

Cross-examination:

"The piano is always known by the surname or name that it is advertised in," * * * "the prefixing of initials," or "additions of such words as 'Co.' or '& Co.', or 'Company'," would make no difference, 'such pianos are generally known in the trade by the family surname."

FRANK A. MCGEE testified on behalf of the Baldwin Company substantially as follows:

I live in Cincinnati, O.; forty five years old; am secretary and auditor of The Howard Piano Company, The Ellington Piano Company, and a director and assistant treasurer of The Baldwin Company, and have been such since 1912. Previous to that I was manufacturing auditor and have been continuously with these companies since 1902. I first began to work for D. H. Baldwin & Company in May 1892 and did work at intervals for them until October 1895.

"Q. 164. State, if you know, how long the present form of transfer with the monogram 'HPCo.' has been in use?

"A. Just as soon as we could secure the transfer from the manufacturer after The Valley Gem Piano Co. name was changed to The Howard Piano Co. We may have used some of the old Valley Gem Piano Co. transfers even after the receipt of the new transfers in order to use up the old ones or to secure a better quality or design of transfer with the initials 'HPCo.'"

The name of The Valley Gem Piano Company was changed to The Howard Piano Company October 12, 1912.

The business and accounts of The Baldwin Company, The Howard Piano Company, The Ellington Piano Company, and The Hamilton Piano Company are kept entirely separate as distinct corporations, and conduct their affairs as distinct and separate corporations, and such has been the fact since my connection with them.

36 LEANDER S. SHERMAN testified on behalf of the R. S. Howard Company substantially as follows:

I live in San Francisco, Cal.; age 67, have been in the piano and musical merchandise business for 44 years, am partner and one of the founders of Sherman, Clay & Co., at San Francisco. Have dealt in a large list of pianos of different makes, including the "Howard" piano which I commenced handling about twenty-five years ago. First dealt in Howard pianos purchased from Mr. R. S. Howard who was then representing the New England Piano Company.

These first pianos had the name of R. S. Howard and were manufactured by the New England Piano Company.

Witness identified "a Howard piano manufactured by the New England Piano Company" (Applicant's Exhibit No. 25), showing the marking "R. S. Howard & Co., Boston, Mass."

"It is a Howard piano of which we have sold many hundreds of them and bears the number 36726. It looks like hundreds of others I have seen."

We purchased "Howard" pianos made by the New England Piano Company for a period of six or seven years and ceased to get these pianos about the middle of the 90's. The "Howard" piano bought through Mr. R. S. Howard from the New England Piano Company "took a prominent place in our line of instruments." We

would speak of these as "Howard pianos" without using the initials. Customers do not remember the initials of pianos.

FRANK T. BOWERS testified on behalf of the R. S. Howard Company substantially as follows:

I live in Belvedere, Cal., am 47 years old, and have been in the piano business in San Francisco since 1886 and dealt in many makes of pianos. I remember the Howard pianos made by the New England Piano Company.

"If I remember rightly, these pianos had the name R. S. Howard & Co." "We had Howard pianos from time to time in stock, either taken in exchange, or by purchase, and I have seen the pianos in houses where I had occasion to do business." "The reason I speak of being able to identify the Howard piano (made by New England Piano Company), the characteristics of both case and plate, is that those I have in mind had peculiar trusses, which I never saw on any other piano, and the plate had a peculiar scroll decoration which was also peculiar to the pianos."

Identifies the piano (Exhibit No. 25) as a piano made by the New England Piano Company.

ERASTUS P. LA SELLE testified on behalf of the R. S. Howard Company substantially as follows:

I live in Richmond, Cal., age 50; furniture and piano dealer in Richmond, Cal. I have been handling pianos all my life and owned the "Howard" piano (Exhibit No. 25) and had a half dozen of these pianos in my store about 26 or 27 years ago.

37 FRANK ANRYS testified on behalf of the R. S. Howard Company substantially as follows:

I live in San Francisco, Cal., age 61, general manager of Wiley B. Allen Company, piano dealers, of San Francisco. I have known of the "Howard" pianos since 1893, first in Portland, Oregon, and Salem, Oregon; afterwards in San Francisco.

JAMES E. WHITNEY testified on behalf of the R. S. Howard Company substantially as follows:

I live in Portland, O., am 50 years old, bookkeeper for Wiley B. Allen Company, Portland, Oregon, dealers in pianos and talking machines, with whom I have been for twenty-six years. That concern handled may different makes of pianos. Began handling the "Howard" piano about 1890 or 1891, which were sold to this concern by Mr. R. S. Howard. These pianos were referred to and commonly known as "Howard" pianos. The "Howard" pianos purchased from Mr. Howard made by the New England Piano Company were marked with the name "Howard" but there might have been some other marking, as New York. "All I recollect is the name of Howard. If there were any other markings there, I

do not remember." "I do not remember any initials before the name 'Howard' or '& Co.' after."

FRANK J. HART testified on behalf of the R. S. Howard Company substantially as follows:

I live in Los Angeles, Cal.; age 53. I have been in the piano business in Los Angeles continuously since 1887, now one of the officers of the Southern California Music Co. of Los Angeles, dealers in musical instruments. Have known Mr. Robert S. Howard since 1888. I knew the "Howard" piano made by the New England Piano Company and became acquainted with this piano in 1892 by purchasing some from Mr. R. S. Howard which were marked R. S. Howard and we dealt in those pianos very extensively for those days. These pianos were usually or commonly indicated or designated as "Howard" pianos. Purchased pianos through Mr. Howard from the New England Piano Company for several years after 1892, just how many years I do not recollect.

A. G. BARTLETT testified on behalf of the R. S. Howard Company substantially as follows:

I live in Los Angeles, Cal.; age 64; oil merchant. I was in the piano business from 1875 to 1909, and handled pianos made by several different makers. I have known Mr. Robert S. Howard since about 1887 or 1888; he was in the piano business at that time and is still in it. I first knew of the Howard piano in 1892 or 1893. Mr. Howard sold us a few samples at that time and some were stenciled Howard.

38 EDWARD A. GEISSLER testified on behalf of the R. S. Howard Company substantially as follows:

I live in Los Angeles, Cal.; am 48 years old. I have been in the music business since 1883; with Sherman, Clay & Company, San Francisco, from 1883 to 1901; from 1901 to date (October, 1914), with George J. Birkel Music Company of Los Angeles, Cal., as vice president and manager. I have dealt in a number of different makes of pianos both in San Francisco and Los Angeles. As an employee of Sherman, Clay & Co. handled "Howard" pianos bought from Mr. R. S. Howard beginning about the year 1888 or 1889. From 1889 to 1901 met Mr. Howard once or twice each year during which time Mr. Howard was selling the "Howard" piano. The "Howard" pianos I first saw were marked on the name board with the name "Howard," and may have contained other wording but I could not give the detail of it if there was any other, "but to the best of my recollection the stencil was the name Howard."

J. F. SALYER testified on behalf of the R. S. Howard Company substantially as follows:

I live in Los Angeles, Cal.; am 51 years old. I have been in the piano business for thirty five years and have dealt in a great number of different makes of pianos. Bought some "Howard" pianos in 1893 from the New England Piano Company through Mr. Howard, and in 1899 some pianos were turned over to me for rental and sale, which included three "Howard" pianos made by the New England Piano Company (the numbers are given). I am morally sure that the Howard pianos made by the New England Piano Company were marked simply with the name "Howard" alone.

"These were marked simply with the word 'Howard' to my recollection."

I do not remember the shape of the letters.

"I never dealt in the New England Piano to my knowledge. The only transaction I ever had with the New England Piano Company was through Mr. Howard, and that was for Howard pianos through the New England account in 1893."

F. W. BLANCHARD testified on behalf of the R. S. Howard Company substantially as follows:

I live in Los Angeles, Cal.; am 50 years old. I was in the piano business from 1886 to 1899, in Los Angeles, California, and dealt in many different makes of pianos including the "Howard" piano purchased from Mr. Howard in about 1892 and continued to handle the "Howard" piano up to 1899. A Howard piano was a piano purchased through R. S. Howard, or consigned from Sherman, Clay & Company and was commonly referred to and designated as the "Howard," and customers knew the piano by the name on the fall board. The pianos purchased from the New England Piano
39 Company through Mr. Howard were marked R. S. Howard & Company and stenciled Clark & Blanchard; the name of Clark & Blanchard was put on at our request.

GEORGE S. MARYGOLD testified on behalf of the R. S. Howard Company substantially as follows:

I live in Los Angeles, Cal.; am 54 years old, a farmer, formerly in the piano business from 1887 to 1914. Dealt in several makes of pianos including the "Howard" piano. Bought six "Howard" pianos in the spring of 1892, which had the name Howard on the fall board, from the New England Piano Company through Mr. R. S. Howard. I do not remember the marking on the "Howard" pianos purchased through R. S. Howard in 1892, and "can only recollect the fact that the name Howard is on the fall board of each piano in large, plain gold letters."

WILLIAM S. LANNEAU testified on behalf of the R. S. Howard Company substantially as follows:

I live in Charleston, S. C.; am 45 years old, merchant, in the art business at Charleston, S. C. I was in the piano business with Henry Siegling, retail piano dealer of Charleston, S. C., from June, 1893, to September, 1897, who handled pianos of several different makers, including "Howard" pianos purchased from Mr. R. S. Howard which were commonly designated and referred to as "Howard" pianos. Identified a number of entries made in his own handwriting in the piano register of Henry Siegling of "Howard" pianos which were handled by Henry Siegling and purchased from Mr. R. S. Howard. The first entry is Nov. 3, 1894.

JOHN FORREST GREER testified on behalf of the R. S. Howard Company substantially as follows:

I live in Charleston, S. C.; am 63 years old; manager of Siegling Music House, Charleston, S. C., with which I have been connected thirty nine years as manager; Siegling Music House, formerly Henry Siegling, have been dealers in pianos, organs and musical goods during the entire period, dealing in pianos of several different makers, including "Howard" pianos purchased from R. S. Howard personally, and marked with the name "Howard" and "Howard & Co.," which were first handled in 1894.

PLATT P. GIBBS testified on behalf of the R. S. Howard Company substantially as follows:

I live in Chicago, Ill.; am 61 years old, at present with the Chicago Music Company, Chicago. Have been dealing and handling pianos since 1868 in Chicago. I have known Mr. Robert S. Howard since 1880, at which time he was a piano salesman working for the same concern with me. I know that he was selling a piano with the name Howard upon it during the time he was with the New England Piano Company and was in the factory of the
40 New England Piano Company while Mr. Howard was connected with that concern, and at that time I saw pianos in their factory with the name Howard upon them. This was during the years 1888 to 1892.

CHARLES A. SCHLICHTER testified on behalf of the R. S. Howard Company substantially as follows:

I live in Burlington, Iowa; am 50 years old, vice president of the Guest Piano Company of Burlington, Iowa. I have been in the piano business since 1882 with James A. Guest, and his successor Guest Piano Company of Burlington, dealers in pianos, organs and general musical goods. Handled many different makes of pianos including Howard, which I handled in the early '90's purchased from Mr. R. S. Howard whom I have known for twenty five years or more, who represented the New England Piano Company at

that time. Produced record book (Applicant's Exhibit 36), showing entries of "Howard" pianos, one purchased April 5, 1890, one purchased January 11, 1891, and the third purchased June 22nd, 1891. I do not remember if there was a prefix or suffix, I simply remember the word Howard on the fall board.

JAMES VAUGHAN testified on behalf of the R. S. Howard Company substantially as follows:

I live in Detroit, Mich.; am salesman for Grinnell Bros., general musical business, Detroit, Michigan. Have been in the piano business since 1881, all the time in Detroit. Was connected with the Detroit Music Company from 1881 up to 1894, or 1895, as General Manager the latter part of the time. Detroit Music Company were dealers in general musical instruments including pianos. Identified journal or day book of the Detroit Music Company in which, on page 274, are entries of two Howard pianos which are original entries, under date of Oct. 13, 1894, and which read: "Folio 118, New England Piano Co., Howard & Co., Style D, 61448, $125.00; Style E, Mahogany, 60289, $145; Total $270."

EDWIN A. KIESELHORST testified on behalf of the R. S. Howard Company substantially as follows:

I live in St. Louis, Mo.; am 41 years old, president of the Kieselhorst Piano Company, dealers in pianos and musical instruments, St. Louis, Mo., have been in the piano business since 1891 with my father up to 1895, when my father died. Identified original book of entry containing record of accounts of various piano manufacturers. Pages 74 to 78 of this book contain entries of pianos purchased from the New England Piano Company of Boston, of New England pianos and "Howard" pianos, the first "Howard" piano being under the date of March 17th, 1890, Style E, 38558, and the last entry of a "Howard" piano under date of March 11th, 1893, D, 56437, and that there are entries of 60 "Howard" pianos in the book. My father purchased "Howard pianos" from the New England Piano Company during the time I was employed by
41 him, which pianos were marked on the fall board "R. S. Howard & Co., Boston" all in Old English letters. Some of the entries in this book are in my own handwriting.

JOHN E. MULVEY testified on behalf of The Baldwin Company substantially as follows:

I live in Boston, Mass.; age 50. Was employed from 1884 to 1897, in charge of the shipping of pianos from the New England Piano factory. The New England Piano Company began to mark pianos "Howard" after Robert S. Howard came there, and marked these Howard pianos all the time that Howard was there, and that "they were the New England piano with Howard's name on them." The marking on the piano was "Howard, Boston, Mass."

NOBLE E. HILL testified on behalf of The Baldwin Company substantially as follows:

I live in Boston, Mass.; age 59; piano worker with Henry F. Miller & Sons, formerly with the New England Piano Company, from 1894 until 1904. They used many stencils for marking pianos, including "Howard," "just plain 'Howard.'"

J. H. BRENNER testified on behalf of The Baldwin Company substantially as follows:

I live in San Francisco, Cal.; age 61. I have been in the piano business since 1887; formerly a member of the firm of Day, Hart & Brenner, afterwards incorporated as the Southern California Music Company, Los Angeles, Cal. For the last six years I have been employed by The Baldwin Company. The first Howard pianos which I sold were sold in 1893, when I was with the Southern California Music Company. These pianos were sold to me by Robert S. Howard, and were made by the New England Piano Co.

CHARLES H. DEWING testified on behalf of The Baldwin Company substantially as follows:

I live in Oakland, Cal.; age 57. I have been in the piano business since 1890, was with Sherman, Clay & Co., in its San Francisco store, from January 15, 1890, to April 18, 1896. During the years 1890 to 1896 Sherman, Clay & Co. were handling pianos marked on the fall board with a name which contained the word "Howard," and I saw the pianos in the store during those years, both at San Francisco and Oakland.

GEORGE A. HEIDINGER testified on behalf of The Baldwin Company substantially as follows:

I live in Portland, O.; manager for Eilers Music Company, Portland, since 1900; prior to that with Wiley B. Allen Company, from 1892 to 1900. Wiley B. Allen Co. handled some New England pianos under the names, "R. S. Howard, New England," and some other names, which I cannot now remember. The pianos with the name "Howard" on them, made by the New England Piano Company, were called "Howard"; the only name on the fall board which I remember is "Howard." Wiley B. Allen Co. began buying the R. S. Howard piano before I went with that concern.

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FERGUS COALTER testified on behalf of The Baldwin Company substantially as follows:

I live in Salt Lake City, Utah; age 61; dealer in pianos and musical merchandise since 1880; connected with several concerns in Salt Lake City. First Howard pianos which I purchased were from Robert S. Howard, made by the New England Piano Company, and were marked "Howard," I believe. I purchased these, to the best of my

recollection, in 1889 to 1890-1891; in that four years in there. I only remember the word "Howard" on them.

LUCIEN WULSIN testified on behalf of The Baldwin Company substantially as follows:

I am and have been Treasurer of The Baldwin Company since December, 1913.

Cross-examination:

"X Q. 91. Were the five letters which I now show you written by The Baldwin Company?

A. They are signed by The Baldwin Piano Company, two of them are signed by me. The other three are signed by one of the men in our office. Yes, they were written by us."

Letters indentified offered in evidence and marked "Applicant's Exhibit No. 111," and two of the letters are set out in full below; the other three letters are substantially verbatim copies of the first letter set out below, and addressed and dated as follows: one to Messrs. Lit Brothers, Philadelphia, Pa., dated January 30, 1915; one to Seigling Music House, Charleston, S. C., dated February 4, 1915; and one to George B. Kennedy, Washington, D. C., dated January 30, 1915.

Evidence: Applicant's Exhibit No. III.

(Letterhead of the Baldwin Piano Company.)

"Cincinnati, January 29, 1915.

"Mr. Sheridan Daboll, Rochester, New York.

"DEAR SIR: We have just been advised that you are advertising both in newspapers and on your show windows, pianos purchased from the R. S. Howard Company, as 'Howard' pianos without marks or words to distinguish them from the pianos bearing the trade-mark which was duly registered by us in the U. S. Patent Office, and write to inquire whether or not these advertisements were made with the knowledge and consent or direction of the R. S. Howard Company of New York.

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"Your early reply will be appreciated. Very truly yours, The Baldwin Piano Company. E. P. H." E. P. H./R.

(Letterhead of the Baldwin Piano Company.)

"Cincinnati, February 10, 1915.

"Messrs. S. & C. G. Daboll, 156 E. Main St., Rochester, N. Y.

"GENTLEMEN: We have your letter of February 2nd, and are disappointed in not receiving your assurance that you would discontinue

advertising pianos manufactured by the R. S. Howard Company of New York as 'Howard' pianos.

"The use of the word 'Howard' as applied to pianos made by the R. S. Howard Company without marks or words to distinguish them from the pianos of our manufacture is not correct. We must insist that it be made clear as by the use of distinguishing initials that the R. S. Howard Company pianos sold by you are not our product and that this distinction be maintained in all advertising matter, bills, correspondence and conversation with customers.

"We have owned the trade-mark 'Howard' for a great many years, and will take all necessary steps to protect our rights against infringement. Yours truly, The Baldwin Piano Company. Lucien Wulsin."

(Here follow Applicant's Exhibits Nos. 64 and 65 and Registrant's Exhibits Nos. 26, 27, 37, and 38, marked pages 42*a*, 42*b*, 42*c*, 42*d*, 42*e*, and 42*f*.)

44 **Opinion.**

District Court of the United States, Southern District of New York.

Equity. 13-75.

THE BALDWIN COMPANY

vs.

R. S. HOWARD COMPANY.

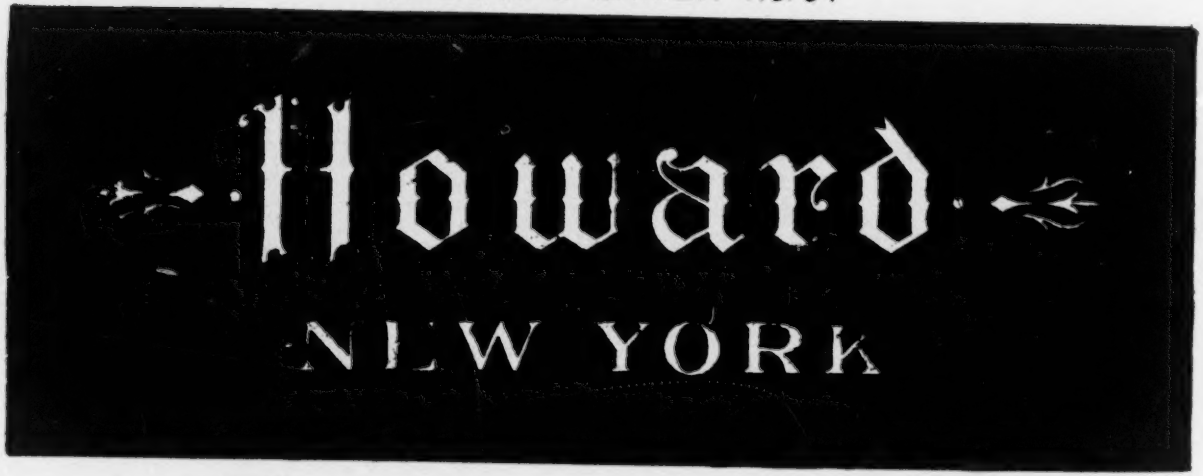
Final hearing in Equity, plaintiff suing for infringement of trade-mark 31,411 registered May 8, 1898; also of trade-mark 46,993, registered October 17, 1905; also of the name "Howard" as a common law trade-mark for pianos, and for unfair competition in that the defendant uses, or threatens to use the name "Howard" in marking, and in connection with the sale of pianos, as distinguished from the name "R. S. Howard Company," "R. S. Howard Co.," or "R. S. Howard."

The registered trade-mark referred to cover the word "Howard" as applied to pianos, the earlier one in connection with certain initials indicative of the selling corporation, and the later one the same word displayed in a peculiar or distinctive manner of type.

The prayer of the bill is for the usual relief, and in addition that defendant be enjoined from further prosecuting certain cancellation proceedings now pending in the Patent Office in respect of the said two trade-marks.

The plaintiff Company is the successor in interest, title and busi-

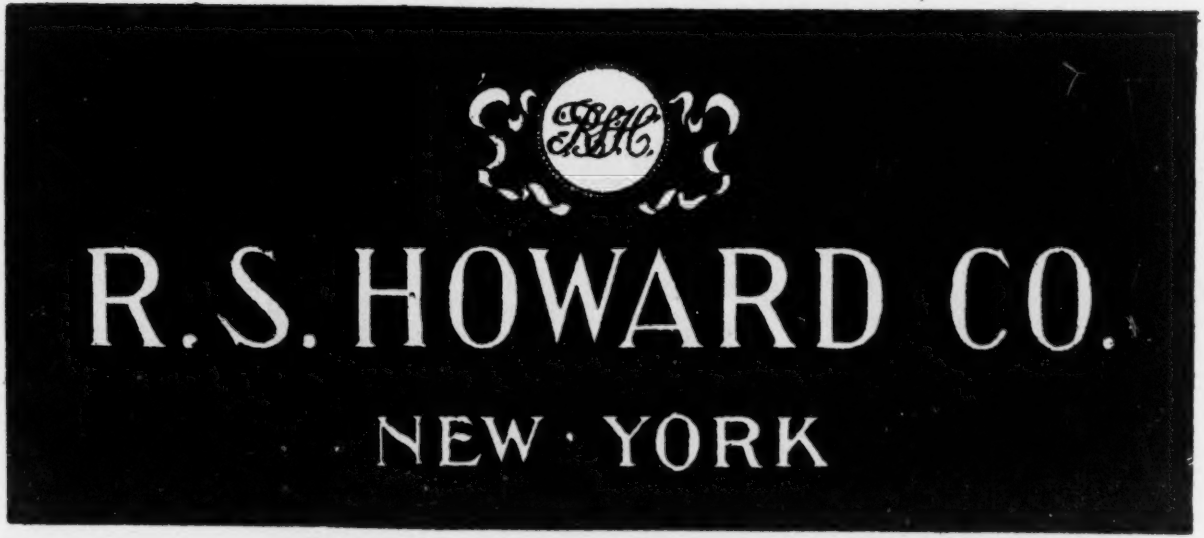
Evidence
APPLICANT'S EXHIBIT No. 64



R. S. Howard Company used this marking for pianos since 1902.

42-a

Evidence
APPLICANT'S EXHIBIT No. 65



90

42-b

R. S. Howard Company claims to have used this marking for pianos since 1902 (except monogram.)

Evidence.

REPRODUCTION OF REGISTRANTS' EXHIBIT No. 70 26

87

42-c

Marking for Pianos which The Baldwin Company claims it has used since 1912.

Evidence
REPRODUCTION OF REGISTRANTS' EXHIBIT No. 42 27.

42-d

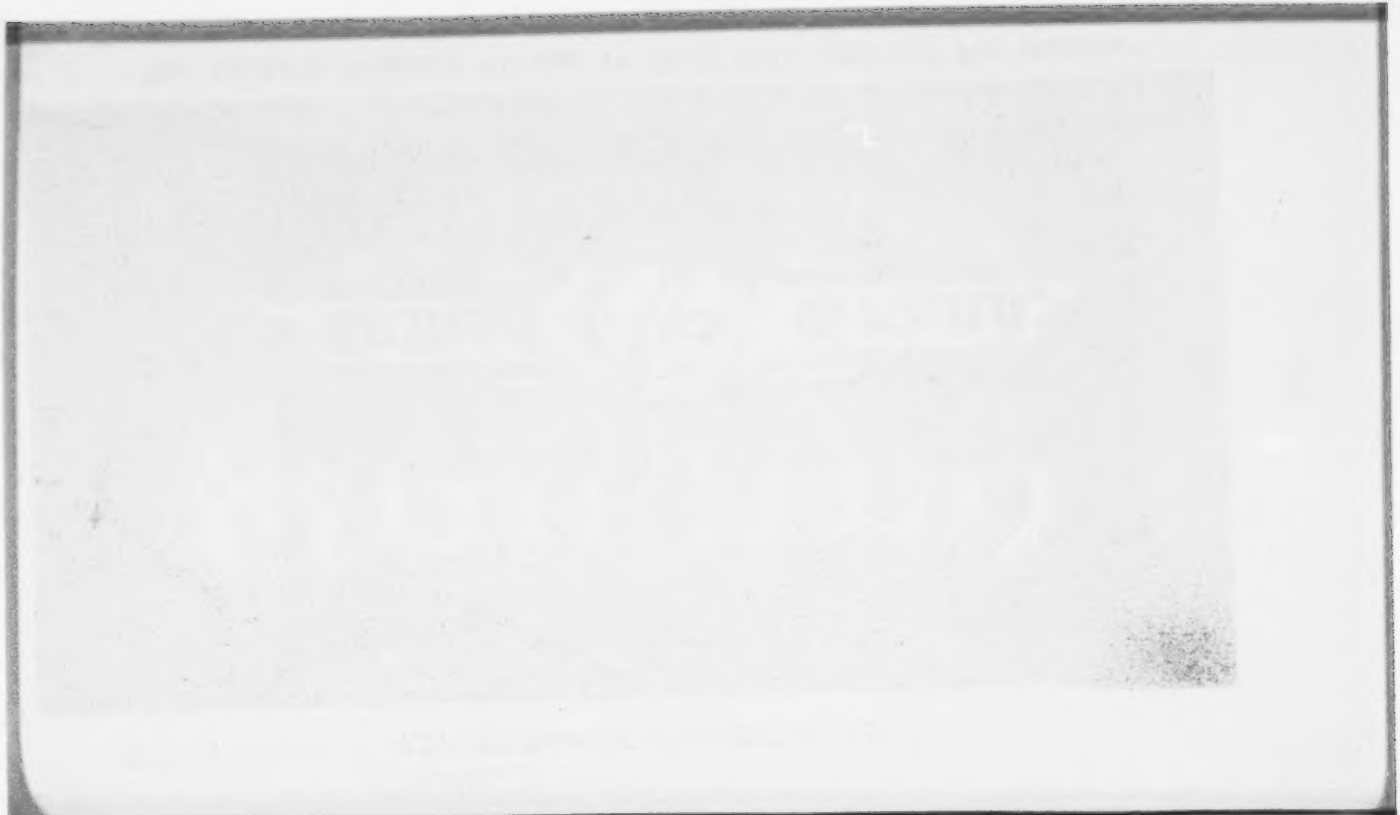
Marking for Player-Pianos which The Baldwin Company claims it has used since 1912.

REPRODUCTION OF Evidence REGISTRANTS EXHIBIT No. ~~39~~ 37.

86

The Baldwin Company claims it used this marking for pianos prior to 1912.

A2-8



Evidence

REPRODUCTION OF REGISTRANTS' EXHIBIT No. ~~41~~ 38.

88

42-I

Marking for pianos which The Baldwin Company claims it has used since 1912.

ness of the concerns (interalios) which registered said two trade-marks. Those concerns either made or sold (or both) pianos marked conspicuously "Howard" and known as Howard pianos. Since 1896 the plaintiff and its predecessors in title and business have pursued this trade, and the mark "Howard" has always been associated with a continuous trade which now belongs to plaintiff. The foregoing is so abundantly proven (and to a large extent undisputed) that the whole line of corporations or partnerships antecedent in business to the present plaintiff will be hereinafter spoken of as the "Baldwin Co." or the "Baldwin concern."

The defendant Company was organized in 1902 for the purpose of manufacturing and selling pianos. In it Mr. Robert S. Howard was and always has been the controlling spirit. The Company (so to speak) was made out of a piano factory in the city of New York plus the selling ability and salesman's reputation of Mr. Howard.

The defense is that the R. S. Howard Company is the successor of Mr. Howard, who was the first to adopt and use the name "Howard" as a mark for pianos in the year 1889; that he so continued until 1902, when he transferred his business, including the trade-mark or mark or name "Howard" to the defendant, which has continued to use that name down to the time this suit began.

Defendant therefore counterclaims and prays for affirmative relief in that it may be adjudged to be the sole owner and entitled
45 to the exclusive use of the name "Howard" as a trade name or trade-mark applied to pianos, and that the plaintiff be enjoined from using that name or the name "Howard Piano Company" in connection with the manufacture and sale of pianos, and also from registering the name "Howard" as a trademark in foreign countries, and be compelled to cancel the existing registrations in the Patent Office.

Lawrence Maxwell, Edmund Wetmore, John E. Cross, and Oscar W. Jeffery, for plaintiff;
Samuel S. Watson, for defendant.

HOUGH, *D. J.*:

The cancellation proceedings above referred to were brought long before this suit, and the record herein largely consists of the evidence taken in the Patent Office by both parties. It is exceedingly voluminous, and descends into great detail. About these details there is that uncertainty, if not contradiction in non-essentials, which must always be the case when even intelligent and well-intentioned men testify regarding occurrences of many years ago.

After perusing the entire record, however, I am of opinion that as to all relevant facts (in the sense of visible or audible phenomena) there is almost no difference between the parties hereto. Contradictions exist, but they are rather in the inferences to be drawn from what was said or written than in respect of the happening of this or that event. I shall, therefore, make the findings of fact herein comparatively brief.

Mr. Robert S. Howard began his active career as a piano tuner

in Ohio about 1877. He plainly developed ability far beyond the usual as a salesman, until in 1889 when he entered the employment of the New England Piano Company of Boston, I have no doubt that Mulcahy (one of the principal employees of the New England concern) testified accurately when he said that though he had never before met Mr. Howard, he had known of him for years as a piano salesman and traveller, and "we" (the New England people) "all congratulated ourselves on making the connection with him."

Nor is it doubted that Mr. Gibbs of Chicago, who has known Howard for a long time, correctly described him as a "very popular and prominent traveller and well liked by the trade."

The New England Company manufactured pianos in a Boston factory, one entrance to which was on Howard Street. There are indications that this fact had something to do with the use of the name "Howard" by that concern; but undoubtedly the principal and controlling reason for selling pianos of their make with any variant of the word "Howard" on the "fall-board" was due to the fact that Mr. Robert S. Howard wished to have it done when he became a salesman for the Company.*

The New England Piano Company's product consisted of two grades of pianos. The superior quality bore and was sold
46 under its own name; the inferior product (consisting of about 40 per cent of the output) was given any name that any customer wished, and Mr. Howard's selection of his own name was but one instance of a common but harmless trade deception. It assisted Howard in selling pianos. The position of the purchaser is amusingly stated by Scanlon, who, when he was asked as to how a man who bought the piano knew the maker, replied, "You will have to ask that question of the fellow who sold it to him; I never attempted to explain that."

The first consignment of pianos bearing any variant of the name "Howard" went from the New England factory to the Pacific Coast in 1889, and I have no doubt from the testimony of Howard himself and from that (Inter alios) of Fox of Chicago, and Dierks of Pittsburgh, that Howard represented that the pianos he was selling were "made for him" by the New England Piano Company. This statement was not true. Mr. Howard did give to Scanlon and others his views as to how a piano should be regulated, both as to tone and action, and he probably also expressed opinions as to what constituted an attractive case; but it amounted to no more than what Scanlon testified to, viz: that it was always his custom with anybody that he employed to represent the concern outside, to have them go to the factory, see how the product was created, and "We were always glad to get suggestions, and always ready to try the suggestions."

The New England Company's piano that Howard sold was simply

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*The New England Piano Company was the trade name of one Scanlon but it will be spoken of throughout this Opinion by its corporate sounding title.

its second quality instrument, and he was a salaried employee. He did not buy the pianos, nor sell them at his own risk. Indeed Howard himself testified (in the cancellation proceeding and before this suit was brought), "I never worked on a commission in my life." But he was paid a stipulated salary by the New England Company, which salary was not based on the number of pianos sold in any year, although he did get (apparently as a gratuity) $1,000 more than his agreed salary the first year he worked for the New England concern, and thereafter his salary was increased from year to year.

In 1894 Howard transferred his allegiance to Fischer & Company, but until 1896 or 1897, whenever he got a chance to sell a piano with the Howard mark upon it he did so and sent in the order to the New England Company. Scanlon says this ceased about 1897; it probably stopped in 1896. No other salesman except Howard sold pianos with the "Howard" mark upon them. No "royalty" was ever paid for the use of this name, but, as Howard himself testified, the sales were made "for the good of the New England Piano Company's business as a whole."

There is no doubt that from the time any variant of "Howard" was inscribed upon pianos the retail trade, the user and the public generally spoke of them as "Howard" pianos; but there is no completely satisfactory proof that the New England Company ever put out any piano bearing the word "Howard" alone. There is evidence that it was done, but after the most careful search, but one specimen of such a piano has been found in the whole United States, and I do not think that the exact date of this piano has been clearly shown.

47 It is found that any use of the word "Howard" on the fallboard of a piano made by the New England Company was sporadic; but there were thousands sold under the title "R. S. Howard & Co.," "Howard, New York," "Howard & Co., Boston," and "R. S. Howard & Co., Boston." After 1896 the New England Company completely ceased using any variant of the word "Howard;" whatever right to title they had in or to that name was abandoned.

In that year Howard entered the employment of the Baldwin concern. The arrangement was oral, and with a Mr. Wulsin, who died before suit was brought. Howard says that pianos bearing his name were to be manufactured for him at an agreed price, of which he had a memorandum, and he was to be credited with the difference between that price and the price he obtained for them; which was the same arrangement that he had had with the New England Company. He guaranteed all the pianos and purchased outright from the Baldwin Company a good many instruments, which he either sold to dealers or consigned to them.

This testimony is untrue, because he never had any such arrangement with the New England Company, and it is utterly inconsistent with his previous oath that he never worked on a commission in his life. The account books produced by the plaintiff persuade me that until 1899 Howard did work on a commission; he did sell pianos bearing the name "Howard" with the adjuncts set forth in the first registered trade-mark; but he also sold all the other makes pro-

duced by plaintiff* if he could; and any other salesman for the plaintiff sold "Howards" if he found a market for them.

It is true that if Mr. Howard found a customer whom he liked and would take a risk on he guaranteed the account; but the sale was always made by the plaintiff, and the business of selling was the plaintiff's; and it was not until 1896 that the word "Howard" alone was habitually and extensively used on the fall-board of any piano.

In 1899, by written agreement, Howard became a salaried salesman for plaintiff, and within the territory allotted to him continued to do just what he had done from 1896-1899. In 1902 he resigned from plaintiff's employ, established the defendant Company, and began to put out pianos uniformly marked on the fall-board with the corporate name. I am of the opinion that there is no evidence that defendant corporation has ever put the word "Howard" alone on the fall-board of a piano; but there is no denial of the statement that beginning in or about 1913, the name "Howard" unaccompanied by any initials or addendum was placed upon the back of the piano.

The result of the foregoing is that with the exception of a few sporadic instances of which only one has (even by defendant's contention) been located the only piano labelled on its front with the word "Howard" (simpliciter) ever put forth is plaintiff's instrument, of which the sales have grown from about $140,000 in 1896
48 to upwards of a million dollars in 1914. This business is the result of the energy of the plaintiff, undoubtedly assisted from 1896-1902 by Mr. Howard for which assistance he was fully paid at rates presumably satisfactory to himself.

The foregoing findings of fact (if correct) leave the case resting upon legal principles so simple as to require but little discussion.

In and prior to 1896, if anybody had or could have a trademark in the word "Howard" or any variant thereof as applied to pianos, the New England Piano Company had it. Whatever that Company had it abandoned.

If Howard's story of the relations established by him with the Baldwin concern in 1896 were true, a good deal might be said in favor of the proposition that he had a trademark.

But not only is the statement untrue because inconsistent with other testimony of his own, and with the account books of the plaintiff (as above shown), but it largely consists in Howard's narration of what Mr. Wulsin said to him on his becoming a Baldwin salesman. This evidence is obviously obnoxious to Section 829 of the New York Code of Civil Procedure; but if considered such consideration renders Mr. Wulsin's report to his corporation of the circumstances of Howard's employment competent evidence.

Having regard to the probabilities of the matter and to the contra-

*It is to be remembered that the word "Plaintiff" as used herein covers not only the Baldwin Company, but all its predecessors in business, and assignors of business.

dictions of Howard's testimony, I have no doubt that, as Wulsin stated, it was "clearly understood that the use of this name ("Howard") gives no rights to Mr. Howard other than his privilege to sell to dealers acceptable to us—his compensation being price received in excess of $95 for style 7."

If Howard had no business when he entered the Baldwin employ, and his agreement with plaintiff was as above found, he certainly created no business during his period of employment in the sense that must be assigned to that word in order to sustain trademark rights.

Down to 1902 Howard was not a manufacturer, a jobber or a retailer of pianos; he was a salesman, receiving (as he says) a salary only; or (as I believe) sometimes a salary and sometimes a commission, perhaps at times both; but always and all the time his relation to his employers was exactly that of a highly favored clerk who sells (for example) neckties over a counter, and being a well-dressed man himself is permitted to call one of his employer's styles of neckties by his own name.

That there can be no such thing as a transfer of a trademark in gross is too true to need citation to support it. If in 1902 Howard had no established business of his own he had no trademark.

That Mr. Howard had an established and well tested capacity to get business and make business is an entirely different thing; this he had, and this, and this alone, he contributed to the R. S. Howard Company. It seems to have turned out a valuable contribution. But because he had not business other than his own active mind and winning ways in 1902, he could not hand over to the defendant any rights even in his own name which were appurtenant to and dependent upon a business of manufacturing, buying and selling
49 belonging to him. As above pointed out, he was not even a jobber, and never had been, and therefore the case much relied upon by defendant of Nelson vs. Winchell, 203 Mass., 75, is inapplicable.

What Howard did have in 1902 was the undeniable right to use his own name in his own business, and this he has done, and this is all he hoped to do (in my judgment) until about 1904, when he began to talk with plaintiff's New York representative about getting sole control of the name "Howard." He followed up this thought in 1905 by beginning two actions in the Supreme Court of this State against plaintiff and some of its officers. The complaint in that case is instructive. It sets forth over Howard's verification that since 1889 Howard had manufactured or caused to be manufactured and sold a style of piano "created by him" which he caused to be marked with the name "Howard." That in 1897 after Howard had been manufacturing or causing to be manufactured and sold pianos bearing this name of "Howard" for upwards of eight years, he entered into an agreement with D. H. Baldwin & Co., whereby that concern "agreed to manufacture said pianos bearing the name "Howard" for said Robert S. Howard." And finally this complaint states that in consideration of this agreement he permitted

Baldwin & Co. to use his name "Howard" upon pianos manufactured by them for sale in their stores.

It is further instructive to compare this verified complaint with defendant's verified application to cancel plaintiff's trademarks herein. In that application it is said that in 1889 and prior thereto Howard was engaged in New York in the sale of pianos manufactured for him, and in that year he adopted "Howard" as his trademark for the pianos manufactured for him and sold by him, and that he continued to have pianos so manufactured and marked continuously until the time he transferred said trademark, together with his business of manufacturing and selling pianos to the defendant herein.

The pleadings in the New York Court, in the Patent Office and in this Court when compared with the testimony appear to me to furnish a very strong confirmation of the result in matters of fact above attempted to be set forth.

This course of pleading and defendant's line of argument all rest, I think, upon the assumption that a trademark or trade name is something that belongs to the first devisor thereof through every change of his business relations, and follows him like a Patent or a Copyright. On this point the recent decision in Hanover Co. vs. Metcalf, 240 U. S. 403, is perhaps sufficient authority. My own views I have set forth at some length in Carroll vs. M'Ilvaine, 171 Fed. Rep., 125, aff'd 193 Fed. Rep., 82, and lately in President Suspender Co. vs. McWilliams, Opinion dated January 10, 1916.

The net result is that plaintiff, and plaintiff alone, is entitled to use the word "Howard" (simpliciter) on the fall-board of pianos, in the name of the Company that manufactures those pianos or handles them or sells them, and in advertising matter re-
50 lating to pianos. Similarly the defendant and defendant alone is entitled to use "R. S. Howard" or "Robert S. Howard" in like manner. In other words their relations to the word "Howard" must remain as heretofore, and as acquiesced in by both parties until in 1914 Mr. Howard began the cancellation proceedings in the Patent Office.

I am inclined to think if this Court has the power, it is inadvisable to seek to prevent the continuance of the cancellation proceedings in the Office.

It is plain to me that the object of these proceedings is primarily to get rid of something which constitutes an obstacle to the extension into certain foreign countries (e. g. Cuba and Uruguay) of the business of the R. S. Howard Company.

I doubt whether under our law the name "Howard," being a not infrequent surname and place name, can be appropriated as a strict trademark. I have no doubt that the original registration in 1898 was made with the full knowledge and consent of Mr. Robert S. Howard. He admits the knowledge; the consent is implied from the course of business. But if he could not make a strict trademark out of his own name, I am unable to see how anybody else could do it even with his consent.

The defendant's counterclaim must be dismissed with costs, and the plaintiff given a decree with costs; but I incline to ground that decree solely on principles of unfair competition, and leave the trade-mark situation to take care of itself; but upon this point I am willing to hear further argument if the matter is pressed, as it was not much alluded to in argument. C. M. Hough, D. J. May 15, 1916.

District Court of the United States, Southern District of New York.

Equity. 13-75.

THE BALDWIN COMPANY

vs.

R. S. HOWARD COMPANY.

Memorandum on Settlement of Final Decree.

Memorandum.

After reflection, I am convinced that the proper order should preserve that status of the parties to this suit which existed until the defendant began to stamp "Howard" merely on the back of its pianos and to encourage advertising (if not to advertise itself) under the name "Howard" alone.

The defendant has never used "Robert S. Howard" or "R. S. Howard" without the suffix "Company" or "Co." There is
51 no reason why it should do it; there is no evidence that it has any right to do it—although Mr. Howard could doubtless create that right (so far as he is concerned) at any moment.

The plaintiff has the superior right, and that superior right can best be maintained by requiring the suffix "Company" or "Co." to be used by the defendant.

I have therefore signed the decree as propounded by plaintiff. C. M. Hough, D. J. May 23, 1916.

Memorandum.—Decree of United States District Court is set out in full in Paragraph 7 of the Amended Bill of Complaint.

United States Circuit Court of Appeals for the Second Circuit, October Term, 1916.

No. 130.

Argued October 4, 1916. Decided November 14, 1916.

THE BALDWIN COMPANY, Complainant-Appellee,

v.

R. S. HOWARD COMPANY, Defendant-Appellant.

Appeal from the District Court of the United States for the Southern District of New York.

Before Coxe, Ward, and Rogers, Circuit Judges.

Opinion.

On appeal from a decree of the District Court for the Southern District of New York in an action brought by the Baldwin Company against the R. S. Howard Company for unfair competition by reason of the use by the defendant of the Complainant's trade-mark "Howard" upon pianos not made or sold by the complainant. The opinion of the District Court is reported in 233 Fed. Rep. 439.

Lawrence Maxwell, Edmund Wetmore, John E. Cross and Oscar W. Jeffery, for Complainant-Appellee.
Samuel S. Watson, for Defendant-Appellant.

COXE, *J.*:

This is an action in equity upon the trade-mark "Howard" as applied to pianos. The custom of the trade is to stencil the name upon the front of the piano just above the keyboard and also upon the cases in which the pianos are shipped. The question here is whether the R. S. Howard Company, the defendant, has a right to use the word "Howard" as a trade-mark in connection with
52 sales of pianos manufactured by it. That it may use its own name, R. S. Howard Company, is not disputed, but the contention is that the complainant has a right to the use of the name "Howard" alone as applied to the fall-board of the pianos manufactured by it because of its long use and also because of the defendant's acquiescence in that use. The Baldwin Company adopted the name "Howard" alone to designate pianos sold by it in 1896 with the full knowledge of R. S. Howard and procured the trade-mark in that name with his acquiescence. It has built up a large and flourishing business in this manner, with the knowledge of R. S. Howard and it would now be most inequitable to permit him to destroy this business and reap the fruits thereof by transferring a large part thereof to himself. He has a perfect right to use his own

name, R. S. Howard, in the piano business but he has not at this late day the right to appropriate the good will of the complainant's business by the use of the trade-mark "Howard," which has by long use come to mean the pianos sold by the complainant.

The name "Howard" without prefix or suffix, when used in connection with pianos indicated that they were the product of the Baldwin Company, the complainant herein. There can be no doubt as to the wide publicity given by the complainant to the "Howard" piano and the large sales made by it under that name. In other words it was the enterprise, energy, capital and brains of the complainant company that established and maintained the reputation of the Howard Piano and that company is entitled to have its rights protected. The facts necessary to understand the situation are fully set out in the opinion of Judge Hough and need not be repeated here.

The appellant disputes the validity of the trade-mark registrations but it is contended that the validity of these registrations is not in issue in this case, at least so far as this court is concerned. The appellee's brief contains the following:

"The appellant's brief attacks the plaintiff's right to its trade-mark registrations, but the validity of the registrations is not in issue in the case. At the final hearing below, plaintiff did not claim infringement of its registrations and confined its charge of infringement solely to its common law rights in the name 'Howard,' and Judge Hough at the close of his opinion said:

"'I incline to ground that decree solely on principles of unfair competition, and leave the trade-mark situation to take care of itself; but upon this point I am willing to hear further argument if the matter is pressed, as it was not much alluded to in argument.'

"The matter was not pressed by either side and therefore there is no finding about it in the decree. It was evidently the opinion of the court below that all questions concerning the validity of the registrations should be left to the Cancellation Proceedings instituted by the R. S. Howard Company in the Patent Office and now about to come to final hearing there."

We are inclined to think that the court was not called upon to hear what were practically moot questions not essential to a de-
53 cision and which, even if decided according to the appellant's contention, would not affect the controlling question in the least.

The decree of the District Court is affirmed.

Concurring Opinion.

WARD, *Circuit Judge* (concurring):

I concur in the opinion of the court but think we should go further. The complainant set up in its bill ownership of a trade-mark for the word "Howard" registered under the Act of 1881 and of another such trade-mark registered under the Act of 1905, and prayed that it might be declared the exclusive owner of both. The

defendant in its answer alleged that both these trade-marks were registered without authority of law and in its counterclaim prayed for affirmative relief, viz., that such registrations be declared invalid. This is relief we have power to grant, and I think we should do so because as to the trade-mark registered under the Act of 1881 there is no evidence that it was ever used in commerce with foreign countries or with the Indian tribes, and as for the trade-mark registered under the Act of February 20, 1905, it was a surname and not used for ten years before the passage of the act, or displayed in such a particular or distinctive manner as to fall within the exception contained in Section 5 and so was not entitled to registration. The defendant duly assigned error to the decree in this respect and argued the question in its brief and at the hearing.

(Here follow reproductions of original folios 53*a*, 53*b*, 53*c*, 53*d*, 53*e*, 53*f*, 53*g*, 53*h*, 53*i*, 53*j*, 53*k*, 53*l*, 53*m*, 53*n*, 53*o*, 53*p*, 53*q*, 53*r*, and 53*s*.)

Final hearing October 9, 1916.

In the United States Patent Office.

Cancellation No. 301.

R. S. Howard Company

v.

The Baldwin Company.

Pianos.

Opinion and Order of Examiner of Interferences.

Registration No. 46,993, Issued Oct. 17, 1905.

Mr. Samuel S. Watson, for R. S. Howard Company.

Messrs. Steuart & Steuart and Mr. John E. Cross, for The Baldwin Company.

This is a petition by the R. S. Howard Company to cancel trade-mark registration No. 46,993 issued to The Baldwin Company October 17, 1905.

54 In another proceeding (cancellation No. 302) the R. S. Howard Company seeks to cancel trade-mark registration No. 31,411, issued to the Valley Gem Piano Company March 8, 1898, which registration is also now owned by The Baldwin Company.

The two proceedings are so closely related, and the matters to be decided are so nearly identical, that only one record has been compiled, and the cases have been submitted and tried as one. Only

$10 RECEIVED
APR 4 1905
CHIEF CLERK U.S. PATENT OFFICE

Serial No. 394 Paper No. 19

Application

LETTER OF ADVICE.

TO THE COMMISSIONER OF PATENTS:

The undersigned present herewith a drawing and specimens of its lawful Trade-Mark, and request that the same, together with the accompanying statement and declaration may be registered in the United States Patent Office, in accordance with the law in such cases made and provided.

Your petitioner hereby appoints Arthur Steuart, James L. Steuart, Sidney R. Perry and Francis M. Phelps, a firm, doing business as STEUART & STEUART, (Registered No. 615) of Pacific Building, Washington, D. C., U. S. A., its Attorneys to represent it in the Patent Office of the United States, in causing the registration of said Trade-Mark, with power of substitution, and revocation, to sign the drawings or *fac-simile*, to receive the certificate of registration and to do all things necessary to be done in connection with securing the registration of its Trade-Mark in the United States Patent Office, as fully as it could have done if personally present.

THE BALDWIN COMPANY.
(Here sign name of firm or petitioner in full.)

By Lucien Wulsin Pres't
(A member of firm or officer of corporation.)

STATEMENT.

TO ALL WHOM IT MAY CONCERN:

APR 4 1905 CHIEF CLERK U.S PATENT OFFICE

Application

LETTER OF ADVICE.

To the Commissioner of Patents:

The undersigned present herewith a drawing and specimens of its lawful Trade-Mark, and request that the same, together with the accompanying statement and declaration may be registered in the United States Patent Office, in accordance with the law in such cases made and provided.

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THE BALDWIN COMPANY.
(Here sign name of firm or petitioner in full.)

By Lucien Wulsin Pres't
(If member of firm or officer of corporation.)

STATEMENT.

To all whom it may Concern:

Be it known that THE BALDWIN COMPANY, a corporation, organized and existing under the laws of the State of Ohio, having its principal place of business and domiciled at Eden Park Entrance, in the city of Cincinnati, in the State of said,

has heretofore adopted and used a Trade-Mark, of which the following is a full, clear, and exact description:

The Trade-Mark sought to be protected by the application in connection with and as part of which this statement is made is shown in the accompanying drawing, and consists of the arbitrary word "HOWARD" in connection with the initials "V C P Co" in the form of a monogram. These have generally been arranged as shown in the accompanying drawing, in which they appear, so far as the word "HOWARD" is concerned, in straight-line type of an ornamental old English style, beneath which in an ornamental panel or tailpiece, appear the initials "V C P Co" in the form of a monogram and the words "CABINET" and "GRAND" on each side of said monogram. Beneath the panel, in curved plain type, appears "Cincinnati, U.S.A.," but this latter, together with the words "Cabinet Grand", the panel, and the form of lettering of "Howard", may be differently arranged without materially altering the character of the trade-mark, the principal feature of which is the word "HOWARD".

53-a

This Trade-Mark has been used continuously in the business of said corporation and that of its predecessors since December 15, 1896.

The class of merchandise to which this Trade-Mark is appropriated is Pianos,

And the particular description of goods comprised in such class on which said corporation uses the said Trade-Mark is Pianos

It has been the practice of said corporation to affix the trade-mark to the pianos by printing, stenciling, or impressing it upon the fronts of the pianos just above the keyboard, or upon any other prominent and conspicuous part of the piano, also upon the boxes or cases in which the pianos are shipped, also to use it upon stationery, advertising matter, and in other usual and suitable ways.

(Here state fully manner of applying mark.)

per a

THE BALDWIN COMPANY,
(Here sign full name of person, firm or corporation.)

WITNESSES: Ne Strong
L A Sergent

By Lucien Wulsin
(Name and office of person signing for corporation)

DECLARATION.

State of OHIO, (State or Country.) County of HAMILTON, (County or City.) ss:

(Name of signer.) LUCIEN WULSIN

being duly sworn, deposes and says, that he is President of THE BALDWIN COMPANY the applicant named in the foregoing statement; that he verily believes the foregoing statement is true; that he believes THE BALDWIN COMPANY to be the owner of the mark sought to be registered; that no other person, firm, corporation, or association to the best of his knowledge and belief has the right to use the mark, either in the identical form or in any such near resemblance thereto as might be calculated to deceive; that the Trade-Mark is used by THE BALDWIN COMPANY in commerce among the several States ~~and particularly between the State of Ohio and the State of~~ (and) ~~(or)~~ between the United States and foreign nations and particularly between the United States and Canada; and that the description, drawing and specimens presented, truly represent the Trade-Mark sought to be registered; [~~and that the mark has been in actual and exclusive use as a Trade-Mark by the applicant or his predecessors from whom he derived title for ten years next preceding the passage of the Act of February 20th, 1905.~~]

(Position of signer, member of firm, or officer of corporation.)

(Erase this clause if mark has not been in use for ten years.)

Lucien Wulsin
(Sign full personal name of affiant.)

Sworn and subscribed before me this 31st day of March 1905

A P Hagemeyer
Notary Public.

NOTARY PUBLIC, HAMILTON COUNTY, OHIO

[NOTARY SEAL.]

53-b

2—236.

Room No. 189.
All communications should be addressed to "The Commissioner of Patents, Washington, D. C."

Paper No. 1. - R.
All communications respecting this application should give the serial number, date of filing, and title of invention.

DEPARTMENT OF THE INTERIOR.

M.A.D. UNITED STATES PATENT OFFICE,

WASHINGTON D. C., April 13, 1905.

The Baldwin Company,

Care of Steuart & Steuart,

Pacific Building,

Washington, D. C.

U. S. PATENT OFFICE,
APR 13 1905
MAILED

Please find below a communication from the EXAMINER OF TRADE-MARKS regarding your application for Trade-Mark filed Apr. 4, 1905, Ser . No. 394.

F. I. Allen
Commissioner of Patents.

The drawing in this application is informal. A lined drawing in india ink is required.

The word "specification" in the preamble, should be changed to "description."

The mark should be described as shown in the drawing, omitting all statements as to general arrangement and variations in the form in which the mark is presented.

All reference to the use of the mark upon stationery and advertising matter should be canceled.

The controlling feature of applicant's mark is the word "HOWARD," an ordinary surname. The mark is, therefore, not registrable as presented. Applicant should proceed under the ten-year proviso of the Trade-Mark act of February 20, 1905.

Registration is refused on the trade-mark of The Valley Gem Piano Company, 31,411, Mar. 8, 1898.

Adlayman

53-C

Serial No. 394 Paper No. 1
Amendt A & Affdt.

ARTHUR STEUART,
JAMES L. STEUART,
SIDNEY R. PERRY,
FRANCIS W. PHELPS.

U.S. PATENT OFFICE.
SPECIALTIES:
PATENTS, TRADE-MARKS AND COPYRIGHTS.
JUN 6 1905
DIVISION 33.

LAW OFFICES
OF
STEUART & STEUART.

NEW YORK, 141 BROADWAY.
BALTIMORE, MARYLAND TRUST BUILDING.
WASHINGTON, PACIFIC BUILDING.

LONG DISTANCE TELEPHONES.

In the United States Patent Office.

Trade-Mark

In the matter of the application for ~~patent~~ of The Baldwin Company, for the arbitrary word "HOWARD" &c.

Filed April 4, 1905.

Serial No. 394.

Room No. 159. Washington, D. C., June 2, 1905.

Hon. Commissioner of Patents,

Sir:

Communication from the Examiner in charge of the above case dated April 13, 1905, has been received.

Please amend this case as follows:

A lined drawing in India Ink on Bristol Board is filed, herewith, kindly cancel the drawing now on file.

In the statement, second paragraph, kindly cancel the words "full, clear, and exact specification" and insert the word "description".

In the third paragraph, kindly cancel the words "or specification"

Line 3 of the statement, after the words "State of" insert the word "Ohio".

In the description of the mark, after the word "HOWARD" first occurrence, cancel the balance of the description of the mark beginning with the words "in connection with" down to the bottom of the page, and insert in lieu thereof the following: "in straight line type of an ornamental old English style"

Page 2, lines 11 and 12, cancel the words "upon stationery, advertising matter, and"

A reconsideration is respectfully requested. The application in this case is presented under Section 5, of the

act of February 20, 1905, which provides for the registration of the name of an individual, firm, corporation, or association, when written, printed, impressed, or woven in some particular or distinctive manner.

The Trade-Mark of The Valley Gem Piano Company, registered Mar. 8, 1898, No. 31,411, together with the good-will of the business in connection with which the same was used was transferred to and is now the property of THE BALDWIN COMPANY, the applicant in this case, as is shown by the affidavit of Mr. Lucien Wulsin, attached hereto.

Respectfully submitted,

Stewart & Stewart
for applicant

IN THE UNITED STATES PATENT OFFICE.

IN THE MATTER OF THE APPLICATION OF	:
The Baldwin Company, for the registration of the Trade-Mark consisting of the word "HOWARD".	:
Filed April 4, 1905,	:
Serial No. 394.	:

AFFIDAVIT OF Lucien Wulsin

State of Ohio, County of Hamilton, to-wit:

Lucien Wulsin

being duly sworn deposes and says that he is President of THE BALDWIN COMPANY the applicant in the abovenamed application for the registration of the word "HOWARD" as a trade-mark for Pianos; that he was President of the Valley Gem Piano Company when that corporation adopted the said Trade-Mark and applied it to pianos and used it continuously until the good-will, business and Trade-Marks of The Valley Gem Piano Company were transferred to and become the property of THE BALDWIN COMPANY; and that THE BALDWIN COMPANY is now the exclusive owner of the said Trade-Mark, and of the good-will and business in connection with which the same has been used since the 15th day of December, 1896.

And further this deponent sayeth not.

Lucien Wulsin

Subscribed and sworn to before me, a Notary Public, in and for the County of Hamilton and State of Ohio, this 22 day of ~~April~~ May, 1905.

A. P. Hammerer
Notary Public.
Hamilton County Ohio

53-f

2—236.

Room No. 159.
All communications should be addressed to "The Commissioner of Patents, Washington, D. C."

J.R.S.

Paper No. 3--Raj.
All communications respecting this application should give the serial number, date of filing, and title of invention.

DEPARTMENT OF THE INTERIOR.

UNITED STATES PATENT OFFICE,

WASHINGTON D. C., June 14, 1905.

The Baldwin Company,

Care of Steuart & Steuart,

Pacific Building,

Washington, D. C.

U.S. PATENT OFFICE
JUN 14 1905
MAILED.

Please find below a communication from the EXAMINER OF TRADE-MARKS regarding your application for Trade-Mark, filed April 4, 1905; Ser. No. 394.

F. I. Allen
Commissioner of Patents.

The amendment of the 6th instant has been incorporated.

Registration of the word HOWARD is refused for the reason that it is merely the name of an individual. The application should be presented under the ten year proviso of the Trade-Mark act.

Acting Examiner.

53-g

Serial No. 394 Paper No. 4

Amdt R

ARTHUR STEUART,
JAMES L. STEUART,
SIDNEY H. PERRY,
FRANCIS G. PHILLIPS.

LAW OFFICES
OF
STEUART & STEUART.

U. S. PATENT OFFICE,
JUN 19 1905
DIVISION 33.

In the United States Patent Office.

Trade-Mark

In the matter of the application for ~~patent~~ of The Baldwin Company, for the name "HOWARD" printed in the distinctive ornamental old English type shown.

Filed April 4, 1905,

Serial No. 394,

Room No. 159. Washington, D. C., June 17th, 1905.

Hon. Commissioner of Patents,

Sir:

Communication from the Examiner in charge of the above case dated June 14, 1905, has been received.

Please amend this case as follows:

In the description of the mark, erase the words "the arbitrary word", and insert in lieu thereof the words, "the name "HOWARD" printed in the distinctive ornamental old English type shown"

We present this mark under section 6, clause (b) under the second proviso of the Act of April 20, 1905, which permits the registration of the names of individuals if printed "in some particular or distinctive manner".

Respectfully submitted,

Steuart & Steuart

53-h

2-236.

Room No. 159.
All communications should be addressed to "The Commissioner of Patents, Washington, D. C."

J.R.S.

Paper No. 5--F.R.
All communications respecting this application should give the serial number, date of filing, and title of invention.

DEPARTMENT OF THE INTERIOR.

UNITED STATES PATENT OFFICE,

WASHINGTON D. C., June 29, 1905.

The Baldwin Company,
Care of Steuart & Steuart,
Pacific Building,
Washington, D. C.

U. S. PATENT OFFICE.
JUN 29 1905
MAILED.

Please find below a communication from the EXAMINER OF TRADE-MARKS regarding your application for Trade-Mark, filed April 4, 1905; Ser. No. 394.

F. I. Allen
Commissioner of Patents.

The amendment of the 19th instant has been incorporated.

This case has been further considered and it is held that th mark claimed is not a distinctive mark and, therefore, not registrable under the act of February 20, 1905. (See decision in ex parte A. Featherstone & Co., 86 O. G., 1497).

Registration is again, and finally refused.

T. A. Durand
Acting Examiner

53-1

Serial No. 394 Paper No. 6

Amended

ARTHUR STEUART,
JAMES L. STEUART,
SIDNEY R. PERRY,
FRANCIS M. PHELPS.

SPECIALTIES:
PATENTS, TRADE-MARKS AND COPYRIGHTS

LAW OFFICES
OF
STEUART & STEUART.

NEW YORK, 141 BROADWAY.
BALTIMORE, MARYLAND TRUST BUILDING.
WASHINGTON, PIONEER BUILDING.

LONG DISTANCE TELEPHONES.

U. S. Patent Office

JUL 29 1905

Trade-Marks and Designs

In the United States Patent Office.

Trade-Mark

In the matter of the application for ~~patent~~ of

The Baldwin Company, for the name "HOWARD" &c.,

Filed April 4, 1905,

Serial No. 394,

Room No. 159. Washington, D. C., July 28, 1905.

Hon. Commissioner of Patents,

Sir:

Communication from the Examiner in charge of the above case dated June 29, 1905, has been received.

Please amend this case as follows:

Erase the words,"'HOWARD' in straight line type of an ornamental old English style", which were inserted by amendment of July 3rd, and insert in lieu thereof the following:

"which consists of a capital "H" of a peculiar ornamental design, having a depending tail from the upper end of the left vertical bar, and from the lower end of the right vertical bar, and having vertical lines crossing the cross bar of the "H". All of the letters have pointed lateral projections in the centers of all vertical bars." so that the description of the mark will read:-

C. S.	The name "HOWARD" printed in the distinctive ornamental old English type resembling ~~type shown~~, which consists of a capital "H" of a peculiar ornamental design, having a depending tail from the upper end of the left vertical bar, and from the lower end of the right vertical bar, and having vertical lines crossing the cross bar of the "H". All of the letters have pointed lateral projections in the centers of all vertical bars."

Respectfully submitted,

THE BALDWIN COMPANY,

By Steuart & Steuart

Its Attorneys.

53-1

D. 2—236. 188

Room No. 159
All communications should be addressed to "The Commissioner of Patents, Washington, D. C."

Paper No. 7 - L.
All communications respecting this application should give the serial number, date of filing, and title of invention.

DEPARTMENT OF THE INTERIOR.

UNITED STATES PATENT OFFICE,

WASHINGTON D. C. July 31, 1905.

The Baldwin Company,
C/o Steuart & Steuart,
Washington, D. C.

U.S. PATENT OFFICE, JUL 31 1905 MAILED.

Please find below a communication from the EXAMINER OF TRADE-MARKS regarding your application for Trade-Mark filed April 4, 1905, Ser. No. 394.

F. I. Allen
Commissioner of Patents.

On further consideration in connection with the amendment of the 29th instant, restricting the description to the precise form of mark shown, the application is held to be ready for publication, subject to the withdrawal of the fee for appeal, heretofore taken.

H. H. Stewart
Acting Examiner.

53-k

394 Letter 8

ARTHUR STEUART,
JAMES L. STEUART,
SIDNEY R. PERRY,
FRANCIS M. PHELPS.

SPECIALTIES:
PATENTS, TRADE-MARKS AND COPYRIGHTS

LAW OFFICES
OF
STEUART & STEUART.

NEW YORK, 141 BROADWAY.
BALTIMORE, MARYLAND TRUST BUILDING.
WASHINGTON, PACIFIC BUILDING.

LONG DISTANCE TELEPHONES.

In the United States Patent Office.

Trade-Mark

In the matter of the application for ~~PATENT~~ of

The Baldwin Company

Filed April 4, 1905,

Serial No. 394,

Room No. 159. Washington, D. C., August 1, 1905.

Hon. Commissioner of Patents,

Sir:

Communication from the Examiner in charge of the above case dated July 31, 1905, has been received.

We have today filed a request withdrawing the appeal in the above entitled application and request that this application be now passed to publication.

Respectfully submitted,

Steuart & Steuart
Attorneys.

53-1

TRADE-MARK DIVISION.
All communications should be addressed to "The Commissioner of Patents, Washington, D. C."

2—237.

M.L.F.

Paper No. 9

All communications respecting this application should give the serial number, date of filing, and title of invention.

DEPARTMENT OF THE INTERIOR,

UNITED STATES PATENT OFFICE,

WASHINGTON, D. C., Aug. 3, 1905.

The Baldwin Company,
c/o Steuart & Steuart,
Washington, D. C.

U. S. PATENT OFFICE,
AUG 8 1905
MAILED.

Your application for the Registration of a Trade-Mark for the name "HOWARD" printed in a distinctive manner, for pianos, filed April 4, 1905, Serial No. 394,

has been examined and passed for publication, in compliance with section 6 of the act authorizing the Registration of Trade-Marks, approved February 20, 1905.

The mark will be published in the Official Gazette of Aug. 22, 1905.

Any person who believes he would be damaged by the registration of this mark may oppose the same by filing notice of opposition, stating the grounds therefor, in the Patent Office within thirty days after the publication thereof, which said notice of opposition shall be verified by the person filing the same before one of the officers mentioned in section 2 of the act of February 20, 1905.

If no notice of opposition is filed within said time the Commissioner may issue a certificate of registration.

Copies of the Trade-Mark portion of the Official Gazette containing the publication of the mark may be obtained as soon as published at five cents each. Coupons are receivable therefor.

Respectfully,

F. I. Allen
Commissioner of Patents.

53-m

A. R. 2—186. No 394

Issue Division.
All communications should be addressed to "The Commissioner of Patents, Washington, D. C."

DEPARTMENT OF THE INTERIOR.

United States Patent Office,

Washington, D. C., Sept. 28, 1905 *190*

The Baldwin Company,

~~%~~ Steuart & Steuart,

City

SIR:

Your **APPLICATION** *for* **REGISTRATION OF TRADE-MARK** *for*

Pianos.

has been examined and allowed.

The **Certification of Registration** *will be issued and forwarded to you as soon as practicable, in due order of business.*

Very respectfully,

F. I. Allen
Commissioner of Patents.

53-n

Canceled June 6. 1905

Witnesses

Inventor
The Baldwin Company
By Stewart & Stewart
Attorney

53-0

TRADE-MARK.

No. 46,093. REGISTERED OCT. 17, 1905.

THE BALDWIN COMPANY.

PIANOS.

APPLICATION FILED APR. 4, 1905.

Howard.

Proprietor

The Baldwin Company

By Stewart & Stewart

Attorneys

53-p

UNITED STATES PATENT OFFICE.

THE BALDWIN COMPANY, OF CINCINNATI, OHIO.

TRADE-MARK FOR PIANOS.

No. 46,993. Statement and Declaration. Registered Oct. 17, 1905.

Application filed April 4, 1905. Serial No. 304.

STATEMENT.

To all whom it may concern:

Be it known that THE BALDWIN COMPANY, a corporation organized and existing under the laws of the State of Ohio, having its principal place of business and domiciled at Eden Park entrance, in the city of Cincinnati, in said State, has heretofore adopted and used a trade-mark, of which the following is a description.

The trade-mark sought to be protected by the application in connection with and as part of which this statement is made is shown in the accompanying drawing and consists of the name "HOWARD," printed in the distinctive ornamental type resembling Old English, which consists of a capital "H" of a peculiar ornamental design having a depending tail from the upper end of the left vertical bar and from the lower end of the right vertical bar and having vertical lines crossing the cross-bar of the "H." All of the letters have pointed lateral projections in the centers of all vertical bars.

This trade-mark has been used continuously in the business of said corporation and that of its predecessors since December 15, 1896.

The class of merchandise to which this trade-mark is appropriated is pianos, and the particular description of goods comprised in such class on which said corporation uses the said trade-mark is pianos.

It has been the practice of said corporation to affix the trade-mark to the pianos by printing, stenciling, or impressing it upon the fronts of the pianos just above the keyboard or upon any other prominent and conspicuous part of the piano, also upon the boxes or cases in which the pianos are shipped, also to use it in other usual and suitable ways.

THE BALDWIN COMPANY,
By LUCIEN WULSIN.

Witnesses:
M. STRONG,
L. D. SARGENT.

DECLARATION.

State of Ohio, county of Hamilton, ss:

LUCIEN WULSIN being duly sworn, deposes and says, that he is president of THE BALDWIN COMPANY the applicant named in the foregoing statement; that he verily believes the foregoing statement is true; that he believes THE BALDWIN COMPANY to be the owner of the mark sought to be registered; that no other person, firm, corporation, or association to the best of his knowledge and belief has the right to use the mark, either in the identical form or in any such near resemblance thereto as might be calculated to deceive; that the trade-mark is used by THE BALDWIN COMPANY in commerce among the several States (and) between the United States and foreign nations and particularly between the United States and Canada; and that the description, drawing and specimens presented, truly represent the trade-mark sought to be registered.

LUCIEN WULSIN.

Sworn and subscribed before me this 31st day of March, 1905.

[L. S.] A. P. HAGEMEYER,
Notary Public, Hamilton County, Ohio.

53-q

one opinion will therefore be prepared, and the whole situation as it applies to both proceedings will be discussed therein.

The earlier registration (No. 31,411) was issued under the Act of 1881, and is for the word "Howard," together with the letters "VGPCo." arranged in monogram, the lettering being Old English. Registration No. 46,993 was issued under the act of 1905 and is for the word "Howard" alone arranged in substantially the same type as the earlier registration. Both marks are for pianos.

After these petitions for cancellation were filed suit was brought by The Baldwin Company in the District Court of the United States for the Southern District of New York against the R. S. Howard Company, the petitioner herein, based upon the identical registrations the cancellation of which is sought in these proceedings. The suit was sustained and the court held the complainant, The Baldwin Company, entitled to the use of the word "Howard" alone on the fall-boards of pianos (The Baldwin Company v. R. S. Howard Company, 233 F. R., 439). This decision has since been sustained by the United States Circuit Court of Appeals for the Second Circuit (not yet in the Federal Reporter). It has thus been decided that The Baldwin Company is entitled to use "Howard" (simpliciter) while use by the R. S. Howard Company is limited to certain distinguishing characteristics such as "R. S. Howard," "Robert S. Howard," "R. S. Howard Company," or some familiar phrascology clearly distinguishing from the use allowed by The Baldwin Company. By reason of the decision in the suit it is contended on behalf of The Baldwin Company that the question of the right of the R. S. Howard Company to cancel these registrations is res adjudicata, and that the petitions should therefore be dismissed.

While the rights of the parties with respect to use of the word "Howard" have been settled, it does not necessarily follow that the right to cancel has been determined. In fact, both the trial court and the appellate court specifically passed over the question as one unnecessary for them to decide. Judge Ward, however, one of the judges constituting the appellate court, in a concurring decision, expressed himself as clearly of the opinion that the court should go further and decide the question of the validity of the registrations. It may therefore be regarded as definitely determined by the Circuit Court of Appeals of the Second Circuit that The Baldwin Company, the registrant and defendant herein, is entitled to use the word "Howard" (simpliciter) upon the fall-boards of pianos, whereas the R. S. Howard Company, the petitioner herein, is restricted to the use of "R. S. Howard," "Robert S. Howard," or "R. S.
55 Howard Company," etc. This decision is final and binding upon the parties. The exact rights of the parties as to their use of the name "Howard" are therefore now settled and determined. It is not necessary, therefore, for me to study and review the voluminous record with a view to reaching a conclusion upon this point. The matter is res adjudicata as between the parties.

A right, question or fact distinctly put in issue and directly determined by a court of competent jurisdiction as a ground of recov-

ery, cannot be disputed in a subsequent suit between the same parties or their privies; and even if the second suit is for a different cause of action, the right, question or fact once so determined, must, as between the same parties or their privies, be taken as conclusively established as long as the judgment in the first suit remains unmodified.

(Southern Pacific R. R. Co. v. United States, 168 U. S., 1, p. 48.)

If the R. S. Howard Company is not entitled to use "Howard" broadly, such company is not damaged by the registration unless for some reason not considered by the court.

Among the grounds set up for cancellation it is alleged that "Howard" is merely a common surname not distinctively written, and is also a geographical name, and therefore unregistrable as a trademark. But if it is settled that the R. S. Howard Company is not entitled to use the name "Howard," this company cannot be heard to urge such matters. It has no interest in the mark, and is in the same position as one of the general public (McIlhenny's Son v. New Iberia Extract of Tobasco Pepper Co., 133 O. G. 995; 30 App. D. C., 337; The Hump Hairpin Co. v. The De Long Hook & Eye Co., 190 O. G. 1032; 39 App. D. C. 484; Standard Brewing Company v. Interborough Brewing Co., 222 O. G., 728; 44 App. D. C., 193). The examiner is not called upon therefore to decide these matters.

It is also urged that the registration should be canceled because the name "Howard" is the essential part of the petitioner's name. But the Court of Appeals of the Second Circuit in the decision above referred to has definitely held that the registrant had used "Howard" upon its pianos long prior to the time the R. S. Howard Company began business, and that such use was with the knowledge and consent of R. S. Howard personally. The cases referred to in petitioner's brief do not go so far as to justify cancellation under such circumstances. The rule is that a party may not register as a trademark a word which is at the time of adoption the essential part of the name of another (The Asbestone Co. v. The Philip Carey Manufacturing Co., 200 O. G., 857; 41 App. D. C. 507); but a party cannot adopt as a part of its name the trade-mark of another, and then claim any special rights as against the trade-mark owner. While the petitioner herein claims superior rights to the name "Howard," the court in the equity suit has held otherwise.

Another ground set up as a basis for cancellation of registration No. 46993 is that such registration is being used as a basis for securing registrations in certain foreign countries. This question was not passed upon by the court and apparently was not presented in such a way as to require consideration. Therefore, notwithstanding the fact that the petitioner is limited to the use of "R. S. Howard," "Robert S. Howard," "R. S. Howard Company," etc., the mark might nevertheless be canceled should it be shown that the registration is used to secure rights abroad which work injustice to the petitioner when the petitioner marks its goods as re-

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quired by the court. In other words, if it appears that importation by the R. S. Howard Company into foreign countries of pianos marked "R. S. Howard," "Robert S. Howard," "R. S. Howard Company," etc., has been prevented, or adversely affected, by reason of The Baldwin Company's registration in such country or countries of the name "Howard" (*simpliciter*), it is believed that the petitioner would be damaged within the terms of the statute, and the registration would be canceled.

The burden of proving such injury is, however, upon the R. S. Howard Company, and the evidence which has been introduced upon this point is far from being conclusive. The Baldwin Company admits that certain registrations of the word "Howard" have been secured in various foreign states. The evidence is to the effect that the R. S. Howard Company had been doing a large piano business in certain of these countries and particularly in Cuba. It is asserted that one of this company's agents subsequently started in business for himself and secured from the United States pianos manufactured by The Baldwin Company and marked "Howard." Thereafter The Baldwin Company secured registration of the name "Howard" in Cuba, and thus prevented the R. S. Howard Company from selling pianos there. There is also testimony by an expert, one Barber, with respect to the trade-mark conditions in Latin-American countries. He states (Q. 4) that in certain of the countries prior registration in the United States is a prerequisite for citizens of the United States to secure registration in such countries, and that in certain of these countries it is a criminal offense to infringe registered trade-marks. This witness admits, however (X Q. 40) that the mere registration of "Howard" (*simpliciter*) by The Baldwin Company ought not in certain of these states at least to prevent the sale of goods by the petitioner when marked with its full name "R. S. Howard," "Robert S. Howard," "R. S. Howard Company," etc., but makes the comment that it is not always easy in these states to actually obtain those rights which the laws are intended to secure.

Thus while the petitioner's evidence tends to convey the idea that the registration of The Baldwin Company of the word "Howard" in Cuba and elsewhere is operating to the injury of the company, the evidence fails to show how the goods which it ships or has attempted to ship into these countries were in fact marked. It is not asserted that goods marked "R. S. Howard," "Robert S. Howard," or "R. S. Howard Company," etc., have been held up, and importation prevented by reason of The Baldwin Company's registration. If the goods were marked "Howard" alone and the right of entry
57 refused, it could not be held that the petitioner was damaged, because it has no right to use the name "Howard" (*simpliciter*).

The burden of proving the right to cancel, is upon the R. S. Howard Company. It has been definitely decided that said company cannot use "Howard" alone. In order to effect cancellation it must therefore show that it has in some manner been injured or is liable to be injured by The Baldwin Company's registration of "Howard"

when it itself has been marking its goods as the court has held it must mark them; that is, with its full name "R. S. Howard," "Robert S. Howard," or "R. S. Howard Company," etc. This the petitioner has failed to do.

The petition is dismissed, and it is hereby recommended that registration No. 46,993, issued October 17, 1905, to The Baldwin Company, should not be canceled.

Limit of appeal: July 20, 1917. H. E. Stauffer, Examiner of Interferences. June 30, 1917.

Memorandum.—Decision of Examiner of Interferences in reference to Registration No. 31,411 which was filed June 30, 1917, followed the decision respecting Registration No. 46,993, and dismissed the petition to cancel.

Hearing October 22, 1917.

In the United States Patent Office.

Cancellation Proceeding No. 301.

R. S. Howard Company

vs.

The Baldwin Company.

Opinion and Order of First Ass't Commissioner.

Appeal from Examiner of Interferences.

Trade-Mark of The Baldwin Company, registered October 17, 1905, No. 46,993.

Mr. Samuel S. Watson, for the R. S. Howard Company.

Messrs. Steuart & Steuart and Mr. John E. Cross, for The Baldwin Company.

The R. S. Howard Company has appealed from the decision of the Examiner of Interferences dismissing a petition to cancel trade-mark registration No. 46,993, issued to The Baldwin Company October 17, 1905.

In another proceeding (Cancellation No. 302) the R. S. Howard Company sought to cancel trade-mark registration No. 31,411,
58 issued to The Valley Gem Piano Company March 8, 1898, which registration is owned by The Baldwin Company.

The two proceedings are closely related. Only one record has been presented and the cases have been submitted and argued as one.

Registration No. 31,411, which was issued under the Act of 1881, is for the word "Howard" in old English letters, together with the letters "V. G. P. Co." arranged in a monogram. Registration No. 46,993, which was issued under the Act of 1905, is for the word "Howard" alone, appearing in substantially the same type as that

word appears in the earlier registration. Both registrations cover the use of the marks on pianos.

After these petitions for cancellation were filed suit was brought by The Baldwin Company in the Southern District of New York against the R. S. Howard Company, based upon these same registrations and also upon its common law rights. In addition to the other relief sought the plaintiff asked the prosecution of the cancellation proceedings be restrained. The R. S. Howard Company in a cross bill asked that the registrations be held invalid.

The Court denied the request for the prohibition of the prosecution of the cancellation proceedings, declined to pass upon the validity of the registrations, but held that The Baldwin Company was entitled to use the word "Howard" alone on pianos, and that the R. S. Howard Company was not entitled to use the word "Howard" alone but only the words "R. S. Howard Company," or the words "Robert S. Howard Company." The decision was affirmed on appeal, one of the judges in a concurring opinion holding that the registrations should both be declared invalid.

The Examiner of Interferences held that if the R. S. Howard Company is not entitled to use the word "Howard" alone, it was not damaged by the registrations unless for some reason not considered by the Court. He considered the question whether the registrations were invalid by reason of the fact that "Howard" was the essential part of the petitioner's name, but held that a party could not adopt as a part of its name the trade-mark of another and then claim any special rights as against that party. He also considered the question whether the R. S. Howard Company was damaged by the use of Registration No. 46,993, by The Baldwin Company as a basis for securing registration in certain foreign countries, and held that the R. S. Howard Company had not established any such damage.

In the decision of the District Court the relation of the parties is set out at length. It appears that R. S. Howard was a piano salesman and was connected with various piano companies; that for several years he was connected with The Baldwin Company and in 1902 organized the R. S. Howard Company and has been connected therewith ever since.

The decision in the suit determined fully the rights between these parties so far as the use of the name "Howard" is concerned. The R. S. Howard Company cannot use the word "Howard" alone, or prevent the use of the word "Howard" alone by The Baldwin
59 Company, and The Baldwin Company cannot prevent the use by the R. S. Howard Company of the words "R. S. Howard Company," or "Robert S. Howard Company."

It is well settled by a long line of decisions of the Court of Appeals of the District of Columbia that a party cannot sustain a cancellation proceeding unless he can establish that he is damaged by the registration of the mark. The rights of the parties to the use of the mark in this country having been fully determined by the Court it is not seen how the rights of the R. S. Howard Company are in any way affected by the registration. No suit could be sustained against the R. S. Howard Company for any use of the words "R. S. Howard

Company," or "Robert S. Howard Company," and it has no right to the use of the word "Howard" alone.

So far as the question of foreign registrations is concerned, there is no testimony that the R. S. Howard Company has in any way been interfered with in its trade in foreign countries where the pianos were marked with the name of the company, and they have under the Court decree no right to mark them otherwise. One of the witnesses testified that the trade of the agent of the R. S. Howard Company in Cuba would have been interfered with had the registration of the name "Howard" in Cuba been effected by the Baldwin Company, but it does not appear whether that testimony was based upon the fact that at one time R. S. Howard had marked pianos with the word "Howard" alone or not.

The witness Barber testified that the registration of the word "Howard" in certain South American countries might put an undue burden upon the R. S. Howard Company to sustain its right to sell pianos marked with the name of the company since it would be difficult to establish that the marks were not substantially the same.

As pointed out by the Examiner of Interferences, however, the burden is upon the R. S. Howard Company to establish the injury and if goods marked with the name of the company had been held up or the importation prevented, it was encumbent upon the company to show it, which has not been done.

It may be noted, as appears from the record and as stated in the decisions of both Courts, that the earlier registration was obtained with the full knowledge of R. S. Howard; that he made no objection to its registration and he made no objection to the use of the word "Howard" by the The Baldwin Company for several years after he left its employ. It is further to be noted that at one time a suit was brought in the Courts of New York by R. S. Howard to prevent the use of the word "Howard" by The Baldwin Company, but this suit was withdrawn and The Baldwin Company continued to use the word "Howard" for a number of years thereafter and built up a large trade without any objection on the part of R. S. Howard or the R. S. Howard Company until the cancellation proceeding was brought in 1914.

Attention is called in the Brief to the following statement of the Commissioner rendered on a petition:

> It is urged that the R. S. Howard Company has not shown the injury required by the statute. But if the mark is not registrable, I think any one who is legitimately using the name "Howard" on pianos is injured by the registration sufficiently to warrant cancellation proceedings.

That decision was rendered before the decision in the suit and expressly states that the person who would be injured by the improper registration is one who was "legitimately" using the name "Howard" on pianos. But the Court proceedings determines that the R. S. Howard Company has no right to use the word "Howard."

It is urged that the name "Howard" and the name "R. S. Howard Company," or "Robert S. Howard Company," are substantially the same, and therefore there would be likelihood of confusion. The best evidence, however, on this point is the fact that although The

Baldwin Company has continuously used the word "Howard" since a time prior to the organization of the R. S. Howard Company and the R. S. Howard Company has been in business since 1902, yet there is on the record no proof of any confusion.

It must be held, therefore, that the petition for cancellation was properly dismissed.

The decision of the Examiner of Interferences is affirmed. R. F. Whitehead, First Assistant Commissioner. Feb. 1, 1918.

MEMORANDUM.—Decision of Assistant Commissioner of Patents in reference to Registration No. 31,411 which was filed February 1st, 1918, followed his decision respecting Registration No. 46,993 and affirmed the decision of the Examiner of Interferences dismissing the petition to cancel Registration No. 31,411.

In the Court of Appeals of the District of Columbia.

Patent Appeal No. 1201.

R. S. HOWARD COMPANY, Appellant,

vs.

THE BALDWIN COMPANY,

and

Patent Appeal No. 1202.

R. S. HOWARD COMPANY, Appellant,

vs.

THE VALLEY GEM PIANO COMPANY (THE HOWARD PIANO COMPANY Substituted) and THE BALDWIN COMPANY.

Opinion.

These are cancellation proceedings brought by R. S. Howard Company, a corporation, against the Baldwin Company, a corporation. One is to cancel the certificate of registration of a trade-mark
61 consisting of the word "Howard" registered by the Baldwin Company on October 17, 1905, and the other is to cancel the certificate of registration for a trade-mark consisting of the word "Howard" in connection with the initials "VGPCo" arranged in monogram, registered by the Valley Gem Piano Company on March 8, 1898, and now owned by the Baldwin Company. Both marks were registered as trade-marks for pianos.

These cases were consolidated and heard together in the Patent Office, and will be so considered here. From the decision of the Commissioner denying the petition, the Howard Company appeals.

It appears that appellant corporation was organized in 1902, and that for a number of years prior to that R. S. Howard, the organizer of the corporation, had been an agent for the sale of pianos for the Baldwin Company. During that period, Howard sold pianos ex-

tensively throughout the country bearing the trade-mark "Howard." It appears, however, that pianos similarly marked were extensively *hold* by the Baldwin Company through other agencies than R. S. Howard. After its organization, the Howard Company sold pianos marked on the fall-board "R. S. Howard Company," and advertised itself extensively as manufactures of "Howard" pianos.

This resulted in a suit by the Baldwin Company against the Howard Company for unfair competition in the United States District Court for the Southern District of New York (233 Fed., 439), resulting in a decree restraining the Howard Company from making or selling pianos bearing the word "Howard" alone, but permitting it to use the marks "R. S. Howard Company" and "Robert S. Howard Company." The decree was affirmed by the United States Court of Appeals (238 Fed., 154).

While an attempt was made to involve the present proceeding in that case, the court refused to interfere with its course in the Patent Office. The district Judge, in his opinion, said: "I am inclined to think if this court has the power, it is inadvisable to seek to prevent the continuance of the cancellation proceedings in the Office. It is plain to me that the object of these proceedings is primarily to get rid of something which constitutes an obstacle to the extension into certain foreign countries (e. g. Cuba and Uruguay) of the business of the R. S. Howard Company. I doubt whether under our law the name "Howard," being a not infrequent surname or place name, can be appropriated as a strict trade-mark. I have no doubt that the original registration in 1898 was made with the full knowledge and consent of Mr. Robert S. Howard. He admits the knowledge; the consent is implied from the course of business. But if he could not make a strict trade-mark out of his own name, I am unable to see how anybody else could do it even with his consent." The Circuit Court of Appeals, referring to the validity of the trade-mark registration, said: "The appellee's brief contains the following: * * * 'The matter was not pressed by either side and therefore there is no finding about it in the decree. It was evidently the opinion of the Court below that all questions concerning the validity of the registrations should be left to the Cancellation Proceedings instituted by the R. S. Howard Company in the Patent Office and now about to come to final hearing there.' We are inclined to think that the court was not called upon to hear what were practically moot questions not essential to a decision and which, even if decided according to the appellant's contention, would not affect the controlling question in the least."

The court decisions can be dismissed from further consideration, since they were confined solely to the question of unfair competition, a matter of no concern in this proceeding, either by way of estoppel or otherwise. We are here dealing with the validity of the registration of the marks in question, in a proceeding in which the Commissioner of Patents is vested by statute with exclusive jurisdiction. Section 13 of the Trade-Mark Act of February 20, 1905, provides "That whenever any person shall deem himself injured by the registration of a trade-mark in the Patent Office he may at any time apply to the Commissioner of Patents to cancel the registration thereof

The Commissioner shall refer such application to the examiner in charge of interferences, who is empowered to hear and determine this question and who shall give notice thereof to the registrant. If it appears after a hearing before the examiner that the registrant was not entitled to the use of the mark at the date of his application for registration thereof, or that the mark is not used by the registrant, or has been abandoned, and the examiner shall so decide, the Commissioner shall cancel the registration. Appeal may be taken to the Commissioner in person from the decision of the examiner of interferences." Section 5 of the same act, as amended by the act of March 2, 1907, among other things, forbids the registration of a "mark which consists merely in the name of an individual, firm, corporatoin, or association, not written, printed, impressed, or woven in some particular or distinctive manner or in association with a portrait of the individual."

Unquestionably, the Baldwin Company was the first to make a trade-mark use of the word "Howard," but in our view of the case that is of no importance. The sole question here is, Was the Baldwin Company entitled to the exclusive use of this mark on the date of its application for registration? If not, has the Howard Company been injured by the registration of the mark? The right to register the name of a person or corporation, except under conditions not present in either of these cases, is expressly forbidden. Rogers vs. International Silver Co., 34 App. D. C. 410. The mark in the Baldwin case and the dominating feature of the mark in the Valley Gem case is not only a common surname, but the name of appellant corporation, either of which is sufficent to prohibit the right of registration or to form the basis of an action for cancellation. As was said by Mr. Chief Justice Fuller in Howe Scale Co. vs. Wyckoff, Seaman & Benedict, 198 U. S., 118, 134: "But it is well settled that personal name cannot be exclusively appropriated by any one as against others having a right to use it; and as the name 'Remington' is an ordinary family surname, it was manifestly incapable of exclusive appropriation as a valid trade-mark, and its registration as such could not in itself give it validity. Brown
63 Chemical Co. vs. Meyer, 139 U. S., 540; Singer Manufacturing Company vs. June Manufacturing Company, 163 U. S., 169; Elgin National Watch Company vs. Illinois Watch Case Company, 179 U. S., 665."

It will be observed that the statutory prohibition relates back to the date of adoption. If it was then "incapable of exclusive appropriation," its validity may be assailed by any one possessing the right. The question of priority of use is immaterial if no right to the use ever existed. As this court said in Asbestone Co. vs. Philip Carey Mfg. Co., 41 App. D. C., 507, 509: "The statute takes from the realm of possible registration the name of an individual, firm, corporation, or association except under conditions not existing in this case. This limitation is founded upon sound principles of public policy. 'A man's name is his own property, and he has the same right to its use and enjoyment as he has to that of any other species of property.' Brown Chemical Co. vs. Meyer, 139 U. S.,

540. The same rule applies to a corporation. 'That the name of a corporation is an essential part of its being, and that the courts, independent of statutory provision, will protect the corporation in the use of its name, seems to be well settled by the authorities, and the controlling principles in such a case are those applicable to trade-marks.' Investor Pub. Co. vs. Dobinson, 72 Fed., 603. The converse is equally true. Had appellee been using the mark when appellant incorporated, it could not, by mere adoption of the name, have created an exclusive right to its use. Goodyear's India Rubber Glove Mfg. Co. vs. Goodyear Rubber Co., 128 U. S., 598."

It follows that, at the date of the adoption of the mark by both the Valley Gem and Baldwin Companies, the word "Howard" was a surname in common use, and not available to either for registration as a trade-mark. But the statute goes further, and requires that the registrant must be entitled to the use of the mark at the date of his application for registration thereof. When the Baldwin Company applied for the registration of the word "Howard," the Howard Company was in existence and a direct competitor of applicant in the piano business. Hence, the registration of its competitor's name was sought and secured in direct violation of the express terms of the statute.

But it is said that the Howard Company has not shown that it has been injured by the registration of its name. The element of damage enters into the right to challenge the registration of a technical trade-mark either in an opposition or a cancellation proceeding. In either case, the complaining party must show that he would be damaged unless the relief sought is granted. But, where the party is seeking to prevent the adoption of his name as a trade-mark or the cancelation of its registration, his action is grounded upon the invasion of a property right inhering in the name itself, and damage will be presumed. As we said in the Asbestone case, supra: "It is not the business which the statute in this particular aims to protect. It is the corporate name, and it is sufficient
64 that possible damage may be inferred from invading the property right which the corporation possesses in its name."

Section 13 of the act of 1905 provides a remedy which applies to registrations existing at the date of its passage, as well as to registrations made subsequent to its enactment. In Black Betsy Coal Co. vs. Hamilton Coal Co., 197 O. G., 998, Commissioner Ewing said: "I see no reason why section 13 of the Trade-Mark Act of 1905 should not be held to apply to trade-marks registered under the earlier act. Section 13 does not alter in any way the right of a registrant to his trade-mark, but merely provides a new remedy in case a trade-mark is registered by a party who never had or who has abandoned any right thereto. The language in section 13 is broad enough to cover registration under the earlier act, and there is no reason for limiting its plain meaning."

The same interpretation was placed upon the statute by this Court in Stamatopoulos vs. Stephano Bros., 41 App. D. C., 590, where we said: "The registration of trade-marks is regulated entirely by

statute. There is no such property right acquired by registration as either forbids regulation or abolition by a subsequent act of Congress. Section 13 relates entirely to procedure in the Patent Office. The act of 1881 did not provide for challenging a registration by a proceeding for cancelation. The act of 1905 for the first time furnished this speedy and sensible remedy. Being merely remedial, and a matter of procedure, it was within the power of Congress to make it apply to all marks registered in the Patent Office. Intention to make it apply only to future marks is not indicated in the later act. Neither do we find anything to that effect in the saving clause in sec. 30 of the act. Provision as to cancelation did not exist in the prior acts, hence the saving clause in the later act could have no reference to that subject."

The decision of the Commissioner of Patents is reversed, and the clerk is directed to certify these proceedings as by law required.

Reversed. Josiah A. Van Orsdel, Associate Justice.

65 January Term, 1919.

No. 1201.

Registration No. 46,993.

R. S. Howard Company, Appellant,

vs.

The Baldwin Company,

and

No. 1202.

Registration No. 31,411.

R. S. Howard Company, Appellant,

vs.

The Valley Gem Piano Company (The Howard Piano Company Substituted) and The Baldwin Company.

Subject-matter: Trade-mark for Pianos.

Appeals from the Commissioner of Patents.

Decree.

These causes came on to be heard on the transcript of the record from the Commissioner of Patents and were argued by counsel. On consideration whereof, it is now here ordered and adjudged by this Court that the decisions of the said Commissioner of Patents in these

causes be and the same are hereby reversed. Per Mr. Justice Van Orsdel, March 3, 1919.

In Supreme Court of District of Columbia.

Motion to Dismiss.

[Filed October 13, 1921.]

Now comes the R. S. Howard Company, one of the above-named defendants, and moves for an order dismissing the above-entitled action, based upon the allegations and admissions contained in the bill of complaint, the answers thereto, and the matters of record and of which the Court will take judicial notice, upon the following grounds:

1. That said action is not brought in the name of the real party in interest.

2. That the bill of complaint fails to state a cause of action, and is bad in substance.

66 3. That said Court is without power or authority to grant the relief prayed for, or any relief in the premises.

4. That all issues involved in the said above-entitled action are res adjudicata, as a matter of law, as appears from the allegations and admissions contained in the bill of complaint and the matters of record, admitted and of which the Court will take judicial notice.

5. The undersigned moves for such other, further and different relief as said Honorable Court shall deem meet and in accordance with equity and good conscience. Respectfully, R. S. Howard Company, By Samuel S. Watson, Its Attorney. 2 Rector Street, New York.

Opinion of Mr. Justice Hoehling of the Supreme Court of the District of Columbia.

[Filed February 20, 1922.]

This is an application for preliminary injunction to restrain the defendant, Commissioner of Patents, from canceling pendente lite two certain trade-mark registrations; one thereof being No. 31,411, dated March 8, 1898, and the other, No. 46,993, dated October 17, 1905.

The question involved is both important and novel; and, as disclosed by the pleadings, the facts involved are substantially thus:

The Baldwin Company, plaintiff, (for brevity, hereinafter referred to herein as Baldwin Co.,) is the owner of the two registered trade-marks above referred to, and has used the same for many years in its business of manufacturing and selling pianos, both in interstate and foreign commerce; the earlier mark consists of the word "Howard," in old English letters, accompanied by the initials and abbreviation "V. G. P. Co." arranged in monogram form, that mark having been

registered under the trade-mark act, of March 3, 1881, (21 Stat. 502;) and the later mark consists of the word "Howard," in old English letters, standing alone, that mark having been registered under the trade-mark act, of February 20, 1905, (33 id. 704); it being alleged that the word "Howard," under each said registration, is printed or impressed in a particular and distinctive manner. It is further alleged that, since the adoption of the mark "Howard," of the character described, the same has been used continuously by said Baldwin Co. and its predecessors upon the fall boards of pianos manufactured by it and upon the boxes in which the pianos have been shipped and sold, and that such mark has been and is of value in identifying pianos as the product of the Baldwin Co. It, also, appears that the Baldwin Co. has obtained registration of the trade-mark "Howard" in a number of foreign countries, where the right to registration is based upon the registration of the mark in this country, but which foreign registration would be subject to
67 cancelation if the registration in this country should be canceled; in which connection, said company alleges that its foreign business has been built up at considerable expense and is largely based upon registrations of its trade-mark, as above described, and which business would be greatly and irreparably injured by the cancelation of either or both of its said trade-marks in the U. S. Patent Office.

The R. S. Howard Company, (intervening defendant herein, and, for brevity, hereinafter referred to as Howard Co.,) in August, 1914, instituted proceedings in the U. S. Patent Office to procure the cancelation of the registration of each of the two marks above described, this under the provisions of Section 13, of the trade-mark act, of February 20, 1905, supra, which provides "that whenever any person shall deem himself injured by the registration of a trade-mark in the Patent Office he may at any time apply to the Commissioner of Patents to cancel the registration thereof."

While that proceeding was pending, the Baldwin Co. filed suit in the U. S. District Court, Southern District of New York, against the Howard Co. for unfair competition in trade: alleging that said defendant, subsequent to its organization, in 1902, sold pianos marked on the fall board "R. S. Howard Company," and that it had advertised itself extensively as manufacturing "Howard" pianos.

That suit resulted in final decree by said District Court, dated May 23, 1916, (Baldwin Co. v. Howard Co., 233 F. R. 439), adjudging that the name "Howard," without prefix or suffix on pianos, or contained in advertisements, or otherwise used in connection with pianos, indicates that such pianos are the product of the Baldwin Co., and distinguishes the same from pianos of all other manufacturers: that the Baldwin Co., and its predecessors, ever since December, 1896, have been, and the Baldwin Co. now is, the true, lawful and sole owner of said word "Howard" as a name for its pianos, and it alone is entitled to use the same on pianos or advertising matter relating thereto; and that defendant, Howard Co., has infringed upon and violated the rights aforesaid of the Baldwin Co. Said final decree

also affirmed the right of the Baldwin Co. to use the name "The Howard Piano Company" as a name for one of the corporations owned and controlled by it. Finally, the decree enjoined defendant, Howard Co., perpetually and forever, from using the word "Howard" in connection with pianos not the product of the Baldwin Co., except with the initials "R. S." or the name "Robert S." prefixed and the word "Company" affixed to said word "Howard" wherever that word appears on pianos, boxes or packages containing the same, or from advertising in any manner calculated to deceive purchasers into the belief that such pianos are the product of the Baldwin Co.

On appeal by said defendant, the decree was affirmed, on November 14, 1916, by the U. S. Circuit Court of Appeals, Second Circuit, (238 id. 154). In passing, it may be noted that the decisions in the litigation just mentioned, by express reference to the matter, did not undertake to interfere with the cancelation proceedings then pending, supra.

68 Thereupon, the Baldwin Co. filed in the U. S. Patent Office, in said cancellation proceedings, certified copy of the final decree aforesaid; with the result that decision was rendered both by the examiner of interferences and by the Commissioner of Patents, denying the applications to cancel; the Commissioner, in his decisions, stating:

"It is well settled by a long line of decisions of the Court of Appeals of the District of Columbia that a party cannot sustain a cancellation proceeding unless he can establish that he is damaged by the registration of the mark. The rights of the parties to the use of the mark in this country having been fully determined by the court, it is not seen how the rights of the R. S. Howard Company are in any way affected by the registration."

From the above adverse holding of the Commissioner of Patents, the Howard Co. appealed to the Court of Appeals of this District; with the result that that court dismissed from consideration the court proceedings, supra, "since they were confined solely to the question of unfair competition, a matter of no concern in this proceeding, either by way of estoppel or otherwise," (p. 440;) and, having found that "unquestionably, the Baldwin Company was the first to make a trade-mark use of the word 'Howard,' but in our view of the case that is of no importance"; thus proceeded in its opinion:

"The sole question here is, Was the Baldwin Company entitled to the exclusive use of this mark on the date of its application for registration? If not, has the Howard Company been injured by the registration of the mark?" (p. 441).

The court then answered the first question in the negative, upon the ground that the right to register the name of a person or corporation is expressly forbidden, except under conditions which the court stated were not present in the case, (that is, "written, printed, impressed, or woven in some particular or distinctive manner, or in association with a portrait of the individual";) and then answered the second question in the affirmative, upon the ground that, while

the complaining party in such cancelation proceeding must show resulting damages unless the relief be granted, nevertheless, "where the party is seeking to prevent the adoption of his name as a trade-mark, or the cancelation of its registration, his action is grounded upon the invasion of a property right inhering in the name itself, and damage will be presumed," (p. 443). The Court of Appeals, accordingly, reversed the decision of the Commissioner of Patents, and directed the clerk of the court "to certify these proceedings as by law required" (Howard Co. v. Baldwin Co., 48 App. D. C. 437).

The Baldwin Co. then prosecuted an appeal to the Supreme Court of the United States, and, also, filed application for writ of certiorari, to review the above decision of the Court of Appeals. The appeal was dismissed and the application for writ of certiorari denied, April 11, 1921; the opinion of the court, delivered by Mr. Justice Day, thus stating:

"If the decision of the Court of Appeals of the District of Columbia is not final, then the motion to dismiss the appeal should be
69 sustained, and we have no authority to grant a writ of certiorari. Judicial Code, Secs. 250-251.

"The nature of proceedings of the character now under consideration was considered in Frasch v. Moore, 211 U. S. 1, in which the opinion of Chief Justice Alvey, speaking for the Court of Appeals of the District of Columbia, in Rosseau v. Brown, 21 App. D. C. 73, 80, explaining the nature of this statutory proceeding and affirming that it did not authorize a judgment but only the return by the Court of Appeals of a certificate to the Commissioner of Patents, to be there entered of record to govern further proce-dings in the case, was fully approved.

"In Atkins v. Moore, 212 U. S. 285, application for registration of a trademark was refused by the Examiner, which action was approved by the Commissioner, and affirmed on appeal by the Court of Appeals of the District of Columbia, an appeal and writ of error were allowed, both of which were dismissed in this court. The previous decisions of this court were reviewed by Chief Justice Fuller, speaking for the court, and in concluding the opinion he said:

"'In the light of the various details of the Act of February 20, 1905, and of the specific provisions of Section 9, we were of opinion (Gaines v. Knecht, 212 U. S. 561) that proceedings under the act were governed by the same rules of practice and procedure as in the instance of patents, and the writ of error was accordingly dismissed. The same result must follow in the present case.

"'Under Section 4914 of the Revised Statutes no opinion or decision of the Court of Appeals on appeal from the Commissioner precludes "any person interested from the right to contest the validity of such patent in any court wherein the same may be called in question," and by Section 4915 a remedy by bill in equity is given where a patent is refused, and we regard these provisions as applicable in trade-mark cases under Section 9 of the act of February 20, 1905.'

"We are of opinion that the principle there announced controls this case. No provision is made which permits this statutory pro-

ceeding to be carried beyond the decision of the Court of Appeals of the District of Columbia, the decision of which court is directed to be certified to the Commissioner of Patents. It is in no sense a final judgment reviewable here upon writ of certiorari or appeal.

"It is true that in Estate of Beckwith v. Commissioner of Patents, 252 U. S. 538, this court allowed a writ of certiorari from a decision of the Court of Appeals of the District of Columbia, affirming a decision of the Commissioner of Patents, in an application to register a trade-mark. No question of the jurisdiction of the court was considered in that case, and an inadvertent allowance of the writ of certiorari does not establish the jurisdiction of the court. Fritch, Inc. v. United States, 248 U. S. 458, 463.

"It follows that the appeal must be dismissed, and the petition for a writ of certiorari denied."

Following the action by the Supreme Court, supra, the Clerk of the Court of Appeals certified to the Commissioner of Patents the action of the latter court; and, thereupon, bill of complaint was filed herein, by the Baldwin Co., May 7, 1921, setting up,

70 substantially, the several matters and things above referred to; detailing the damage which would result to it by reason of the cancellation of the trade-mark registrations, and alleging that, because of the certain final decree of injunction, aforesaid, the R. S. Howard Company cannot legitimately get a direct benefit from the cancellation of said registrations; prayed that said question be determined; and that the Commissioner of Patents be restrained and enjoined from canceling said registration, pendente lite and perpetually.

Following the filing of that bill and rule to show cause issued thereon, answer was filed on behalf of defendant, Commissioner of Patents, contending therein that said defendant is bound by the decision of the Court of Appeals of this District, and that, therefore, the application for injunction should be denied and the bill dismissed.

On May 17, 1921, said R. S. Howard Company filed petition for leave to intervene as party defendant; that leave was granted, May 27, 1921, and, on the same day, said company filed answer to the bill, in which answer, it was contended, inter alia, that, under the circumstances present in the case, this court is without jurisdiction to grant the relief prayed, and concluded by asking that the bill be dismissed.

Thus the litigation stood, until October 13, 1921, when plaintiff Baldwin Co. filed amended bill of complaint herein, in which the allegations of its original bill are amplified, and the assertion made that, under the circumstances stated, the Commissioner of Patents is without lawful authority and power to cancel the trade-mark registrations described; and that, by Section 4915, R. S. U. S., "as construed and directed to be applied by the Supreme Court of the United States," supra, remedy by bill in equity is afforded plaintiff, and that such remedy, so given and so applicable, would be futile if, pending the disposition of the proceedings, the Commissioner of Patents should be permitted to cancel the registration

Aside from the prayer for injunction, pendente lite and perpetually, the substantial prayer for affirmative relief contained in said amended bill of complaint, and upon which the prayer for injunction is based, is thus stated therein:

"2. That * * * this * * * court will determine and declare that the R. S. Howard Company, intervenor in the above entitled cause, is without any such right to or interest in the case as a trade-mark in connection with pianos of the word 'Howard,' standing alone, without prefix or suffix, as is or can or may be damaged by the continued maintenance of record in the United States Patent Office of either one or both of the registered Trade-Marks next above described"; (meaning the two certain trade-marks hereinaforesaid).

Thereupon, the intervening defendant, Howard Co., filed motion to dismiss the action, the substantial grounds assigned therefore being thus stated:

"3. That said court is without power or authority to grant the relief prayed for, or any relief in the premises.

71 "4. That all issues involved in the said above entitled action are res adjudicata, as a matter of law, as appears from the allegations and admissions contained in the bill of complaint and the matters of record, admitted and of which the court will take judicial notice."

Thereafter, the cause was argued orally, on behalf of the respective parties in interest, on the application for preliminary injunction and on the motion to dismiss. On behalf of the defendant, Commissioner of Patents, the cause was submitted for such action as the court might deem proper; it being agreed, in open court, on behalf of said Commissioner, that, pending the determination of the application for preliminary injunction and motion to dismiss, the status of the registration of the trade-marks would be preserved unimpaired, so far as the Patent Office is concerned. In addition to the oral arguments of counsel, written briefs have been submitted on behalf of the Baldwin Co. and the Howard Co., respectively, covering the questions involved; all of which arguments, both oral and written, have been carefully considered by the court, and, it may be added, that the arguments so presented by counsel have been exceedingly helpful to the court in its consideration of the various questions involved.

While, as hereinabove stated, the determination and adjudication sought by the Baldwin Co., in its amended bill of complaint, is limited to the matter of alleged lack of right on the part of said Howard Co. to maintain the cancelation proceedings aforesaid, because of the fact, as alleged, that it cannot be damaged by the continued maintenance of either one or both of said trade-mark registrations; and injunction is, accordingly, sought to restrain the cancelation upon that ground; the case itself, in the written brief submitted herein on behalf of said defendant, Howard Co., reaches to the whole merits of the trade-mark registrations; including, however, particularly the defense that "the subject-matter and all ques-

tions at issue at bar are res adjudicata and shown to be such by matters of record now before the trial court."

In support of the defense last mentioned, said defendant states:

"It is respectfully submitted that as the subject-matter of the bill of complaint herein has been definitely and finally adjudicated by the Court of Appeals of the District of Columbia, the plaintiff has exhausted its remedies, and this controversy should now forthwith be terminated."

In view of the holding of the Supreme Court of the United States, supra, to the effect that the decisions of the Court of Appeals of this District, both in patent and trade-mark cases, are in no sense a final judgment reviewable upon certiorari or appeal, but are only the return by that court of a certificate to the Commissioner of Patents to be there entered of record to govern further proceedings in the case; in view of the further holding of said Supreme Court that Secs. 4914 and 4915 R. S. U. S. are applicable in trade-mark cases; and, finally, in view of the express holding of the Supreme Court that this case is controlled by the principles so announced; the conclusion seems necessarily to follow that the Supreme Court, having
72 before it an application to review the adverse holding of the Court of Appeals, supra, and finding itself without jurisdiction to entertain the same, either on appeal or by certiorari; nevertheless, in direct and express terms and language, pointed out a method and way in which such judicial review of the questions might be secured.

If that be not the true intent and meaning of the decision of that court, then the language of the opinion must be denied its ordinary, plain, and usual meaning.

If, therefore, there be open to the plaintiff, Baldwin Co., an opportunity for judicial review of the questions raised in this suit, under said Sections 4914 and 4915 R. S. U. S., and the Supreme Court apparently has so held; then pending the proceeding, the status of the subject-matter of the litigation should be preserved unimpaired; since the remedy so given would be futile if, pending the proceeding, the trade-mark registrations be permitted to be canceled.

Accordingly, the court is of opinion that the motion of defendant, Howard Co., to dismiss should be overruled, and that the application of plaintiff, Baldwin Co., for preliminary injunction should be granted. Appropriate order in that behalf may be prepared by counsel and submitted, upon due notice.

As the case now stands on the pleadings, the rule to show cause was issued upon the original bill of complaint, answer to which original bill was made and filed by said defendant, Howard Co. The court has deemed it proper to consider that answer in connection with the application for preliminary injunction which was carried forward in the amended bill of complaint.

The motion to dismiss the cause, however, was filed in response to the amended bill of complaint, and which latter supersedes and takes the place of the original bill. Hence, the motion to dismiss must be and has been determined upon the allegations of said amended bill, and the matters of law urged in opposition thereto.

If defendant, Howard Co., be of opinion that the questions of law and jurisdiction are sufficiently presented in the amended bill and the motion to dismiss the same, it may elect, if so advised and in order to speed the cause, to stand upon said motion to dismiss; in which event, final decree for plaintiff may be entered at once, from which an appeal may be taken. A. A. Hoehling, Justice. February 20, 1922.

In Supreme Court of District of Columbia.

Decree Overruling Intervenor's Motion to Dismiss and Granting Plaintiff's Application for Injunction Pendente Lite.

[Filed June 16, 1922.]

This cause having come on to be heard upon the application for and return to Rule to Show Cause why an injunction should not be granted pendente lite as prayed in the Bill of Complaint, and upon the Answer of defendants Thomas E. Robertson, Commis-
73 sioner of Patents, and R. S. Howard Company, Intervenor-Defendant thereto, both of said answers having been submitted also by way of return to said Rule to Show Cause; and also having come on to be heard upon the motion of R. S. Howard Company, intervenor-defendant, to dismiss plaintiff's Amended Bill of Complaint, and all proceedings connected therewith as filed and had herein for the reasons and upon the grounds in said motion to dismiss stated; and both said application for injunction pendente lite, and said motion to dismiss having been argued orally and in writing by counsel for each of the several parties to the cause, were submitted to the Court and by said Court were taken under advisement; and the Court being now sufficiently advised in the premises, It is this 16th day of June, 1922, adjudged, ordered and decreed,

(1) That the Motion of intervenor-defendant R. S. Howard Company to dismiss plaintiff's Bill of Complaint herein both as filed and as amended be, and same is hereby denied;

(2) That pending final disposition of this cause, defendant Thomas E. Robertson, Commissioner of Patents, his assistants, agents, subordinates and successors be and they are and each of them is hereby restrained and enjoined from cancelling or erasing from the records of the United States Patent Office or in any other manner interfering with the Registration in said United States Patent Office of the two several Trade Marks described in said Bill of Complaint as amended as follows:

(a) Trade Mark Registration for Pianos, consisting of the word "Howard" accompanied by the initials V. G. P. Co. so arranged in a monogram,—the word "Howard" therein being also printed or impressed in a particular and distinctive manner,—that is in Old English letters, such Registration being numbered 31,411 and bearing date March 8, 1898;

(*b*) Trade-Mark Registration for Pianos consisting of the word "Howard" printed or impressed in a particular and distinctive manner,—that is, in Old English letters, such Registration being numbered 46,993, and bearing date October 17, 1905.

such restraint and injunction pendente lite to become and be effective upon the execution and filing in this cause by the plaintiff The Baldwin Company of an undertaking in the penal sum of One Thousand Dollars ($1,000.00) with surety to be approved by the Court to make good to said defendants and to each of them all damages which they or either of them may sustain by reason of the wrongful suing out of such injunction. A. E. Hoehling, Justice.

From the foregoing the defendant R. S. Howard Company, intervenor, in open court noted an appeal in open court, and thereupon the amount of appeal bond for costs is fixed at $50 deposit in cash, or undertaking in the penalty of $100. A. A. Hoehling, Justice.

74 **Memorandum.**

June 16, 1922. Deposit of $50 made by R. S. Howard Company as security for costs on appeal.

In Supreme Court of District of Columbia.

Assignment of Errors.

[Filed June 16, 1922.]

The defendants hereby enter their appeals to the Court of Appeals of the District of Columbia, from the decree made and entered in the above entitled cause, on the 16th day of June, 1922.

The following are assigned as errors and grounds for appeal:

The Supreme Court of the District of Columbia erred:

1. In not adjudging that said action is not brought in the name of the real party in interest.

2. In not adjudging that the amended bill of complaint fails to state a cause of action and is bad in substance and insufficient in law.

3. In not adjudging that said Supreme Court of the District of Columbia was without power or authority to grant the relief prayed for, or any relief in the premises.

4. In not adjudging that all issues set up in said amended bill of complaint are res adjudicata as matters of law, as appears from the allegations and admissions contained in the bill of complaint and the matters of record admitted and of which the Court will take judicial notice.

5. In granting the injunction, or granting any injunction or relief whatsoever to the plaintiff in the premises.

6. In refusing to dismiss the amended bill of complaint.

7. In holding that Sections 4914 or 4915 Revised Statutes of the United States provide grounds for a judicial review of the issues set up in the amended bill of complaint, or any of them.

8. In failing to hold that the R. S. Howard Company is damaged by said registrations sought to be canceled:

(*a*) By reason of The Baldwin Company sending to customers of the R. S. Howard Company threatening and intimidating letters claiming rights under said "duly registered" trade-marks, "and will take all necessary steps to protect our rights against infringement;"

(*b*) By suing the R. S. Howard Company for infringement of both said registered trade-marks and claiming three-fold damages for such infringement under the Trade-Mark Registration Acts of Congress;

(*c*) Because "R. S. Howard Co." and "Howard" are substantially and deceptively similar, and that damage and injury will not only inevitably result, but also will be presumed to result from their concurrent use on the same class of goods, and that as said R. S. Howard Company has been adjudged entitled to use its corporate and trade-name "R. S. Howard Co." damage will be presumed to result to it from the improper registration of "Howard;"

75 (*d*) Because "Howard" being a personal name, its improper or improvident registration will be presumed to damage any person or concern entitled to use the name "Howard" in any form as its trade or business name in connection with the manufacture and sale of the same class of goods, as pianos marked "Howard," with or without prefix or suffix, or with any variant of "Howard" have always been, and always will be, commonly known, referred to and spoken of, as "Howard" pianos;

(*e*) Because the registration of the name "Howard" is prima facie evidence of exclusive ownership, as a valid trade-mark, and as such, prima facie, entitles the owner to the exclusive use of the name "Howard" as a mark for pianos, i. e., "Howard" in any form and in every form, whether used simpliciter or with prefixes or suffixes; if "Howard" were a valid and registrable trade-mark, the use of "R. S. Howard Co." or "R. S. Howard Company" on pianos would be prima facie infringements of such trade-mark;

(*f*) Because the word "Howard" is the dominant and distinguishing feature of the corporate name of the R. S. Howard Company which was incorporated in 1902, whereas The Baldwin Company, or any of its predecessors in business, did not make statutory use of the name "Howard" prior to 1912;

(*g*) Because The Baldwin Company has registered in a number of foreign countries since said cancellation proceedings were begun the name "Howard" as a trade-mark for pianos, such foreign registrations being based on the United States registration No. 46,993, in which foreign countries the R. S. Howard Company is now, and continuously for many years past beginning long prior to 1912 has been, selling pianos of its manufacture prominently marked with applicant's corporate and trade-name "R. S. Howard Co."

9. In not adjudging that The Baldwin Company comes into Court with unclean hands and not entitled to any relief under Sections 4914 or 4915 Revised Statutes of the United States, or in the premises, because the statement and declaration forming a part of the application to register each of said marks were false in that:

(*a*) The marks had not been used in the business of registrants (or their predecessors in business) since December 1896;

(*b*) Registrants (or their predecessors in business) had never made statutory use of the mark prior to their applications to register;

(*c*) The declaration and affidavit of Lucien Wulsin forming a part of the application to register Registration No. 46,993 was false in that The Baldwin Company had no title or right to the mark therein sought to be registered.

10. In not adjudging that The Baldwin Company comes into court without equity and not entitled to any relief in the premises because its answers in said cancellation proceedings were false in that (*a*) it had no title to the mark registered by it; (*b*) it had not made statutory use of the mark prior to its application to register.

11. In not adjudging that The Baldwin Company comes into court without equity, because the marks registered were improperly and improvidently registered and were registered without
76 authority of law and in violation of the Trade-Mark Acts of Congress in force when registered and not registrable under the Trade-mark Acts now in force. Samuel S. Watson, Attorney for R. S. Howard Company. Theodore A. Hostetler, Attorney for Commissioner of Patents.

Filed June 16, 1922.

In Supreme Court of District of Columbia.

Designation of Record on Appeal.

[Filed June 16, 1922.]

The defendant, R. S. Howard Company, by its Attorney, hereby designates the following papers and proceedings to be included in the transcript of record on the appeal in the above entitled cause:

1. Amended bill of complaint filed October 13, 1921.
2. Rule to Show Cause issued May 17, 1921.
3. Answer of Commissioner of Patents filed May 20, 1921.
4. Answer of R. S. Howard Company to the amended bill filed October 13, 1921, with summary of "Exhibit A" annexed to said answer.
5. Motion of R. S. Howard Company to dismiss the bill filed October 13, 1921.
6. Opinion of Mr. Justice Hoehling filed February 20, 1922.
7. Decree overruling motion of R. S. Howard Company to dismiss and granting injunction pendente lite entered June 16, 1922.

8. Notation of deposit of $50 as security for costs on appeal.
9. Assignment of errors filed June 16, 1922, with notice of appeal.
10. This designation of record.

Samuel S. Watson, Attorney for R. S. Howard Co., 2 Rector Street, New York.

Order for Appeal and Citation.

[Filed June 21, 1922.]

* * * * * * *

The Clerk of said Court will enter an appeal for the Commissioner of Patents and issue citation to The Baldwin Company. T. A. Hostetler, Attorney for Thomas E. Robertson, Com. of Patents.

77

A3149.

In the Supreme Court of the District of Columbia.

In Equity.

No. 39010.

[Title omitted.]

Citation and Service.

The President of the United States to The Baldwin Company, Greeting:

You are hereby cited and admonished to be and appear at a Court of Appeals of the District of Columbia, upon the docketing the cause therein, under and as directed by the Rules of said Court, pursuant to an Appeal noted in the Supreme Court of the District of Columbia, on the 21″ day of June, 1922, wherein Thomas E. Robertson, Commissioner of Patents is Appellant, and you are Appellee, to show cause, if any there be, why the Decree rendered against the said Appellant, should not be corrected, and why speedy justice should not be done to the parties in that behalf.

Witness the Honorable Walter I. McCoy, Chief Justice of the Supreme Court of the District of Columbia, this 21″ day of June in the year of our Lord one thousand nine hundred and twenty two. Morgan H. Beach, Clerk, By F. E. Cunningham, ass't Clerk. [Seal of the Supreme Court of the District of Columbia.]

Service of the above Citation accepted this — day of ——, 19—. —— ——, Attorney for Appellee.

[Endorsed:] No. 39010. Equity. Baldwin Co. vs. Robertson. Citation. Issued June 21, 1922. Served copy of the within Citation on The Baldwin Co. by McKenney & Flannery, Lawyers. Service accepted by C. H. Quill, representing McKenney & Flannery, June 26, 1922. E. C. Snyder, Marshal. K. —— ——, Attorney for Appellant.

78 **Clerk's Certificate.**

UNITED STATES OF AMERICA,
District of Columbia, ss:

I, Morgan H. Beach, Clerk of the Supreme Court of the District of Columbia, hereby certify the foregoing pages numbered from 1 to 149, both inclusive, to be a true and correct transcript of the record, according to directions of counsel herein filed, copy of which is made part of this transcript, in cause No. 39010 in Equity, wherein the United States of America ex relatione The Baldwin Company is Plaintiff and Thomas E. Robertson, as Commissioner of Patents and R. S. Howard Company, Intervener, by leave of Court, are Defendants, as the same remains upon the files and of record in said Court.

In testimony whereof, I hereunto subscribe my name and affix the seal of said Court, at the City of Washington, in said District, this 26th day of June, 1922. Morgan H. Beach, Clerk, By W. E. Williams, Assistant Clerk. [Seal of the Supreme Court of the District of Columbia.] E. W.

[File endorsement omitted.]

79 In Court of Appeals of District of Columbia.

Friday, January 5th, A. D. 1923.

* * * * * * *

[Title omitted.]

Argument and Submission.

The argument in the above entitled cause was commenced by Mr. S. S. Watson, attorney for the appellants, and was continued by Mr. F. D. McKenney, attorney for the appellee, and was concluded by Mr. S. S. Watson, attorney for the appellants. On motion the appellants are allowed to file additional authorities herein if so advised.

80 In the Court of Appeals of the District of Columbia.

[Title omitted.]

Opinion.

Mr. Chief Justice SMYTH delivered the opinion of the Court:

The Baldwin Company claimed to be the owner of two trade-marks, used on pianos, which were registered in the Patent Office. Two proceedings to have the marks cancelled were instituted by R. S. Howard Company, one of the appellants. Relief was denied it by the Commissioner of Patents, but on appeal to this court his decision was reversed and the Commissioner was so advised, as provided by statute (33 Stat. L. 727, sec. 9; secs. 4914 et seq., Revised Statutes). From our action the Baldwin Company appealed to the Supreme Court of the United States, and also prayed for writs of certiorari. The appeals were dismissed and the writs of certiorari denied, for the reason that our decision was not final. Judicial Code, secs. 250, 251 et seq. Thereupon the Baldwin Company filed its bill in equity against Honorable Thomas E. Robertson as Commissioner of Patents, in the Supreme Court of the District, basing its right to do so upon section 9 of the trade-mark statute (33 Stat. 727) and sections 4914 and 4915 of the Revised Statutes. The bill as amended sought to restrain the Commissioner from cancelling the marks in accordance with our decision, and prayed that pending the final disposition of the case he be enjoined from cancelling them. On its petition the R. S. Howard Company was permitted to intervene. The Commissioner of Patents and the latter company filed separate answers. The Commissioner asserted, among other things, that he was bound by the decision of this court. The Howard Company went into its case with much elaboration, and then moved to dismiss the amended bill on several grounds, among them being one to
81 the effect that the court was without authority to grant the relief asked for, or any relief in the premises. The motion having been overruled, a preliminary injunction went out restraining the Commissioner of Patents as prayed, and the Howard Company brought the case here for our review by special appeal. 27 Stat. 436.

The case turns upon the jurisdiction of the Supreme Court of the District to entertain the suit. Registration of trade-marks, opposition to registration, cancellation of registration, and interference proceedings are all governed by statute. 33 Stat., sec. 724 et seq. The solution of any question which arises with respect to these matters must be in harmony with the terms of the statute. Lincoln vs. Virginia Portland Cement Co., 49 App. D. C. 33; Moore vs. United States, 249 U. S. 487; United States vs. Temple, 105 U. S. 97. If there is no statutory authority for bringing the suit, then the action of the lower court must be reversed and the amended bill dismissed.

It is asserted by the Baldwin Company that section 9 of the trade-mark act and sections 4914 and 4915, Revised Statutes, supra, when considered together authorize the suit. Section 9 says that if a "party to an application for the cancellation of the registration of a trade-mark is dissatisfied with the decision of the Commissioner of Patents he may appeal to the court of appeals of the District of Columbia, on complying with the conditions required in case of an appeal from the decision of the Commissioner by an applicant for patent, or a party to an interference as to an invention, and the same rules of practice and procedure shall govern in every stage of *such proceedings*, as far as the same may be applicable." (Italics supplied.) When this court was organized in 1893 (27 Stat. 434) the determination of appeals from the decisions of the Commissioner of Patents, then vested in the Supreme Court of the District of Columbia, was transferred to this court. 27 Stat. 436, section 9. Section 4914, R. S., provides that when this court determines an appeal from the Commissioner of Patents in patent cases it "shall return to the Commissioner a certificate of its proceedings and decision, which shall be entered of record in the Patent Office, and shall govern
82 the further proceedings in the case"; and adds, "But no opinion or decision of the court in such case shall preclude any person interested from the right to contest the validity of such patent in any court wherein the same may be called in question."

Section 4915 says that whenever a patent is refused by the Commissioner of Patents or by this court "the applicant may have remedy by bill in equity; and the court having cognizance thereof, on notice to adverse parties and other due proceedings had, may adjudge that such applicant is entitled, according to law, to receive a patent for his invention, as specified in his claim, or for any part thereof, as the facts in the case may appear," and that such adjudication, if in favor of the right of the applicant, shall authorize the Commissioner to issue a patent to him when he has complied with certain other requirements of the statute.

It will be observed that section 9 of the trade-mark statute, supra, so much relied upon by the Baldwin Company, deals with appeals from the Commissioner of Patents to this court, and declares that the rules of practice and procedure in patent cases shall govern in every state of "such proceedings" as far as they may be applicable. What proceedings? Clearly, the proceedings followed in taking the appeals just mentioned. There is nothing in it which purports to deal with what shall happen after an appeal has been determined. Section 4914 says that no decision by this court shall preclude any person interested from the right to contest the validity of a patent "in any court wherein the same may be called in question." This relates to something that may take place after the decision of this court, and has no relation to proceedings in an appeal from the Commissioner to this court. And what is said with respect to this section may also be said with respect to section 4915, which deals with patent cases after they have been disposed of by this court or by the Commissioner in case no appeal is taken to this court. There is nothing in it which

relates to an appeal from the Commissioner to this court, and therefore it can not affect "such proceedings." Besides, Congress has provided by section 22 of the trade-mark statute (33 Stat. 729) for proceedings in equity after a case has been finally disposed of
83 by this court. It is there declared that "whenever there are *interfering registered trade-marks,* any person interested in any one of them may have relief against the interfering registrant, and all persons interested under him, by suit in equity against the said registrant." (Italics ours.) But no provision is made for a suit in equity in a case such as the one before us. Does not this call for the application of the maxim Expressio unius est exclusio alterius?

There is a good reason why Congress should have provided for equitable relief in patent cases as it has done in section 4915 without making a like provision for trade-mark cases. If the section did not exist the applicant for a patent would be concluded by the decision of this court holding that his invention was not patentable. He might manufacture and put it on the market and successfully defeat anyone who might charge him with being an infringer, but he could not obtain a monopoly himself. Brown vs. Duchesne, 19 How. 183; Dable Grain Shovel Co. vs. Flint, 137 U. S. 41. Against his will his invention could be made and vended by anybody with impunity. Moreover, a patent conveys a property right to the inventor. Imperial Cotto Sales Co. vs. N. K. Fairbanks Co., 50 App. D. C. 250, 270 Fed. 686; Shaw vs. Cooper, 7 Pet. 292; Cammeyer vs. Newton, 94 U. S. 225. To be denied a patent is to be denied this right, which may be very valuable.

In the case of a trade-mark the situation is entirely different. The registration of a mark conveys no property right (Sarrazin vs. W. R. Irby Cigar & Tobacco Co., 93 Fed. 624; Hanover Star Milling Co. vs. Allen & Wheeler Co., 208 Fed. 513; Andrew Jergens Co. vs. Woodbury, Inc., 273 Fed. 952, 965) and its cancellation takes none away. Ownership of the mark depends upon its adoption and use, not on its registration. Columbia Mill Co. vs. Alcorn, 150 U. S. 460; Phillips vs. Hudnut et al., 263 Fed. 643. The only effect of the registration is to raise a rebuttable presumption in favor of the registrant's ownership. Section 16 of the trade-mark act says that the registration of a trade-mark shall be prima facie evidence of ownership. 33 Stat. 728. If in a contest
84 between a registrant and one who is using the same mark upon the same class of goods the latter can establish that he is the owner of the mark, the registration of it will avail the other party nothing. The right to a patent originates in the statute. The right to a trade-mark exists independently of a statute and comes into existence by reason of its adoption and use. (See authorities ante.) Under section 4915 the inventor may secure a monopoly of his invention, which he could not otherwise obtain, but the owner of a trade-mark could secure nothing which he did not have before except a presumption which might be overturned by proof. The one would gain much, the other very little. There

is a reason, then, for section 4915 with respect to patents, but little reason for it with respect to trade-marks. To our mind these things indicate why section 4915 does not apply, either directly or by reference, to trade-mark cases.

The Baldwin Company, however, contends that its right to maintain the bill is no longer open to discussion because the Supreme Court of the United States has settled the matter in Atkins & Company vs. Moore, 212 U. S. 235, and Baldwin Co. vs. Howard Co., 256 U. S. 35. (The last case was the one between the parties to this suit when they were before the court on the appeals.) Of course if this contention be sound, that ends the contest so far as this court is concerned. We have but one duty in the premises and that is to follow those decisions.

In construing the opinion of a court reference must be had to the facts involved, and to the question to which the court's mind was directed when formulating the decision. Cohens vs. Virginia, 6 Wheat. 264; Plumley vs. Massachusetts, 155 U. S. 461, 471; Harriman vs. Northern Securities Co., 197 U. S. 244, 291. In the Atkins case it appeared that Atkins & Co. made application for registration of a trade-mark in the Patent Office. The application was denied, and on appeal to this court the decision was affirmed. An appeal and writ of error were allowed by the Supreme Court of the United States. The court dismissed both on the ground that our order affirming the decision of the Commissioner was not final. In support of its conclusion the court
85 called attention to its decision in Frasch vs. Moore, 211 U. S. 1, in which it was held that our decisions on appeals from the Patent Office are interlocutory and not final; also to the decision in Gaines vs. Knecht, 21 U. S. 561, where a ruling to the same effect was made. After quoting with approval from our decision in Gaines vs. Knecht, 27 App. D. C. 530, 532, the court said that, in the light of the various details of the act of February 20, 1905 (Trade-Mark Act) and of the specific provisions of section 9, to which we have already called attention, it was of the opinion that proceedings under the act were governed by the same rules of practice and procedure as in the instance of patents, and the writ of error was accordingly dismissed. Then it added that under section 4914, R. S., supra, no opinion or decision of the Court of Appeals on appeal from the Commissioner precludes any person from the right to contest the validity of such patent in any court wherein the same may be called in question, and that by section 4915 a remedy by bill in equity is given where a patent is refused, and that it regarded these provisions as applicable in trade-mark cases under section 9 of the act of February 20, 1905.

That the act of February 20, 1905, makes it clear that the decisions of this court in trade-mark cases are not final is beyond question. (See section 16.) But the thing which makes trouble is the observation that the court regards the provisions of section 4915 applicable in trade-mark cases under section 9 of the act of February 20, 1905. We do not think that the court was consid-

ering anything but the question as to whether or not the decision of this court was final. That was the point before it and the one on which the thought of the court was centered. The provisions of the trade-mark act, especially section 16, furnished ample authority for the conclusion which it had reached. The court had no occasion to determine whether section 4915 gave a defeated applicant for registration the right to commence a proceeding in equity, and we do not think it intended to so decide. In this we are supported by a statement in the last opinion of the court upon the subject, Baldwin Co. vs. Howard Co., supra. Mr. Jus-
86 tice Day, who spoke for the court in that case, after referring to the decisions in the Frasch, Atkins, and Gaines cases, wherein the various statutory sections about which we have been writing were referred to, said: "No provision is made which permits this statutory proceeding to be carried beyond the decision of the Court of Appeals of the District of Columbia, the decision of which court is directed to be certified to the Commissioner of Patents." The statutory proceeding referred to is the one relating to the registration of trade-marks, the decisions of the Commissioner touching the same, and the review of his decisions by this court. This proceeding, according to the learned justice, can not be carried beyond the decision of the Court of Appeals. In other words, the questions of registration, cancellation, opposition, and interference in trade-mark cases are ended by our decision. The only thing decided in such a proceeding is as to whether or not the mark shall be registered, or, having been registered, whether or not it shall be cancelled. The effect of the registration, as we have seen, is simply to provide a rule of evidence which under section 16, supra, casts upon him who would attack the right of the registrant to the mark the burden of establishing his claim in an infringement, unfair competition, or other proper proceeding. We think the court had this in mind when it said that there was no authority for carrying the statutory proceeding beyond the decision of the Court of Appeals.

Believing that there is no authority for the maintenance of this suit we reverse the decision appealed from and remand the case with instructions to dismiss the suit, costs to be assessed against appellee.

Reversed and Remanded.

87 In the Court of Appeals of the District of Columbia.

[Title omitted.]

Dissenting Opinion.

Mr. Justice Robb dissenting:

Section 9 of the Trademark Act of February 20, 1905, (33 Stat. 724), authorizes an applicant for registration of a trademark, a party to an interference as to a trademark, a party who has filed an

opposition to the registration of a trademark, or a party to an application for the cancellation of the registration of a trademark, to appeal from the decision of the Commissioner of Patents to this Court, on compliance with conditions incident to an appeal by an applicant for patent or a party to an interference, as to an invention, and it is further provided that "the same rules of practice and procedure shall govern in every stage of such proceedings, as far as the same may be applicable." Were this an open question, the force of the argument of my Associates would lead me to their conclusion that the provision last quoted refers only to proceedings in this court, and that view would be further strengthened by the specific provisions of Section 22 of the Trademark Act, which apparently were intended to restrict and limit the right to equitable relief to parties to "interfering registered trademarks." However, as I read the opinion of the court in Baldwin Co. vs. Howard Co., 256 U. S. 35, 39, it there is intimated that Section 4915 R. S. authorizes a remedy by bill in equity in a case like the present. Therefore, while it is quite possible that, when the provisions of Section 22 of the Trademark Act are brought to the attention of the Supreme Court and a definite ruling invoked, the conclusion reached by my Associates will be approved, I now feel constrained to give full force and effect to the suggestion in the Howard case and to dissent here.

88 Monday, February 5th, A. D. 1923.

* * * * * * *

[Title omitted.]

Appeal from the Supreme Court of the District of Columbia.

Decree.

This cause came on to be heard on the transcript of the record from the Supreme Court of the District of Columbia and was argued by counsel. On consideration whereof, It is now here ordered, adjudged and decreed by this Court that the decree of the said Supreme Court in this cause be and the same is hereby reversed with costs, and that this cause be and the same is hereby remanded to the said Supreme Court with instructions to dismiss the suit. Per Mr. Chief Justice Smyth, February 5, 1923. Mr. Justice Robb dissenting.

89 Court of Appeals of the District of Columbia, January Term, 1923.

[Title omitted.]

No. 3854.

Appeal from the Supreme Court of the District of Columbia.

Petition for Appeal.

[Filed Mar. 12, 1923.]

Now comes the above named appellee, The Baldwin Company, conceiving itself to be aggrieved by the continued maintenance in this Honorable Court of the final decree passed and made of record in the above entitled cause on the 5th day of February, A. D., 1923, and invoking the applicable provisions of Section 250, of the Judicial Code and particularly the First and Sixth provisions thereof, respectfully appeals from said final decree to the Supreme Court of the United States, and prays that this appeal be allowed and that a transcript of all pertinent parts and portions of the transcript of the record and proceedings had in this Honorable Court, including the opinion of the Court and the dissenting opinion of Mr. Justice Robb, upon which said final decree was based, all duly authen-
90 ticated, may be directed to be prepared by the clerks of this court and duly transmitted to the said Supreme Court of the United States. John E. Cross, McKenney & Flannery, Attorneys for The Baldwin Company. March 12, 1923.

91 In Court of Appeals of District of Columbia.

Memorandum in Support of Appeal.

[Filed Mar. 12, 1923.]

The Baldwin Company, plaintiff in the Supreme Court of the District of Columbia, acting in pursuance of and in accord with certain expressions contained in the opinion of the Supreme Court of the United States in The Baldwin Company, et al. vs. R. S. Howard Company (256 U. S. 35), brought its bill of complaint in the Supreme Court of the District of Columbia against Thomas E. Robertson, as Commissioner of Patents, praying that the latter be restrained and after hearing, perpetually enjoined from cancelling or erasing from the records of the United States Patent Office certain registrations of trade marks for pianos which had been registered and made of record in pursuance of law, basing its right to bring and maintain such suit upon the provisions of Sections 4914 and 4915 of the Revised Statutes of the United States and pertinent provisions of the Trade Mark Laws, as same had theretofore been con-

strued and directed to be applied in the cases of Frasch v. Moore (211 U. S. 1); Atkins v. Moore (212 U. S. 285); Gaines v. Knecht (212 U. S. 561), and The Baldwin Company v. Howard Company (256 U. S. 35).

The jurisdiction of the trial court was put in issue by answer of The R. S. Howard Company which denied the applicability in the premises of Section 4915, R. S., U. S. and asserts want of power and authority on part of the trial court in the premises "to grant the relief prayed for in the amended bill or to enjoin or restrain
92 the Commissioner of Patents from cancelling said Trade Mark Registrations," and was again and further put in issue by a motion filed by said R. S. Howard Company to dismiss the bill of complaint, on the ground, among others, that the trial court was without authority to grant the relief prayed or any other relief in the premises.

On hearing, the trial court on his appreciation of the opinion and ruling of the Supreme Court of the United States in Baldwin Company v. R. S. Howard Company, ubi supra, held that Interveners' objection and motion to dismiss for want of jurisdiction was not well founded, overruled same, and granted an injunction pendente lite as prayed in plaintiff's said bill of complaint.

To review such order, the case was duly brought into the Court of Appeals of the District of Columbia for review.

The Court of Appeals, first holding (all the Justices agreeing) that "The case turns upon the jurisdiction of the Supreme Court of the District of Columbia to entertain the suit," reviewed the above cited opinions of the Supreme Court of the United States and being of opinion (Mr. Justice Robb, dissenting) that "there is no authority for the maintenance of this suit," reversed the decision of the trial court and remanded the case with instructions to dismiss the bill of complaint with costs.

It is to review the decision of this Honorable Court upon the single question of jurisdiction considered and disposed of by it and upon which alone its final decree entered in the cause was made to turn, that allowance of this appeal is prayed.

93 Applicable provisions of the Judicial Code are as follows:

Sec. 250. Any final judgment or decree of the Court of Appeals of the District of Columbia may be reexamined and affirmed, reversed, or modified by the Supreme Court of the United States, upon writ of error of appeal in the following cases:

First. In cases in which the jurisdiction of the trial court is in issue; but when any such case is not otherwise reviewable in said Supreme Court, the question of jurisdiction alone shall be certified to said Supreme Court for decision.

Sixth. In cases in which the construction of any law of the United States is drawn in question by the defendant.

John E. Cross, McKenney & Flannery, Attorneys for Baldwin Company.

94 Court of Appeals of the District of Columbia, January Term, 1923.

[Title omitted.]

Appeal from the Supreme Court of the District of Columbia.

Assignment of Errors.

[Filed Mar. 12, 1923.]

Now comes The Baldwin Company, appellant, and makes and files this its assignments of error on appeal to the Supreme Court of the United States from the decree of the Court of Appeals of the District of Columbia entered in the above entitled cause on the 5th day of February, A. D., 1923.

1. Error on part of the Court of Appeals of the District of Columbia in holding that the Supreme Court of the District of Columbia was without jurisdiction to entertain this suit.

2. Error on part of the Court of Appeals of the District of Columbia in reversing the decision and order of the Supreme Court of the District of Columbia, appealed from, for want of jurisdiction and remanding the cause with directions to dismiss plaintiff's bill of complaint with costs. McKenney & Flannery, John E. Cross, Attorneys for the Baldwin Company, Appellant.

95

96 [File endorsement omitted.]

97 Monday, March 12th, A. D. 1923.

* * * * * * *

[Title omitted.]

Order Allowing Appeal.

On motion of Mr. F. D. McKenney of counsel for appellee, It is ordered that an appeal to the Supreme Court of the United States in the above entitled cause be and the same is hereby allowed and the bond to act as supersedeas is fixed at the sum of three hundred dollars.

98

Bond on Appeal.

[Filed Mar. 12, 1923.]

Know all men by these presents, That we, The Baldwin Company, as principal, and United States Fidelity and Guaranty Company, a Corporation, as surety, are held and firmly bound unto Thomas E. Robertson as Commissioner of Patents and R. S. Howard Company, Intervener, in the full and just sum of Three Hundred ($300) dol-

lars, to be paid to the said Thomas E. Robertson as Commissioner of Patents and R. S. Howard Company, Intervener, his its or their certain attorney, executors, administrators, or assigns; to which payment, well and truly to be made, we bind ourselves, our heirs, executors, and administrators, jointly and severally, by these presents. Sealed with our seals and dated this 12th day of March, in the year of our Lord one thousand nine hundred and twenty-three.

Whereas, lately at a Court of Appeals of the District of Columbia in a suit depending in said Court, between Thomas E. Robertson as Commissioner of Patents and R. S. Howard Company, Intervener, vs. The Baldwin Company—No. 3854—a decree was rendered against the said—The Baldwin Company—and the said—The Baldwin Company—having prayed and obtained an appeal to the Supreme Court of the United States to reverse the decree in the aforesaid suit, and a citation directed to the said Thomas E. Robertson as Commissioner of Patents and R. S. Howard Company, Intervener, citing and admonishing them to be and appear at a Supreme Court of the United States, at Washington, within thirty days from the date thereof;

Now, the condition of the above obligation is such, That if the said The Baldwin Company shall prosecute said appeal to effect, and answer all damages and costs if it fail to make its plea good, then the above obligation to be void; else to remain in full force and virtue. The Baldwin Company, by F. D. McKenney, Its Attorney. [Seal.] United States Fidelity and Guaranty Company, by Louis L. Perkins, Attorney in Fact. [Seal.] (Seal of United States Fidelity and Guaranty Co.) Sealed and delivered in presence of C. Edw. Wright, as to the Baldwin Company.

Approved by C. J. Smyth, Chief Justice Court of Appeals of the District of Columbia.

[File endorsement omitted.]

99 **Citation and Service.**

[Filed Mar. 15, 1923.]

UNITED STATES OF AMERICA, *ss:*

To Thomas E. Robertson, as Commissioner of Patents, and R. S. Howard Company, Intervener, Greeting:

You are hereby cited and admonished to be and appear at a Supreme Court of the United States at Washington, within 30 days from the date hereof, pursuant to an order allowing an appeal, filed in the Clerk's Office of the Court of Appeals of the District of Columbia, wherein United States of America ex relatione The Baldwin Company is appellant and you are appellees, to show cause, if any there be, why the decree rendered against the appellant, should not be corrected, and why speedy justice should not be done to the parties in that behalf.

Witness, the Honorable Constantine J. Smyth, Chief Justice of the Court of Appeals of the District of Columbia, this Twelfth day of

March, in the year of our Lord one thousand nine hundred and Twenty-three. Constantine J. Smyth, Chief Justice of the Court of Appeals of the District of Columbia.

Service acknowedged this 13th day of March, 1923. Samuel S. Watson, Attorney for the Baldwin Company.

100 [File endorsement omitted.]

101 Court of Appeals of the District of Columbia, January Term, 1923.

No. 3854.

[Title omitted.]

Designation of Record on Appeal.

[Filed Mar. 14, 1923.]

In making up the transcript of record on appeal to the Supreme Court of the United States in the above entitled cause, the Clerk of the Court of Appeals of the District of Columbia will please include therein the following papers:

1. The entire transcript of record as filed in the Court of Appeals of the District of Columbia.
2. Argument.
3. Opinion and Dissent.
4. Final Decree of the Court of Appeals.
5. Petition for allowance of appeal to the Supreme Court of the United States.

102 6. Order allowing appeal and fixing bond, $300, to operate as supersedeas.

7. Appeal bond.
8. Citation, acceptance of service.
9. Assignment of errors.
10. Copy this Designation.

Yours very truly, McKenney & Flannery, Attorneys for the Baldwin Company, Appellant.

[File endorsement omitted.]

103 Court of Appeals of the District of Columbia.

Clerk's Certificate.

I, Henry W. Hodges, Clerk of the Court of Appeals of the District of Columbia, do hereby certify that the foregoing printed and typewritten pages numbered from 1 to 102 inclusive constitute a true copy of the transcript of record and proceedings of said Court of

Appeals, as designated by counsel, in the case of Thomas E. Robertson, as Commissioner of Patents, and R. S. Howard Company, Appellants, vs. The United States of America ex Relatione the Baldwin Company, No. 3854, January Term, 1923 as the same remain upon the files and records of said Court of Appeals.

In testimony whereof, I hereunto subscribe my name and affix the seal of said Court of Appeals, at the City of Washington, this twenty-first day of March, A. D. 1923. Henry W. Hodges, Clerk of the Court of Appeals of the District of Columbia. Seal of the Court of Appeals, District of Columbia.

Endorsed on cover: File No. 29,468. District of Columbia Court of Appeals. Term No. 918. The United States of America ex relatione the Baldwin Company, appellant, vs. Thomas E. Robertson, as Commissioner of Patents, and R. S. Howard Company. Filed March 22d, 1923. File No. 29,468.

IN THE

SUPREME COURT OF THE UNITED STATES.

OCTOBER TERM, 1898.

No. [illegible]

THE UNITED STATES OF AMERICA EX RELATIONE
THE BALDWIN COMPANY, Petitioner,

vs.

THOMAS T. ROBERTSON, as Commissioner of Patents,
and E. HOWARD COMPANY, Respondent.

PETITION FOR ALLOWANCE OF CERTIORARI TO THE COURT
OF APPEALS OF THE DISTRICT OF COLUMBIA.

PETITION FOR CERTIORARI AND BRIEF.

[illegible]
JOHN [illegible] KENNEDY,
[illegible] & McKENNEY,
Attorneys for Petitioner, The Baldwin Company.

IN THE

SUPREME COURT OF THE UNITED STATES.

OCTOBER TERM, 1922.

No. 918.

THE UNITED STATES OF AMERICA *EX RELATIONE* THE BALDWIN COMPANY, PETITIONER,

vs.

THOMAS E. ROBERTSON, AS COMMISSIONER OF PATENTS, AND R. S. HOWARD COMPANY, INTERVENER, RESPONDENTS.

PETITION FOR ALLOWANCE OF CERTIORARI TO BE ISSUED TO THE COURT OF APPEALS OF THE DISTRICT OF COLUMBIA.

PETITION FOR CERTIORARI.

Petitioner, The Baldwin Company, a corporation under the laws of the State of Ohio, engaged in the manufacture and sale of high-grade pianos and the owner of two certain duly registered trade-marks for use on and long used by it in connection with such manufacture and sales, comes now

before this Honorable Court and respectfully represents as follows:

1. Petitioner is now and for many years last past has been the sole owner of trade-mark for pianos consisting of the word "Howard" accompanied by initials "V. G. P. Co." arranged in the form of a monogram, printed or impressed in a particular and distinctive manner and duly registered in the United States Patent Office in accord with law on the 8th day of March, 1898, same being numbered 31,411 on the Register of Trade Marks preserved in said Patent Office.

Petitioner also is now and for many years last past has been the sole owner of another trade-mark for pianos consisting of the word "Howard" alone, printed or impressed in a particular and distinctive manner and duly registered in the United States Patent Office in accord with law on the 17th day of October, 1905, same being numbered 46,993 on said Register of Trade Marks.

As such sole owner of said duly registered trade-marks your petitioner has been and is grievously wronged by a certain final decree of the Court of Appeals of the District of Columbia passed and made of record in said Court on the 5th day of February, A. D. 1923, in a cause wherein Thomas E. Robertson, as Commissioner of Patents, and R. S. Howard Company, intervener, respondents above named, were appellants and The United States of America on the relation of The Baldwin Company, your petitioner, was appellee, said cause being numbered 3854 on the docket of said Court of Appeals of the District of Columbia.

Apart from the mere matter of error apparent in said final decree of the said Court of Appeals of the District of Colum-

bia which particularly wrongs and especially affects this petitioner, said final decree and the righting thereof is of interest to all owners of duly registered trade-marks who may be or at any time may come in like situation with that in which the petitioner, notwithstanding its full acceptance of and strict compliance with the principles of decision and rules of action outlined and defined in previous decisions of this Honorable Court (*Gaines vs. Knecht*, 212 U. S., 561, cited with approval in *Atkins vs. Moore*, 212 U. S., 285; *Baldwin Co. vs. Howard Co.*, 256 U. S., 35), has come and is now placed by reason of the opinion and decree of said Court of Appeals of the District of Columbia here complained of and prayed to be removed into this Honorable Court on certiorari, so that, in so far as same may be found to differ in matters of principle or substance from the conclusions of this Court as expressed in the reported cases referred to, same may be modified or reversed and remanded to said Court of Appeals with instructions for further action therein.

Wherefore petitioner, The Baldwin Company, citing in such behalf the pertinent provisions of sections 250 and 251 of the Judicial Code, which read as follows:

> "SEC. 250. * * * Except as provided in the next succeeding section (*i. e.*, sec. 251) the * * * decrees of said Court of Appeals (of the District of Columbia) shall be final in all cases arising under the patent laws, * * * and in all cases not reviewable as hereinbefore provided.
>
> "SEC. 251. In any case in which the * * * decree of said Court of Appeals (of the District of Columbia) is made final by the section last preceding, it shall be competent for the Supreme Court of the

> United States to require, by *certiorari*, * * *, such case to be certified to it for its review and determination, with the same power and authority in the case as if it had been carried by writ of error or appeal to said Supreme Court,"

most respectfully and earnestly prays issuance of the writ of certiorari as in said sections of the Judicial Code provided, upon the grounds and for the reasons above indicated and more specifically set forth as follows:

2. The parties to the instant proceeding other than Thomas E. Robertson, as Commissioner of Patents, were parties to certain causes of action heretofore attempted to be brought before this Court both on appeal and by certiorari (*Baldwin Co. vs. Howard Co.*, 256 U. S., 35).

In the instant case, as in the cases cited, the controversy is single and involves an attempt by R. S. Howard Company to secure cancellation of the registrations of the two trade-marks above described, owned by the Baldwin Company and long used by it in connection with its manufacture and sale of pianos.

Applications for cancellation of the trade-marks in question were filed in the United States Patent Office by R. S. Howard Company in August, 1914, and went to hearing in regular course. Pending such hearings the Baldwin Company instituted suit against R. S. Howard Company in the District Court of the United States for the Southern District of New York which resulted in a final decree in favor of the Baldwin Company in pertinent part reading as follows:

"First. That the name 'Howard' without prefix or suffix, on pianos, or contained in advertisements or otherwise used in connection with pianos, indicates that the pianos bearing or referred to by said name, are the product of the plaintiff, the Baldwin Company, and said name 'Howard' distinguishes plaintiff's pianos from the pianos of all other manufacturers, and that the plaintiff, the Baldwin Company, and its predecessors in business, have been ever since December, 1896, and the Baldwin Company now is the true, lawful and sole owner of said word 'Howard' as a name for its pianos, and it alone is entitled to use the said word (simpliciter) on pianos, or in advertising matter relating thereto.

"Second. That the defendant, R. S. Howard Company, has infringed upon and violated the rights of the plaintiff in its said name 'Howard' by threatening to use the said word on pianos not the product of the plaintiff, and by using the same in advertisements and otherwise in connection with the sales of its said pianos and by placing said name on the back of its pianos.

"Third. That an injunction issue out of and under the seal of this court restraining and enjoining said defendant, R. S. Howard Company, its officers, agents, servants, clerks, employees, and workmen, and all persons claiming or holding through or under it or in privity with it, and each and every of them, perpetually and forever, from directly or indirectly making or causing to be made, selling, or causing to be sold, or offering for sale pianos bearing the said word 'Howard' and not the product of the plaintiff, except with the initials 'R. S.' or the name 'Robert S.' prefixed and the word 'Company' affixed to the said word 'Howard' wherever the said word appears

on said pianos or boxes or packages containing the same, and from marking or advertising or describing in any manner by said word, pianos not the product of the plaintiff except with the initials 'R. S.' or the name 'Robert S.' prefixed to said word and with the word 'Company' affixed thereto in as conspicuous and prominent a manner as the word 'Howard,' and from marking, advertising, or describing pianos manufactured or sold by it with any name or in any manner calculated or liable to confuse or deceive purchasers into the belief that said pianos are the product of the plaintiff.

"Fifth. That the plaintiff (The Baldwin Company), has the right to use the name 'The Howard Piano Company' as a name for one of the corporations, owned and controlled by it, and it alone is entitled to use the word 'Howard' without prefix or suffix in the name of any company, firm or corporation that manufactures pianos bearing said name, and that the defendant's counterclaim be and it hereby is, dismissed with costs." * * *

(233 Federal Reporter, 439.)

This decree was affirmed by the United States Circuit Court of Appeals for the Second Circuit (238 Federal Reporter, 154) and a certified copy of the transcript of record embracing said decree having been filed in the proceedings for cancellation then pending in the United States Patent Office, both the Examiner of Interferences and the Commissioner of Patents denied the application of R. S. Howard Company to cancel the registrations, the former in part saying that—

"It may therefore be regarded as definitely determined by the Circuit Court of Appeals of the Second

Circuit that the Baldwin Company, the registrant and defendant herein, is entitled to use the word 'Howard' (*simpliciter*) upon the fall-boards of pianos, whereas the R. S. Howard Company, the petitioner herein, is restricted to the use of 'R. S. Howard,' 'Robert S. Howard,' or 'R. S. Howard Company,' etc. This decision is final and binding upon the parties. The exact rights of the parties as to their use of the name 'Howard' are therefore now settled and determined. * * *

"It is also urged that the registration should be canceled because the name 'Howard' is the essential part of the petitioner's name. But the Court of Appeals of the Second Circuit in the decision above referred to has definitely held that the registrant had used 'Howard' upon its pianos long prior to the time the R. S. Howard Company began business, and that such use was with the knowledge and consent of R. S. Howard personally. The cases referred to in petitioner's brief do not go so far as to justify cancellation under such circumstances. The rule is that a party may not register as a trade-mark a word which is at the time of adoption the essential part of the name of another (*The Asbestone Co. vs. The Philip Carey Manufacturing Co.*, 200 O. G., 857; 41 App. D. C., 507); but a party cannot adopt as a part of its name the trade-mark of another, and then claim any special rights as against the trade-mark owner. While the petitioner herein claims superior rights to the name 'Howard,' the court in the equity suit has held otherwise."

On appeal to the Commissioner of Patents, the reasoning and conclusions of the Examiner of Interferences in the premises were upheld, the Commissioner, in part, saying:

"The Examiner of Interferences held that if the R. S. Howard Company is not entitled to use the word 'Howard' alone, it was not damaged by the registrations unless for some reason not considered by the court. He considered the question whether the registrations were invalid by reason of the fact that 'Howard' was the essential part of the petitioner's name, but held that a party could not adopt as a part of its name the trade-mark of another and then claim any special rights as against that party. He also considered the question whether the R. S. Howard Company was damaged by the use of Registration No. 46993 by the Baldwin Company as a basis for securing registration in certain foreign countries and held that the R. S. Howard Company had not established any such damage.

"In the decision of the District Court the relation of the parties is set out at length. It appears that R. S. Howard was a piano salesman and was connected with various piano companies; that for several years he was connected with the Baldwin Company, and in 1902 organized the R. S. Howard Company and has been connected therewith ever since.

"The decision in the suit determined fully the rights between these parties so far as the use of the name 'Howard' is concerned. The R. S. Howard Company cannot use the word 'Howard' alone, or prevent the use of the word 'Howard' alone by the Baldwin Company, and the Baldwin Company cannot prevent the use by the R. S. Howard Company of the words 'R. S. Howard Company,' or 'Robert S. Howard Company.'

"It is well settled by a long line of decisions of the Court of Appeals of the District of Columbia that a party cannot sustain a cancellation proceeding unless he can establish that he is damaged by the regis-

tration of the mark. The rights of the parties to the use of the mark in this country having been fully determined by the court it is not seen how the rights of the R. S. Howard Company are in any way affected by the registration. No suit could be sustained against the R. S. Howard Company for any use of the words 'R. S. Howard Company,' or 'Robert S. Howard Company,' and it has no right to the use of the word 'Howard' alone.

"So far as the question of foreign registrations is concerned, there is no testimony that the R. S. Howard Company has in any way been interfered with in its trade in foreign countries where the pianos were marked with the name of the company, and they have under the court decree no right to mark them otherwise. * * *

"It may be noted, as appears from the record and as stated in the decisions of both courts that the earlier registration was obtained with the full knowledge of R. S. Howard; that he made no objection to its registration and he made no objection to the use of the word 'Howard' by the Baldwin Company for several years after he left its employ. It is further to be noted that at one time a suit was brought in the courts of New York by R. S. Howard to prevent the use of the word 'Howard' by the Baldwin Company but this suit was withdrawn and the Baldwin Company continued to use the word 'Howard' for a number of years thereafter and built up a large trade without any objection on the part of R. S. Howard or the R. S. Howard Company until the cancellation proceeding was brought in 1914.

* * * * * * *

"It is urged that the name 'Howard' and the name 'R. S. Howard Company,' or 'Robert S. Howard Com-

> pany,' are substantially the same, and therefore there would be likelihood of confusion. The best evidence, however, on this point is the fact that although the Baldwin Company has continuously used the word 'Howard' since a time prior to the organization of the R. S. Howard Company and the R. S. Howard Company has been in business since 1902, yet there is on the record no proof of any confusion."

The petition for cancellation accordingly was ordered to be dismissed. To review that order, R. S. Howard Company, under provisions of section 9 of the Act of February 20, 1905, chapter 592 (33 Stats., 728), reading as follows:

> "SEC. 9. That if * * * party to an application for the cancellation of the registration of a trade-mark, is dissatisfied with the decision of the Commissioner of Patents, he may appeal to the Court of Appeals of the District of Columbia, on complying with the conditions required in case of an appeal from the decision of the Commissioner by an applicant for patent, or a party to an interference as to an invention, and the same rules of practice and procedure shall govern in every stage of such proceedings, as far as the same may be applicable,"

appealed to the Court of Appeals of the District of Columbia, where, after hearing, it was said (Van Orsdel, Associate Justice):

> "The court decisions (District Court, Southern District of New York and Circuit Court of Appeals for Second Circuit) can be dismissed from further consideration, since they were confined solely to the question of unfair competition, a matter of no concern in this proceeding, either by way of estoppel or

> otherwise. We are here dealing with the validity of the registration of the marks in question, in a proceeding in which the Commissioner of Patents is vested by statute with exclusive jurisdiction. * * * Unquestionably, the Baldwin Company was the first to make a trade-mark use of the word 'Howard,' but in our view of the case that is of no importance. * * * The right to register the name of a person or corporation, except under conditions not present in either of these cases, is expressly forbidden. *Rogers vs. International Silver Co.*, 34 App. D. C., 410. The mark in the Baldwin case * * * is not only a common surname, but the name of appellant corporation, either of which is sufficient to prohibit the right of registration or to form the basis of an action for cancellation."* * * * *

and further, that where, as assumed in the case then before it, the party applying for cancellation of a registered trade-mark sought

> "to prevent the adoption of his (its) name as a trade-mark or the cancellation of its registration, his (such) action is grounded upon the invasion of a right inhering in the name itself, and damage will be presumed. It is the corporate name, and it is sufficient that possible damage may be inferred from invading the property right which the corporation possesses in its name."

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*FOOT NOTE.—In reaching the conclusion so expressed the learned Court of Appeals of the District of Columbia either inadvertently overlooked concurring findings and conclusions of the Patent Office officials to the effect that a corporation such as R. S. Howard Company could not adopt as part of its corporate name the trade-mark previously in use by another and then claim common surname rights against the earlier user or intentionally ignored the same.

In conclusion the learned Court of Appeals of the District of Columbia ordered the decision of the Commissioner of Patents to be reversed and directed its clerk "to certify these proceedings as by law required."

To review such wrongful interpretation and application of the provisions of the trade-mark laws, The Baldwin Company made its appeal to and filed in this honorable court its application for certiorari above referred to. (See 256 U. S., 35.)

In dismissing such appeal and denying such petition for certiorari, both on the ground of want of statutory finality in the decrees complained of, this Court, through Mr. Justice Day, after first commenting upon the earlier case of *Frasch vs. Moore* (212 U. S., 1), in which the opinion of Mr. Chief Justice Alvey, speaking for the Court of Appeals of the District of Columbia in *Rousseau vs. Brown* (21 App. D. C., 73, 80), was fully approved, said:

> "In *Atkins vs. Moore* (212 U. S., 285), application for registration of a trade-mark was refused by the Examiner, which action was approved by the Commissioner, and affirmed on appeal by the Court of Appeals of the District of Columbia, an appeal and writ of error were allowed, both of which were dismissed in this Court. The previous decisions of this Court were reviewed by Chief Justice Fuller, speaking for the Court, and in concluding the opinion he said:
>
> " 'In the light of the various details of the Act of February 20, 1905, and of the specific provisions of section 9, we were of opinion (*Gains vs. Knecht*, 212

U. S., 561) that proceedings under the act were governed by the same rules of practice and procedure as in the instance of patents, and the writ of error was accordingly dismissed. The same result must follow in the present case.

"'Under section 4914 of the Revised Statutes no opinion or decision of the Court of Appeals on appeal from the Commissioner precludes "any person interested from the right to contest the validity of such patent in any court wherein the same may be called in question," and by section 4915 a remedy by bill in equity is given where a patent is refused, and we regard these provisions as applicable to trade-mark cases under section 9 of the act of February 20, 1905.'

"We are of opinion that the principle there announced controls this case. No provision is made which permits this statutory proceeding to be carried beyond the decision of the Court of Appeals of the District of Columbia, the decision of which court is directed to be certified to the Commissioner of Patents."

In strict accord with the intimations of this opinion as extracted and quoted above, the Baldwin Company, your petitioner, promptly filed in the Supreme Court of the District of Columbia its bill of complaint herein (R., 1-10), praying that upon the facts averred and conceded by defendants that Thomas E. Robertson, individually and as Commissioner of Patents, be enjoined from cancelling on or erasing from the records of the United States Patent Office the notations evidencing the registration of the above-described trade-marks.

As a further basis for the relief prayed petitioner also asserted rights under Article 5 of the amendments to the Constitution of the United States.

In the Supreme Court of the District of Columbia, R. S. Howard Company was permitted to intervene as a party defendant, and by answer and motion to dismiss drew in question the applicability of sections 4914 and 4915 of the Revised Statutes of the United States, insisting that, notwithstanding the expressed opinion of this Court to the contrary, such sections when correctly construed did not confer jurisdiction upon the Supreme Court of the District of Columbia to entertain such a bill in equity or to grant the relief therein prayed.

On hearing of application for injunction *pendente lite*, the Supreme Court of the District of Columbia (Mr. Justice Hoehling sitting) upheld its jurisdiction in the premises, overruled R. S. Howard Company's motion to dismiss, and issued injunction *pendente lite*, saying (R., p. 73):

> "In view of the holding of the Supreme Court of the United States, *supra*, to the effect that the decisions of the Court of Appeals of this District, both in patent and trade-mark cases, are in no sense a final judgment reviewable upon certiorari or appeal, but are only the return by that court of a certificate to the Commissioner of Patents to be there entered of record to govern further proceedings in the case; in view of the further holding of said Supreme Court that secs. 4914 and 4915, R. S. U. S., are applicable in trade-mark cases; and, finally, in view of the express holding of the Supreme Court that this case is controlled by the principles so announced, the conclusion seems necessarily to follow that the Supreme Court, having before it an application to review the adverse holding of the Court of Appeals, *supra*, and finding itself without jurisdiction to entertain the same, either on appeal or by certiorari; nevertheless,

in direct and express terms and language, pointed out a method and way in which such judicial review of the questions might be secured.

"If that be not the true intent and meaning of the decision of that court, then the language of the opinion must be denied its ordinary, plain, and usual meaning.

"If, therefore, there be open to the plaintiff, Baldwin Co., an opportunity for judicial review of the questions raised in this suit, under said sections 4914 and 4915, R. S. U. S., and the Supreme Court apparently has so held, then, pending the proceeding, the status of the subject-matter of the litigation should be preserved unimpaired, since the remedy so given would be futile if, pending the proceeding, the trade-mark registrations be permitted to be canceled.

"Accordingly, the court is of opinion that the motion of defendant Howard Co. to dismiss should be overruled, and that the application of plaintiff, Baldwin Co., for preliminary injunction should be granted. Appropriate order in that behalf may be prepared by counsel and submitted, upon due notice."

On appeal to the Court of Appeals of the District of Columbia, that Court, by a majority, the Chief Justice and Mr. Justice Van Orsdel concurring, reversed the decree of the trial justice and directed the bill of complaint to be dismissed for want of jurisdiction, saying:

"That the Act of February 20, 1905, makes it clear that the decisions of this Court in trade-mark cases are not final is beyond question. (See sec. 16.) But the thing which makes trouble is the observation that the Court (Supreme Court, U. S.) regards the pro-

visions of section 4915 applicable in trade-mark cases under section 9 of the Act of February 20, 1905. We do not think that the Court was considering anything but the question as to whether or not the decision of this Court was final. That was the point before it and the one on which the thought of the Court centered. The provisions of the Trade-mark Act, especially section 16, furnished ample authority for the conclusion which it had reached. The Court had no occasion to determine whether section 4915 gave a defeated applicant for registration the right to commence a proceeding in equity, and we do not think it intended to so decide. In this we are supported by a statement in the last opinion of the court upon the subject. *Baldwin Co. vs. Howard Co.* (*supra*). Mr. Justice Day, who spoke for the Court in that case, after referring to the decisions in the Frasch, Atkins, and Gaines cases, wherein the various statutory sections about which we have been writing were referred to, said: 'No provision is made which permits this statutory proceeding to be carried beyond the decision of the Court of Appeals of the District of Columbia, the decision of which Court is directed to be certified to the Commissioner of Patents.' The statutory proceeding referred to is the one relating to the registration of trade-marks, the decisions of the Commissioner touching the same, and the review of these decisions by this Court. This proceeding, according to the learned Justice, cannot be carried beyond the decision of the Court of Appeals. In other words, the questions of registration, cancellation, opposition, and interference in trade-mark cases are ended by our decision. The only thing decided in such a proceeding is as to whether or not the mark shall be registered, or, having been registered, whether or not it shall be canceled. The effect of the registra-

tion, as we have seen, is simply to provide a rule of evidence which under section 16, *supra,* casts upon him who would attack the right of the registrant to the mark the burden of establishing his claim in an infringement, unfair competition, or other proper proceeding. We think the Court had this in mind when it said that there was no authority for carrying the statutory proceeding beyond the decision of the Court of Appeals.

"Believing that there is no authority for the maintenance of this suit, we reverse the decision appealed from and remand the case, with instructions to dismiss the suit, costs to be assessed against appellee."

By way of dissent from the opinion of his associates, Mr. Justice Robb, supporting the view of Mr. Justice Hoehling, expressed his appreciation of the opinion of this Honorable Court above cited and quoted from, as follows:

"Section 9 of the Trade-mark Act of February 20 1905 (33 Stat., 724), authorizes an applicant for registration of a trade-mark, a party to an interference as to a trade-mark, a party who has filed an opposition to the registration of a trade-mark, or a party to an application for the cancellation of the registration of a trade-mark, to appeal from the decision of the Commissioner of Patents to this Court, on compliance with conditions incident to an appeal by an applicant for patent or a party to an interference, as to an invention, and it is further provided that 'the same rules of practice and procedure shall govern in every stage *of such proceedings,* as far as the same may be applicable.' Were this an open question, the force of the argument of my associates would lead me to their conclusion that the provision last quoted refers only to proceedings in this court, and that view

would be further strengthened by the specific provisions of section 22 of the Trade-mark Act, which apparently were intended to restrict and limit the right to equitable relief to parties to 'interfering registered trade-marks.' However, as I read the opinion of the (Supreme) Court in *Baldwin Co. vs. Howard Co.*, 256 U. S., 35, 39, it there is intimated that section 4915, R. S., authorizes a remedy by bill in equity in a case like the present. Therefore, while it is quite possible that, when the provisions of section 22 of the Trade-mark Act are brought to the attention of the Supreme Court and a definite ruling invoked, the conclusion reached by my associates will be approved, I now feel constrained to give full force and effect to the suggestion in the Howard case and to dissent here."

To review the final decree of the Court of Appeals reversing the conclusions of the Supreme Court of the District of Columbia and remanding the cause with instructions to dismiss the bill of complaint with costs, plaintiff, the Baldwin Company, your petitioner, prayed and perfected its appeal to this Honorable Court under the first and sixth provisions of section 250 of the Judicial Code as follows:

"SEC. 250. Any final judgment or decree of the Court of Appeals of the District of Columbia may be reexamined and affirmed, reversed, or modified by the Supreme Court of the United States, upon writ of error or appeal, in the following cases:

"First. In cases in which the jurisdiction of the trial court is in issue; but when any such case is not otherwise reviewable in said Supreme Court, then the question of jurisdiction alone shall be certified to said Supreme Court for decision.

* * * * * * *

"Sixth. In cases in which the construction of any law of the United States is drawn in question by the defendant."

and said appeal has heretofore been docketed and is numbered 918 on the docket for the current October term of this court.

As plaintiff's bill of complaint in the circumstances above narrated depended at least in part, for its maintenance in point of jurisdiction, both upon the terms of section 4915 of the Revised Statutes, a patent law, and upon section 9 of the trade-mark law, and as, by certain provisions of section 250 of the Judicial Code above quoted, the decrees of the Court of Appeals of the District of Columbia are made final in all cases arising under the patent laws, except certiorari from this court under section 251 be issued to review same, it may be doubted whether the appellate power of this court should be exercised herein on appeal or by certiorari (*Gompers vs. United States*, 233 U. S., 604; *Chott vs. Ewing*, 237 U. S., 197, 200, 201); it is therefore respectfully prayed, notwithstanding the pendency of this cause in this Court upon an appeal duly allowed and perfected, out of abundant caution and to obviate a possible failure of justice because of a mistake in procedure, that petitioner may be granted a writ of certiorari to said Court of Appeals of the District of Columbia, as herein prayed, or in the alternative that final consideration of this petition for certiorari be postponed until the case as now docketed and pending on the appeal allowed by the Court of Appeals of the District of Columbia (No. 918, Oct. term, 1922), shall have been reached and heard on said docket in the regular call of cases for argument.

Apart from the plain lack of uniform appreciation and understanding on part of learned judges of the lesser courts of the purport and controlling purpose of the rulings of this Court as manifested in the reported cases of *Frasch vs. Moore* (211 U. S., 1); *Gaines vs. Knecht* (212 U. S., 561); *Atkins & Co. vs. Moore, Com'r.* (212 U. S., 285), and *Baldwin Co. vs. Howard Co.* (256 U. S., 35), heretofore referred to, it is also urged as a further reason why the certiorari prayed for should be granted that relying upon the usually accepted interpretation of the opinions of this Court in the cases above cited, numerous bills of complaint founded upon the asserted applicability of said sections 4914 and 4915 of the Revised Statutes of the United States in cases involving the registration or cancellation of registrations of trademarks have been instituted in the United States District courts in and for various judicial districts and have heretofore been decided or are still pending therein or on appeal therefrom. Among such cases petitioner cites the following:

Old Lexington Club Distillery Co. vs. Kentucky Distilleries (Dist. Ct. U. S., Dist. of N. J.), 234 Fed., 464.

Hercules Powder Co. vs. Newton, Com'r (Dist. Ct. U. S., Southern District of New York), 254 Fed., 906.

American Steel Foundries vs. Robertson, Com'r (from the District Court for the Northern District of Illinois, No. 291 O. T., 1922; argued and submitted April 19, 1922).

McIlhenney Co. vs. New Iberia Extract & Tab. Pepper Co. (pending in Dist. Ct. U. S. for Eastern Dist. of Louisiana).

Chero-Cola Co. vs. Coca-Cola Co. (pending in Dist. Ct. U. S., Northern Dist. of Georgia).

Loughran vs. Quaker City Chocolate &c., Co., Inc., 281 Fed. Rep., 186, 187; 286 Fed. Rep. (advance part 4) 694.

In the last-cited case the plaintiff had applied for the registration of a trade-mark and application had been refused by the Commissioner of Patents. Applicant thereupon brought his bill in equity under R. S., Sec. 4915, to require the Commissioner to admit the mark to registration and to issue certificate therefor. No question as to the right of applicant to maintain its bill for this purpose was raised.

Apart from considerations based upon the prohibitions of the 5th Amendment, it is respectfully submitted, the opinion and decree of the learned Court of Appeals of the District of Columbia to the contrary notwithstanding, that petitioner's bill of complaint in the instant case was properly brought under applicable provisions of the trade-mark laws of the United States, particularly under those of the Act of February 20, 1905, as amended, operating in conjunction with the provisions of section 4915, R. S. U. S., as construed and interpreted by this Honorable Court in

Frasch vs. Moore, 211 U. S., 1.
Gaines vs. Knecht, 212 U. S., 561.
Atkins & Co. vs. Moore, 212 U. S., 285.
Baldwin Co. vs. Howard Co., 256 U. S., 35.

In the interest of clarity of view and uniformity of decision, it is further submitted, with great respect, that this petition for certiorari should be granted, and upon hearing

the decree of the Court of Appeals of the District of Columbia directing the dismissal of petitioner's bill of complaint should be reversed with directions to permit the further prosecution of the cause.

THE BALDWIN COMPANY,
By H. C. DICKINSON,
Its Vice-President.

JOHN E. CROSS,
JOHN SPALDING FLANNERY,
FREDERIC D. McKENNEY,
Attorneys for Petitioner,
The Baldwin Company.

LAWRENCE MAXWELL,
Of Counsel.

To R. S. Howard Co. and S. S. Watson:

Please take notice that we will submit the foregoing Petition for Certiorari to the Supreme Court of the United States on Monday, May 21, 1923, at 12 o'clock noon, or so soon thereafter as counsel may be heard.

JOHN E. CROSS,
J. SPALDING FLANNERY,
FREDERIC D. McKENNEY,
Attorneys for The Baldwin Company.

BRIEF IN SUPPORT OF PETITION.

In paragraph eleven (11) of its bill of complaint herein, The Baldwin Company represented that, based on certified copies of the registration proceedings had in the United States Patent Office as evidenced by registration certificate number 46,993 of October 17, 1905, for the mark "Howard," it had obtained registration of said mark "Howard" in a number of foreign countries and was making use thereof in connection with sales of its pianos in said foreign countries; that cancellation in the United States Patent Office of the basic registration would result in the automatic cancellation of the ancillary registrations in such foreign countries, and so work inevitable and irreparable injury to the foreign business which plaintiff had built up at great expense to itself, and of which R. S. Howard Company enviously was desirous of reaping the benefit, and that by such registration both in the United States and elsewhere it had acquired and was possessed of a vested property interest in the continued maintenance of record of such trade-mark registrations, the summary cancellation of which in the United States Patent Office, under the circumstances narrated would deprive plaintiff of property rights contrary to the prohibitions of the Fifth Article of the Amendments to the Constitution of the United States, in that in so doing, plaintiff would be deprived of its property without due process of law.

In addition to such ground for relief, plaintiff also invoked the affirmative provisions of section 9 of the Trade-

mark Law in conjunction with sections 4914 and 4915 of the Revised Statutes, as same had been construed by this court in

Gaines vs. Knecht, 212 U. S., 561.
Atkins vs. Moore, 212 U. S., 285, 290.
Baldwin Co. vs. Howard Co., 256 U. S., 35.

As The Baldwin Company based its assertion of right to the relief prayed in its bill of complaint both upon the due process clause of the Fifth Amendment and upon the trade-mark law in association with the provisions of section 4915 of the Revised Statutes, as same had been construed by this court, there would seem to be no room for real doubt as to the applicability in the circumstances of the provisions of section 250 of the Judicial Code, which provides for re-examination on appeal, as matter of right, of final decrees of the Court of Appeals of the District of Columbia "In cases in which the jurisdiction of the trial court is in issue;" * * * "In cases involving the * * * application of the Constitution of the United States," and "In cases in which the Constitution or any law of the United States is drawn in question by the defendant."

By its motion to dismiss, defendant R. S. Howard Co. denied the jurisdiction of the Supreme Court of the District of Columbia; denied the applicability of the Fifth Amendment of the Constitution of the United States and drew in question the construction of section 4915 of the Revised Statutes of the United States.

As for reasons satisfactory to itself, the Court of Appeals, in course of its opinion, declared "The case turns upon the jurisdiction of the Supreme Court of the District, to entertain the suit," and directed dismissal solely for want of such

jurisdictional authority; no certificate of the Court of Appeals in such aspect was asked for or required.

Shields vs. Coleman, 157 U. S., 168.

Petri vs. F. E. Creelman Lumber Co., 199 U. S., 487.

McAllister vs. C. & O. R. R. Co., 243 U. S., 302, citing:

Excelsior W. P. Co. vs. Pacific Bridge Co., 185 U. S., 282.

It is with regard to the issues involved in the application of the Fifth Amendment and the proper construction of section 251 of the Judicial Code, as it pertains to the patent laws, of which, in its general aspect, section 4915 is one, that this application for certiorari, out of abundant caution, is respectfully submitted.

The pertinency of the relief sought and the existence of jurisdictional power on part of the Supreme Court of the District of Columbia to grant same in a proper case is aptly illustrated by the opinion and decree of this court in the case of *Noble, Secretary, etc. vs. Union River Logging R. R. Co.,* 147 U. S., 165, 171, which has been cited frequently with approval.

Gaines vs. Knecht, supra, involved considerations arising out of opposition to the registration of a trade-mark, while in the instant case opposition is made to the proposed cancellation of trade-marks previously registered, on the ground among others that any such cancellation would deprive plaintiff of vested property rights without due process of law and thus render section 9 of the trade-mark law, in such particular, invalid.

In *Gaines vs. Knecht,* this court purposely pointed out

the difference in result which flows from such a difference between cases, saying (italics supplied):

> "It may be true that the Commissioner acts in a judicial capacity in determining whether the applicant is the owner of the trade-mark, and whether it is one of those marks the registration of which is prohibited, but when he has determined these in favor of the applicant the act to be performed by him is ministerial merely, and that is the act which it is claimed he should have refused to perform, on the ground that the statute is unconstitutional. Such judicial proceedings as there are, issue and culminate in a purely ministerial act—the mere registration of a mark which, if the statute is void, cannot possibly prejudice the right of the opponent or of any one else. *It is not as if the culminating act interfered with the person or property of others.* We sit to review the action of the officer from the same standpoint which he was bound to take. Although the case is now before a court, the case itself is not changed, nor are the rules changed by which it should be decided. It is for this court to say merely whether his decision was right or wrong. We think he did not err in treating the act as valid. *When some case shall arise in which rights of persons or property must be affected by the decision, it will become necessary to consider the question now attempted to be raised,* but to pass upon it now would be to decide a question of theory alone, and this is not the province of a court." 25 App. D. C., 586, 592.

In the instant case the result of cancellation—that is, the culminating act on the part of the Commissioner, acting by direction of the Court of Appeals—would unquestionably be to interfere "with the person or property of others" and it

is now for this court to consider the propriety and validity of the act of this officer from the same standpoint that under the earlier advisory opinion of the Court of Appeals, he will be bound to take if not restrained by higher authority.

Whether the decree of the Court of Appeals now complained of should be reexamined on appeal or on certiorari is of little consequence, save only in connection with questions of right procedure which may inhere in the terms of section 251 of the Judicial Code.

That the decree complained of should be reexamined and the divergent views of learned courts which have heretofore passed upon the questions involved may be so expounded as to insure reasonable uniformity of decision in the future, would seem to be as clear as is the general importance of the questions involved and the public interest in their just and appropriate settlement.

JOHN E. CROSS,
JOHN SPALDING FLANNERY,
FREDERIC D. McKENNEY,
Attorneys for The Baldwin Company, Petitioner.

LAWRENCE MAXWELL,
Of Counsel.

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CLERK

IN THE

Supreme Court of the United States

OCTOBER TERM, 1922.

No. 918. 251

THE UNITED STATES OF AMERICA, *ex relatione*, THE BALDWIN COMPANY,

Petitioner,

vs.

THOMAS E. ROBERTSON, as Commissioner of Patents, and R. S. HOWARD COMPANY, intervenor.

BRIEF ON BEHALF OF R. S. HOWARD COMPANY OPPOSING PETITION FOR CERTIORARI.

SAMUEL S. WATSON,
Attorney for R. S. Howard Company,
2 Rector Street,
New York City, N. Y.

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IN THE

SUPREME COURT OF THE UNITED STATES.

OCTOBER TERM, 1922.

No. 918

THE UNITED STATES OF AMERICA, *ex relatione*, THE BALDWIN COMPANY,

Petitioner, Appellant,

vs.

THOMAS E. ROBERTSON, as Commissioner of Patents, and R. S. HOWARD COMPANY, intervenor.

BRIEF ON BEHALF OF R. S. HOWARD COMPANY.

Statement of the Case.

This action was brought to enjoin the Commissioner of Patents from cancelling two Trade-

Mark Registrations, viz: Trade-Mark Registration No. 31,411 registered March 8, 1898, by the Valley Gem Piano Company, and Trade-Mark Registration No. 46,993 registered October 17, 1905 by The Baldwin Company. Both of said marks were for pianos and both registrations were claimed to be owned by The Baldwin Company.

Registration No. 31,411 is for the registration of the mark reproduced on page 53-r of the Record; the essential features of this mark are the common surname "Howard" and the initials "VGPCo." arranged in a monogram.

Registration No. 46,993 is for the mark reproduced on page 53-p of the Record, and consists solely of the common surname "Howard".

The "10-year" clause of Sec. 5 of the Trade-Mark Act of 1905 is not involved at bar, because The Baldwin Company does not claim use of the mark for the requisite "10-year" period.

In August, 1914, the R. S. Howard Company brought proceedings against The Baldwin Company to have cancelled the said two Trade-Mark Registrations and the Court of Appeals of the District of Columbia in *R. S. Howard Company* vs. *The Baldwin Company* (48 App. D. C., 437; Rec. pp. 61-65 adjudged that both said marks were incapable of registration, that said R. S. Howard Company was damaged by said registrations and that both said registrations should be cancelled; appeals to this Court were dismissed and petitions for writs of certiorari were denied (256 U. S. 35; 41 Supp. Ct. Rep., 405).

Before the decision of the Court of Appeals of the District of Columbia in said cancellation

proceedings had been certified to the Commissioner of Patents, as provided by Sec. 4914 Rev. Stat., The Baldwin Company filed its bill of complaint, at bar, against the Commissioner of Patents, in the Supreme Court of the District of Columbia, alleging that it would be damaged by the cancellation of said trade-mark registrations and that the said R. S. Howard Company had not been, and could not be, damaged by said trade-mark registrations, and prayed that the Commissioner of Patents be enjoined from cancelling said trade-mark registrations, *pendente lite* and perpetually.

The claim for such injunction was based wholly upon the allegations that the R. S. Howard Company is not, and could not be, damaged or injured by said Trade-Mark Registrations, and that The Baldwin Company is entitled to have this claim "judicially determined" under Sec. 4915 U. S. Rev. Stat.

The grounds alleged for such an injunction are identical with those alleged, and adjudicated adversely to The Baldwin Company, in said Cancellation proceedings of *R. S. Howard Company* vs. *The Baldwin Company* (48 App. D. C. 437; Rec. pp. 61-65; 256 U. S. 35), and the relief prayed for at bar is the same relief which was *expressly denied* to The Baldwin Company in the Equity suit in the Second Circuit of *The Baldwin Company* v. *R. S. Howard Company* (See pp. 26-29, *infra*).

Motion to Dismiss.

The R. S. Howard Company intervened in the action at bar, filed its answer, and moved to dismiss the bill of complaint on the following grounds (Rec. p. 65):

(a) That the bill was bad in substance and insufficient in law;

(b) That the Supreme Court of the District of Columbia was without power or authority to grant the relief prayed for, or any relief in the premises;

(c) That all issues involved in the action were *res adjudicata* as appeared from the allegations and admissions contained in the bill of complaint and the matters of record filed as a part of the answer of the R. S. Howard Company.

All the separate grounds, above stated, were urged and argued at length, below, and unmistakably show a want of equity

Respondent urges that if the ground of the decision below is not well taken, the record discloses other good and sufficient grounds. *Cole* v. *Ralph*, 252 U. S. 286, 290.

I.

The complaint is bad in substance and insufficient in law.

The complaint fails to state a good cause of action.

The only "right" claimed at bar, and the only matter in dispute, is the right to have the common surname "Howard" registered as a trade-mark.

That a common surname cannot be exclusively appropriated, or registered, as a trade-mark has been positively foreclosed by the repeated decisions of this Court.

Howe Scale Co. v. *Wyckoff, Seamans & Benedict*, 198 U. S., 118;
Merriam Co. v. *Syndicate Pub. Co.*, 237 U. S., 618; and cases cited therein.

Any contention based upon such a claim is manifestly frivolous.

Newburyport Water Co. v. *Newburyport*, 193 U. S., 561;
Merriam Co. v. *Syndicate Pub. Co.*, 237 U. S., 618;
Equitable Life Assur. Soc. v. *Brown*, 187 U. S., 308.

The "10-year" clause is not involved.

The claim that "Howard" is displayed in a "particular" or "distinctive" manner is also frivolous; see pp. 13-15, *infra*.

Baldwin Company not the first to use "Howard".

The Baldwin Company was not the first to use "Howard" as a mark for pianos. The Record shows, without contradiction, that Robert S. Howard, the organizer and predecessor in business of the R. S. Howard Company was continuously selling

pianos made by the New England Piano Company of Boston, Mass., from 1889 to 1896 which were marked "Howard, New York", "R. S. Howard & Co., Boston"; also "Howard & Co., Boston", beginning in 1893 (Howard's testimony, Rec. p. 24; Scanlan's testimony, Rec. p. 25).

Judge Hough finds that *prior to* 1896

> "there were thousands sold under the title 'R. S. Howard & Co.', 'Howard, New York', 'Howard & Co., Boston', and 'R. S. Howard & Co., Boston' ", and that "no other salesman except Howard sold pianos with the 'Howard' mark upon them. * * * There is no doubt that from the time any variance of 'Howard' was inscribed upon pianos, the retail trade, the user and the public generally, spoke of them as 'Howard' pianos" (Rec. p. 47).

The New England Piano Company never claimed to own the mark or brand "Howard" for pianos, but, on the contrary, recognized that it belonged to Robert S. Howard (Rec. pp. 25, 26).

The Record in the Cancellation proceedings contains the testimony of twenty four witnesses who sold, handled or knew about pianos marked "Howard" (either "Howard", "R .S. Howard & Co.", or "Howard & Co.") sold by Robert S. Howard *prior* to 1896 (Rec. pp. 23-26, 36-41).

The Baldwin Company must Establish an Affirmative Right.

To entitle the Baldwin Company to relief (to any relief) it must show, in itself, the existence of a right, something to which he is lawfully entitled and which he may lawfully claim.

Whether or not the R. S. Howard Company is damaged by said registrations is wholly immaterial.

As the Baldwin Company seeks affirmative relief, it must establish an affirmative right. This Court has said:

> "It necessarily follows that no adjudication (under Sec. 4915 R. S.) can be made in favor of the applicant unless the alleged invention for which a patent is sought is a patentable invention", and it must be shown that "the applicant is entitled, according to law, to receive a patent". *Gandy* v. *Marble*, 122 U. S., 432.
>
> *Butterworth* v. *Hoe*, 112 U. S., 50;
> *Hill* v. *Wooster*, 132 U. S., 693.

The same must hold good as to a trade-mark, if Sec. 4915 R. S. applies to trade-marks.

In *Hill* v. *Wooster, supra*, patent was refused under Sec. 4915 R. S. because the alleged invention was not a patentable invention, although the pleadings presented only the question of *priority of invention* and all the tribunals below decided the case solely on the issue of priority.

In *Curtiss Aeroplane Corp.* v. *Janin*, 278 Fed. (C. C. A.) 454, an action under Sec. 4915 R. S., the Court said:

> "As was pointed out in *Hill* v. *Wooster*, 132 U. S., 693, 10 Sup. Ct., 228, L. Ed., 502, it is the duty of the Court, in proceedings under Rev. Stat. Sec. 4915, not only to decide priority as between rival claims to invention, but to ascertain whether the parties or either of them has made a patentable invention".

In a suit under Sec. 491 R. S., which is, in substance, an interference suit to determine priority of invention, it has been repeatedly held that the Courts will not engage in a useless investigation of priority, if there is no patentable invention involved, but will dismiss the complaint. *International Signal Co.* v. *Vreeland Apparatus Co.*, 278 Fed. (C. C. A.) 468, 470, and numerous cases therein cited.

Hence, it is respectfully submitted that if Sec. 4915 R. S. applies to trade-marks (which is one of the questions here in dispute), then no adjudication can be made in favor of a plaintiff unless the alleged marks which it seeks to register, or to continue upon the Register, are registrable marks; that is, plaintiff at bar must show that it is entitled, *"according to law"*, to have its said marks on the Register of Trade-Marks.

No Property right in a Trade-Mark Registration.

Property rights in a mark are not created by registration or by the Trade-Mark Acts, but must already be in existence under the common-law before entitled to the benefits of the Registration Acts. Registration confers no title, and there is no vested right, or vested right of property, in trade-mark registrations, and registration creates no new right or title.

Trade-Mark Cases, 100 U. S., 52, 92, 93;
Hanover Star Milling Co. v. *Metcalf*, 240 U. S., 403;
United Drug Co. v. *Theo. Rectanus Co.*, 248 U. S., 90.

Fifth Amendment of the Constitution does not apply.

A registrant cannot be deprived, in a legal sense of the benefits of registrations or damaged by the cancellation of registrations if he were never entitled to register the marks, as is self-evident. A "right" which never existed cannot be violated.

"Rights" unlawfully obtained cannot *confer* "rights" which can be protected by the Fifth Amendment (or any other Article) of the Constitution.

The claim that the Fifth Amendment applies is manifestly frivolous; it is without color of merit.

Amer. R. Co. v. *Castro*, 204 U. S., 453;
Kent vs. *Porto Rico*, 207 U. S., 113, 117;
Defiance Water Co. v. *Defiance*, 191 U. S. 184, 190, 191.

Trade-Mark Registration Provisions are all Statutory and Arbitrary.

All provisions relating to the registration of trade-marks are wholly statutory and may be modified or entirely withdrawn at any time at the will of Congress; there are no general principles or substantive law applicable and all statutory provisions relating to the registration of trade-marks are wholly arbitrary. For example, the so-called "10-year" clause of Section 5 of the present Trade-Mark Act which admits to registry marks which were not common-law or tech-

nical trade-marks which had been in "actual and exclusive use" for 10 years next preceding the passage of the Act which benefits only those who have used such marks for a continuous 10-year period *prior* to February 20, 1895; another arbitrary exercise was the amendment preventing the future registration of the symbol of the American National Red Cross, making no provision for cancelling those already registered, but allowing any person already using the symbol to continue its use; another exercise of this arbitrary power, without any regard to any rules of technical trade-mark law, was the amendment of January 8, 1913, which prevented the registration of any "name, distinguishing mark, character, emblem, colors, flag or banner adopted by any institution, organization, club, or society which was incorporated prior to the date of adoption and use by the applicant", etc. The Trade-Mark Act expressly prohibits the registration of the name of an "individual, firm, corporation or association" except when "written, printed, impressed or woven in some particular or distinctive manner or in association with the portrait of the individual", or has been "in actual and exclusive use as a trade-mark" for 10 years prior to February 20, 1905.

Registration at best is but a *privilege*. It is within the power of Congress to withhold it altogether or grant it to such an extent, with such duration, and to such classes of marks or persons, and with such benefits and advantages, and subject to such conditions and limitations as it may please. That is, the right to register is wholly statutory and the powers of the Courts and the

executive departments of the Government are positively bound by the confines of the statutes, and the cancellation paragraph (Sec. 13) of the Trade-Mark Act should be left in the status where Congress placed it, that is, wholly within the exclusive jurisdiction of the Patent Office and the Court of Appeals of the District of Columbia. It is well settled law that no right of review exists unless expressly conferred by statute. (*In re Hien*, 166 U. S., 432). As this Court said in *Baldwin Company* vs. *Howard Company* (256 U. S., 35), wherein the various statutory sections relating to registration of trade-marks were refered to:

> "No provision is made which permits this statutory proceeding to be carried beyond the decision of the Court of Appeals of the District of Columbia."

The limitations of the registration Acts have been enforced by the Courts in a strict manner as is illustrated by a host of cases of which the following are a few:

Stark Bros. v. *Stark*, 41 Sup. Ct. Rep., 221. Held: No damages can be recovered in an action for infringement of registered trade-mark except on proof that defendant was notified of the registration by actual notice or constructive statutory notice by marking the goods as required by the statute, and notice to "discontinue the unfair competition and infringement of our rights" not sufficient as a basis to recover damages under the Trade-Mark Statute.

Elgin Nat'l. Watch Co. v. *Illinois Watchcase Co.* 179 U. S., 665. Held: Where a word or name had been granted registration improperly, the

registration conferred no rights or benefits under the Trade-Mark Statutes. "He can register only what he has used".

Ryder v. *Holt,* 128 U. S., 525. Held: Where bill did not allege that the mark was used by defendant on goods intended to be transported to a foreign country, the Federal Court had no jurisdiction, and where proof of that fact was not presented the bill was dismissed. *Warner* v. *Searle & Hereth Co.,* 191 U. S., 195, to the same effect.

Corbin v. *Gould,* 133 U. S., 308. Held: That use and registration of the words "The Tycoon Tea" enclosed in a diamond shaped figure, "the essential features of which are the symbol of a diamond and the arbitrary selected word 'Tycoon' ", conferred no exclusive right to the word "Tycoon" *simpliciter.*

Ammon & Person v. *Narrangansett Dairy Co.,* 252 Fed., 276, 262 Fed. (C. C. A.) 880. Held: That use of "Queen of the West" did not show the prerequisite statutory use to authorize the registration of "Queen", and the defendant held not guilty of infringement of the registered trade-mark "Queen", although the defendant used "Queen" on goods of the same description; the defendant was held guilty of unfair trade competition.

Diederich v. *Schneider Co.,* 195 Fed. (C. C. A.) 31. Held: That one acquires no right in a registered trade-mark unless the mark is used on a vendable commodity, and a registered mark cannot be infringed, that is, plaintiff can have no relief under the trade-mark statutes, unless the mark is placed by the defendant on a vendable commodity sold or intended to be sold in commerce

among the States, foreign nations or Indian tribes; *Warner* v. *Searle & Hereth Co.*, 191 U. S., 195, to same effect.

Bronson v. *Duell*, 17 App. D. C., 471. Held: "The lawful right to convert a mark or symbol into a trade-mark was intended to remain a prerequisite to registration", and that the mark must be such a mark as could be lawfully exclusively appropriated.

> "These are questions not of natural but purely statutory right * * *. No Court can disregard any statutory provisions in respect of these matters on the ground that in its judgment they are unwise or prejudicial to the interests of the public". *United States* v. *Amer. Bell Tel. Co.*, 167 U. S., 224, 246 (respecting patent statutes).
>
> "The general powers of Federal Courts when sitting as Courts of equity * * * can be exerted only in cases otherwise within the jurisdiction of those Courts as defined by Congress". *Briggs* v. *United Shoe Mach. Co.*, 239 U. S., 48, 50, (Van Devanter, J.) in holding that the equity powers of the Courts in actions under Sec. 4915, 4920 R. S. were limited to those defined by Congress in those Sections.

"Howard" not in a "Particular" or "Distinctive" Manner.

"Howard" in said registrations is not written or impressed in a particular or distinctive manner as required by the Trade-Mark Statute. This

needs no argument. The drawings of the Trade-Mark Registrations to be cancelled (Rec. pp. 53-r, 53-p) speak for themselves.

> "Peculiarities in printing cannot lend trade-mark properties to an otherwise unregistrable descriptive word (or personal name.) If it were otherwise, an unregistrable non-technical word could be appropriated and registered as a trade-mark as many times as the form of its printing could be varied." *Johns-Manville Co.* v. *Am. Steam Packing Co.*, 33 App. D. C. 234.
>
> *Oliver Plow Works* v. *Oliver Mfg. Co.*, 40 App. D. C., 125.

A mark is not registrable unless its controlling or dominant features are registrable.

> *Chapman* v. *Wintroath*, 40 Sup. Ct. Rep., 234;
> *In re Crescent Typewriter Supply Co.*, 30 App. D. C., 324;
> *Johnson* v. *Brandeau*, 30 App. D. C., 348;
> *In re Hopkins*, 29 App. D. C., 118.

To permit the registration of "Howard" to stand opens the door to imposition, fraud and oppression, and to do precisely what has been done by The Baldwin Company, viz: disclaim "Howard" here as a mark except when written in "Old English" but everywhere else, under all other circumstances, to claim "Howard" in every form—that is, the *exclusive* right to use "Howard", and IN ANY FORM and EVERY FORM of lettering.

An attempt to prevent the cancellation of said registrations is equivalent to a threat to enforce the penalties provided by the registration statutes, and a refusal to cancel is equivalent to ruling that the Baldwin Company has the *exclusive* right to the personal name "Howard". *McIlhenny Sons* v. *Trappey*, 278 Fed. 582.

Attention is respectfully requested to the certificate of registration (Rec. p. 53-s) No. 31,411, wherein it is stated that "the panel and form of lettering of 'Howard' may be differently arranged without wholly altering the character of the trademark, the principal feature of which is the word 'Howard' in connection with the initials 'VGPCo.' arranged monogrammatically."

In the application to register, which resulted in Registration No. 46,993, substantially the same wording is found. (Rec. p. 53-a). The first drawing (Rec. p. 53-o) originally filed with this application was substantially a duplicate of the drawing shown in Registration No. 31,411, and the statement contained the following:

> "the form of lettering of 'Howard' may be differently arranged without materially altering the character of the trade-mark, the principal feature of which is the word 'Howard' ".

Comparison is also respectfully requested between the lettering of the name "Howard" appearing in the registrations with the piano markings reproduced in the Record, pages 42-c, 42-d, 42-f. which reproductions the officers of the Baldwin Company testified are the only markings for "Howard" pianos used by that Company since 1912 (Sargent's testimony, Rec. pp. 31, 32;

McGee's testimony, Rec. p. 36). It will be noted that the lettering of the name "Howard" is different in each of the markings and also that each marking is different from the lettering of the mark used prior to 1912, which last mentioned mark is reproduced in Rec. page 42-e.

Action at Bar Was Not Brought in Time.

If it should be held that Section 4915 R. S. is applicable to trade-marks, it is respectfully submitted that the case at bar was not brought in time.

This Court, in *Gandy* v. *Marble,* 132 U. S., 432, held that an action under Section 4915 R. S. must be begun "within one year after any action therein"; that is, after refusal of a patent by the Commissioner or of the Court of Appeals of the District of Columbia, and that such was the requirement of Section 4894 R. S.

Gandy v. *Marble,* 122 U. S., 432; 7 Sup. Ct., 1290;
In re Hien, 166 U. S., 432, 438;
Westinghouse Co. v. *Ohio Brass Co.,* 186 Fed. 518;
Colman v. *Amer. Co.,* 235 Fed., 531. (Certiorari denied);
McKnight v. *Metal etc. Co.,* 128 Fed., 51.

In re Hien, 166 U. S., 432, 438, this Court said of *Gandy* v. *Marble, supra*:

> "It was held that the bill in equity (under Section 4915 R. S.) was *sub modo* a branch of the application for the patent and

was governed by the rule as to laches and delay declared by Section 4894".

Section 4894 states in part:

"upon failure of the applicant to prosecute the same within one year after any action therein, of which notice shall have been given to the applicant, they shall be regarded as abandoned by the parties thereto, unless it can be shown to the satisfaction of the Commissioner of Patents that such delay was unavoidable.

In *Westinghouse Elec. Co.* v. *Ohio Brass Co.*, 186 Fed., 518, where a bill of complaint brought under Section 4915 R. S. was dismissed, the Court said:

"The failure of complainants to institute the present proceedings within one year after the last official action on their application for Letters Patent, viz, the adverse decision of the Court of Appeals of the District of Columbia, is a bar to such proceedings."

Sutton v. *Wentworth*, 247 Fed. (C. C. A.) 493, 502.

In the cases cited, it was held that the time began to run "on the day it (the decision of the Court of Appeals of the District of Columbia) was rendered by that Court".

The decision and order of the Court of Appeals of the District of Columbia which was the "last action" in said cancellation proceedings

was made March 3, 1919 (Rec. p. 65), and the bill of complaint at bar was filed May 7, 1921 (Rec. p. 11).

Under the decisions above cited, to take advantage of Section 4915 R. S. (assuming that it applies to trade-marks) the bill of complaint at bar should have been filed within one year from the date of the decision of the Court of Appeals of the District of Columbia in said cancellation proceedings.

The appeals of The Baldwin Company to the Supreme Court of the United States which were dismissed for want of jurisdiction and its applications for writs of certiorari which were denied (256 U. S. 35) cannot be held to have extended the time within which to file the bill of complaint at bar.

In *Westinghouse Elec. Co.* v. *Ohio Brass Co.*, 186 Fed., 518, where proceedings under Section 4915 R. S., were first brought in the wrong district, and afterwards brought in the right district but not until more than a year had elapsed after the decision of the Court of Appeals of the District of Columbia, the Court, in dismissing the proceedings, said:

> "Nor did the institution of proceedings within the year in the United States Circuit Court for the Western Division of the Northern District of Ohio satisfy the requirements of Section 4894. That requirement is to prosecute the application, and that presupposes that action be taken in the right tribunal and against the right party".
>
> "These proceedings, if they had been in time, amounted to the taking of an appeal,

but as they were not initiated and prosecuted within the time limited they were ineffectual". *In re Hien,* 166 U. S., 432, 437, adjudging an appeal to the Court of Appeals of the District of Columbia from a decision of the Commissioner of Patents not taken in 40 days was too late.

In cases involving time-limits under which writs of certiorari are returnable, or appeals taken, it has been repeatedly held that it is imperative that such actions be taken within the time limited.

"The statute imperatively requires that the right remedy should be invoked within the time limited". *Darnell* v. *Ill. Cent. R. Co.,* 206 Fed. (C. C. A.) 445, in which many cases are cited and the question discussed at length.

II.

The Supreme Court of the District of Columbia was without power or authority to grant the relief prayed for, or any relief in the premises.

The Court is respectfully referred to the Opinion of the Court of Appeals of the District of Columbia in the case at bar dismissing the bill of complaint, where this question is carefully discussed. (See opinion in record p. 79).

It is unmistakably plain that Sec. 4915 R. S., by its wording and by its history, pertains solely to

patents, and that it does not include trade-marks.

The power and authority to cancel a trade-mark registration is granted by the Trade-Mark Statutes EXCLUSIVELY to the Commissioner of Patents subject only to review by the Court of Appeals of the District of Columbia, except in the case of interfering registrations where remedy is provided under Sec. 22 of the Trade-Mark Act of 1905.

Even though it be assumed that Sec. 4915 R. S. authorizes a bill in equity to *secure* a trade-mark registration, it does not follow that it authorizes the cancellation of a trade-mark registration. Section 4915 R. S. does not authorize the cancellation of a patent; a patent can only be cancelled by the United States under the authority of Sec. 4920 R. S. (*United States* v. *Bell Telephone Co.*, 128 U. S., 315, 368, 369; *United States* v. *Am. Bell Telephone Co.*, 159 U. S., 548, 555).

The question is wholly one of statutory power and statutory construction. Congress has dictated what rule and what Court shall control, and even should plaintiff's contentions appear meritorious "they cannot prevail against the provisions of the statutes. (*U. S.* v. *Amer. Bell Tel. Co., supra*)", "for the whole subject is one of statutory origin and regulation", (*Chapman* v. *Wintroath*, 40 Sup. Ct. Rep., 234), and subject to all the restrictions congress has provided.

In *Butterworth* v. *Hoe*, 112 U. S., 50, and in *United States* v. *Duell*, 172 U. S., 576, this Court described and summarized all the instrumentalities provided by Congress since the foundation of the Government for the granting of patents and

traces the development of appeals, viz: in 1793 appeals might be taken to three arbitrators; in 1836 appeals might be taken to a Board of examiners composed of three disinterested persons whose decision was to be certified to the Commissioner of Patents, who "shall be governed thereby in further proceedings to be had on such application", also remedy by bill in equity between interfering patents or whenever an application had been refused by the Board of Examiners (much the same as Sections 4918 and 4915 R. S.); in 1839, as modified in 1852, where an appeal was allowable by law to the Board of Examiners, the applicant instead thereof had the right to appeal to the Chief Judge or to either of the assistant Judges of the Circuit Court of the District of Columbia and the remedy by bill in equity was extended to all cases where patents were refused for any reason whatever; in 1861 the board of examiners, substantially as now constituted, was created with appeal to the Judges, as before; in 1870 an appeal to the Supreme Court of the District of Columbia sitting in banc was substituted for the appeal to the Judges, "whose decision was to govern further proceedings in the case"; in 1893 appeals were transferred from the Supreme Court of the District of Columbia sitting in banc to the Court of Appeals of the District of Columbia, which is the present status.

It is difficult to imagine in what words Sec. 4915 R. S. could be more explicitly stated; not the slightest indication exists that the section includes, or applies to, trade-mark registrations.

Previous Registration Applications under Sec. 4915.

In none of the cases mentioned in the petition, where attempts have been made to *secure* trade-mark registrations by bill in equity under Sec. 4915 R. S., has these efforts been successful.

In *Old Lexington Club Dist. Co.* v. *Kentucky Dist.* (1916) "Old Lexington Club" for whiskey, 234 Fed., 464; aff. 247 Fed., 1005; registration denied, jurisdictional question not raised.

In *Hercules Powder Co.* v. *Newton, Commissioner of Patents,* (1918), "Infallible" for powder. 254 Fed., 906; aff. 266 Fed., 169; registration refused; defendant "consents to the jurisdiction of the Court above named to hear and determine said action as a Court of original jurisdiction".

In *American Steel Foundries* vs. *Robertson, Commissioner,* No. 291, October Term, 1922 of this Court; "Simplex" for railway car devices; jurisdictional question raised and complaint dismissed.

In *Loughran* v. *Quaker City Chocolate Co.,* 286 Fed. 694, 698, the Court expressly held that it was without jurisdiction to cancel a trade-mark registration.

As has frequently been stated by the Courts, patents and trade-marks have little in common. Patent grants and trade-mark registrations are under different constitutional provisions, all Acts of Congress relating to patent grants and trade-mark registrations are separate, and distinctly different, and the propery rights secured by patent grants and the benefits and advantages obtained by trade-mark registrations are vastly

different. As this Court said in *Trade-Mark Cases*, 100 U. S., 82, 93, 94:

> "Any attempt, however, to identify the essential characteristics of a trade-mark with inventions and discoveries in arts and science or with the writings of authors, would show that the effort is surrounded with insurmountable difficulties.
>
> "The ordinary trade-mark has no necessary relation to invention or discovery, * * *. It is often the result of accident rather than design, and when under the Act of Congress it is sought to establish it by registration, neither originality, invention, discovery, science nor art is in any way essential to the right conferred by that Act. * * * trade-marks have sometimes been likened to letters patent and sometimes to copyrights from both of which they differ in many respects. And I think * * * 'much confusion has arisen from similitudinary reasonings on the subject' ".

A trade-mark may be and usually is wholly destitute of originality, whereas originality is a primary essential of a patent.

It is respectfully submitted that to hold that Sec. 4915 R. S. applies to trade-marks would be "judicial legislation", so often condemned by this and other Courts (*Trade-Mark Cases*, 100 U. S. 82, 95).

It is "familiar doctrine that 'when a statute creates a new offense and denounces the penalty, or gives a new right and declares the remedy, the punishment or the remedy can be only that

which the statute prescribes' ". *Wilder Mfg. Co.* v. *Corn Products Co.*, 236 U. S., 165, 174, 175, and cases therein cited.

"When a statute creates a new right or offense and provides a special remedy or punishment, they alone apply, such provisions are exclusive". *Barnett* v. *National Bank*, 98 U. S., 555, 558.

United States v. *Babcock*, 250 U. S., 328.

Jurisdiction.

"Jurisdiction may be defined to be the right to adjudicate concerning the subject-matter in the given case. To constitute this there are three essentials: First, the Court must have cognizance of the class of cases to which the one to be adjudged belongs; second, the proper parties must be present; third, the point decided must be, in substance and effect, within the issue." *Reynolds* v. *Stockton*, 140 U. S., 254.

"It is a familiar principle that, though a tribunal may have no power to grant the relief asked, it has jurisdiction to hear and determine the question of power".

As the right of cancellation, as well as of registration is strictly a statutory right and strictly limited and controlled by the statutory remedy provided by Section 13 of the Trade-Mark Act of 1905, and as it plainly appears that the Supreme Court of the District of Columbia has no "cognizance of the class of cases" to which the case

at bar belongs, the Supreme Court of the District of Columbia was without authority or power to grant the injunction appealed from or any relief in the premises.

> "The Circuit Court being without jurisdiction to entertain the bill in equity for an injunction, all its proceedings in the exercise of the jurisdiction which it assumed are null and void. The restraining order, in the nature of an injunction, it had no power to make * * *.
>
> "Where a Court has jurisdiction, it has a right to decide every question which occurs in the case; and whether its decision be correct or otherwise, its judgment until reversed, is regarded as binding in every other Court. But if it acts without authority, its judgments and orders are regarded as nullities. They are not voidable, but simply void". *In re Sawyer*, 124 U. S., 200, 220.

Windsor v. *McVeigh*, 93 U. S., 274;
Elliott v. *Peisal*, 1 Pet. 328, 340;
Langford v. *Monteith*, 102 U. S., 145;
Ex parte Lange, 18 Wall., 163, 176;
United States v. *Walker*, 109 U. S., 259;
Thompson v. *Whitman*, 18 Wall., 457, 461

Where it appears that there is no ground for relief, the Appellate Court may finally dispose of the merits upon an appeal from an interlocutory order and dismiss the bill.

Eagle Glass Mfg. Co. v. *Rowe*, 245 U. S., 275, 280;

Smith v. *Vulcan Iron Works*, 165 U. S., 518;
Metropolitan Co. v. *Kaw Valley District*, 223 U. S., 523;
U. S. Fidelity Co. v. *Bray*, 225 U. S., 214.

On appeal from an interlocutory order the Court "may direct the bill to be dismissed if it appeared that the complainant was not entitled to maintain its suit" (*Met. Co.* v. *Kaw Valley District, supra*), "review the whole of the interlocutory decree, not merely the part granting the injunction, and determine whether there was any insuperable objection, in point of jurisdiction or merits to the maintenance of the suit, and, if there was, to direct a final decree dismissing the bill". *U. S. Fidelity Co.* v. *Bray, supra.*

III.

All issues involved in this action are res adjudicata because of their adjudication in the Federal Courts of the Second Circuit.

After most of the testimony had been taken in said cancellation proceedings, said The Baldwin Company brought an action *in equity* against said R. S. Howard Company in the United States District Court, Southern District of New York. Certified copies of the pleadings and decree are a part of the records of this Court, and were put in evidence by The Baldwin Company. The Opinions and decree are in the record at bar (Rec.

pp. 4, 5, 44-53) and show that this action was brought:

(a) for infringement of the said two trade-mark registrations No. 31,411 and No. 46,993, and praying for three-fold damages for their infringement;

(b) to enjoin unfair trade competition based on common law rights to the name "Howard" as a common law mark for pianos;

(c) to enjoin said R. S. Howard Company from further prosecuting said cancellation proceedings respecting said two trade-mark registrations, "or any other application for the cancellation" of said trade-mark registrations.

As shown by said Opinions (Rec. pp. 44-53), the claims for infringement of said trade-mark registrations were withdrawn at final hearing and no adjudication was made thereon. The United States Circuit Court of Appeals said (Rec. p. 53):

> "At the final hearing below, plaintiff did not claim infringement of its registrations and confined its charge of infringement solely to its common law rights in the name 'Howard' ".

The Courts in many cases have ruled that decisions "confined solely to the questions of unfair competition" are "a matter of no concern * * * either by way of estoppel or otherwise" in cancellation or opposition proceedings.

See *Hercules Powder Co.* v. *Newton*, 266 Fed., (C. C. A.) 169, which case thoroughly covers this

point, the Opinion of the Court being written by the same Judge who decided the Baldwin-Howard case in the District Court in New York.

Also:

In re Hoff, 30 App. D. C., 233;
Oliver Plow Works v. *Oliver Co.*, 40 App. D. C., 125, 128.

It may be noted that in the decree in the New York case the word "mark" or "trade-mark" does *not appear*, and is nowhere used, but the decree is that The Baldwin Company has the right to use the name "'Howard' as a name for its pianos", and that the R. S. Howard Company has the right to use "Howard", with the prefix "R. S." or "Robert S." and the suffix "Company" or "Co.", on its pianos, and as its business and corporate name (Rec. pp. 4, 5).

The Federal Courts in New York *refused* the injunctive relief there sought which is the *identical* relief now sought at bar.

A reference to the Opinions of the Federal Courts in New York (Rec. pp. 44-53) shows not only that an injunction "to prevent the continuance of the cancellation proceedings in the (Patent) Office" was pleaded and urged, but also that such injunction was *expressly denied*. The parties and the subject-matter were the same.

It is respectfully submitted that said adjudication by the Federal Courts in New York is *res adjudicata* of the whole contention and all issues involved in the case at bar.

In view of said decisions (as well as the adjudication of the Court of Appeals of the District of Columbia in said cancellation proceedings,

48 App. D. C., 437) respondent further expressly urges that The Baldwin Company has already entirely exhausted its remedies and that this controversy should now forthwith be terminated.

Certified copies of the pleadings, Opinions and Decrees of the Federal Courts in New York were put in evidence by The Baldwin Company and form a part of the records of this Court in said cancellation proceedings (256 U. S., 35, Nos. 113 and 139 October Term, 1919 pp. 2599-2646) and also in No. 916 October Term, 1916, petition for writ of certiorari, R. S. Howard Company, petitioner, vs. The Baldwin Company (pp. 1-53, 401-417).

Certified copies of Opinions and Decree are included in the record at bar at pages 4, 5, 44-53.

Every Court takes judicial notice of its own records; at least, in the same case.

Bienville Water Co. v. *Mobile*, 186 U. S., 212;

The Golden Gate, 286 Fed. (C. C. A.) 105, 106.

The Baldwin Company is Wholly Without Equity.

The Baldwin Company does not come into equity with clean hands, because both registrations were originally secured upon false affidavits.

This is conclusively shown by the admissions and testimony of the officers of The Baldwin Company, and admissions of the parties are competent. *Sutton* v. *Wentworth*, 247 Fed. (C. C. A.) 493.

As to Registration No. 31,411, the testimony of the officers of The Baldwin Company was that there had never been any statutory use of the mark shown in this registration prior to the application to register (Sargent's testimony, Rec. pp. 31, 32). Such statutory use is a prerequisite to a valid registration.

Elgin National Watch Co. v. *Illinois Watchcase Co.*, 179 U. S., 665;
Bronson Co. v. *Duell*, 17 App. D. C., 471.

The testimony of the officers of The Baldwin Company was that there had never been any "use" of the mark by The Valley Gem Piano Company (the registrant) *at any time*. The president of The Baldwin Company testified that The Valley Gem Piano Company (the registrant) never at any time had any factory, tools, machinery or equipment, had never at any time made pianos, sold pianos, or dealt in pianos (Armstrong's testimony, Rec. pp. 32, 33; also Sargent's testimony, Rec. pp. 31, 32).

The Baldwin Company claims its only title and rights to Registration No. 31,411, and to the mark therein shown, and to the name "Howard" as a mark for pianos, *solely* from and through The Valley Gem Piano Company, and as the assignee and successor to the business of The Valley Gem Piano Company (See The Baldwin Company's answers, Rec. pp. 21-23; affidavit of President Wulsin, Rec. p. 53-f).

Inasmuch as The Valley Gem Piano Company never did or could acquire any trade-mark rights (as it never had or did any business), it obviously follows that The Baldwin Company could not ob-

tain any rights or title from The Valley Gem Piano Company.

The testimony of the officers of The Baldwin Company was that the mark shown in Registration No. 31,411 was abandoned in 1912 with the intention never "to take it up again", and that The Baldwin Company has never used that mark since 1912 (Armstrong's testimony, Rec. pp. 32, 33; Sargent's testimony, Rec. pp. 31, 32; McGee's testimony, Rec. p. 36).

The Baldwin Company's right to Registration No. 46,993 was based solely upon Registration No. 31,411 and the use of the mark by, and its assignment from, The Valley Gem Piano Company. (See affidavit of President Wulsin, Rec. p. 53-f, forming a part of the application to register).

As The Valley Gem Piano Company had no trade-mark rights which it could transfer, The Baldwin Company's title to the mark not only must fail but the registration be held invalid because obtained by false affidavit and declaration.

The testimony of The Baldwin Company's officers was that whatever mark or marks containing the name "Howard" were used on pianos by any Baldwin concerns at any time prior to 1912 was not "Howard," but Howard in conjunction with the initials "VGPCo" arranged in a monogram. (Armstrong's testimony, Rec. pp. 32, 33; McGee's testimony, Rec. p. 36; Sargent's testimony, Rec. pp. 31, 32).

Hence it follows that there was no statutory use of "Howard" prior to the application to register the later registration, and as statutory use of a mark is a prerequisite to the right to

register, such registration was improperly granted and is invalid. "He can register only what he has used".

Elgin Nat'l Watch Co. v. *Illinois Watch Case Co.*, 179 U. S. 665;
Corbin v. *Gould*, 133 U. S. 308;
Ammon & Person v. *Narragansett Diary Co.*, 252 Fed. 276; aff. 262 Fed., 880;
Quaker City Flour Mills Co. v. *Quaker Oats Co.*, 43 App. D. C., 260;
Hay v. *Malone*, 50 App. D. C. 399;
Bronson Co. v. *Duell*, 17 App. D. C. 471.

It is respectfully submitted that the action of The Baldwin Company, at bar, is wholly without equity.

The complete testimony of George W. Armstrong, Jr., Levi D. Sargent and Frank A. McGee was included in the record before the Supreme Court of the District of Columbia, and is summarized in the record at bar. George W. Armstrong, Jr., testified that he was one of the organizers of said The Valley Gem Piano Company and also of The Baldwin Company, and had been a director and officer of both Companies since their organization and was at the time he gave testimony the president of both said Companies. Levi D. Sargent testified that he was factory manager of The Ellington Piano Company, an Ohio corporation in whose factory all "Howard" pianos were made for the first several years, and was a director (and had been suc for several years) of The Baldwin Company at the time he gave said testimony; Frank A. Mc-

Gee testified he was a director and the Auditor of The Baldwin Company at the time he gave said testimony and had been such for several years. The complete testimony of these witnesses is on file in this Court in Nos. 113 and 139, October Term, 1919.

"Damage" to R. S. Howard Company.

The complaint at bar is based upon the allegation that the R. S. Howard Company is not and cannot be damaged by said trade-mark registrations. It is respectfully submitted that the *fact* of whether or not the R. S. Howard Company is or can be damaged is wholly immaterial; the basis of the action at bar must be the affirmative right, "*according to law*", of The Baldwin Company to the registration of the personal name "Howard".

However, if it be held that the *fact* of whether or not the R. S. Howard Company is or can be damaged by said registrations is material, it is respectfully submitted that this fact appears in the Record, fully adjudicated.

Grounds of Damages to R. S. Howard Co.

The elements or grounds of injury and damage to the R. S. Howard Company may be summarized under the following heads:

1. The Record shows that The Baldwin Company has been sending threatening and intimi-

dating letters to respondent's customers claiming rights under trade-marks "duly registered by us in the United States Patent Office", and "will take all necessary steps to protect our rights against infringement". Samples of these threatening and intimidating letters are set out in the Record pp. 43, 44.

It is respectfully submitted that any use by the Baldwin Company of unlawful registrations of trade-marks which threatens damage or injury to, or unfairly obstructs or unlawfully interferes with, respondent's business is a continuing menace, injury and damage to respondent; that the direct and obvious purpose of the letters was to intimidate respondent's customers, threaten them with litigation, and cause them to cease to deal in respondent's pianos.

American Wells Works Co. v. *Layne & Bowler Co.*, 241 U. S. 257;

Racine Paper Goods Co. v. *Dittgen*, 171 Fed. (C. C. A.) 631;

Kidd v. *Horry*, 28 Fed. 773 (Mr. Justice Bradley);

Seattle Brewing Co. v. *Hansen*, 144 Fed. 1011 and cases cited.

2. The Baldwin Company's threatened suit against respondent for infringement of said unlawful registrations constitutes a continuing threat of serious and permanent damage to respondent's business and an intimidation of its customers.

"The registration is itself a standing threat". *Denny Tag Co.* v. *Dennison Mfg. Co.*, 256 O. G. 221; aff. 48 App. D. C. 213.

Elgin Nat'l Watch Co. v. *Illinois Watchcase Co.*, 179 U. S. 665;

Electro Steel Co. v. *Lindenberg Steel Co.*, 43 App. D. C. 270;
Old Lexington Club D. Co. v. *Kentucky D. & W. Co.*, 234 Fed., 464; Aff. 247 Fed. 1005;
Heaton-Peninsular Button Co. v. *Independent Button Co.*, 43 App. D. C. 264.

3. Respondent has been adjudged entitled to use "R. S. Howard Co." as its business and corporate name and so to mark its pianos (Rec. p. 5).

Pianos bearing the name "Howard" or any name of which the name "Howard" formed a part, have always been called "Howard" pianos by everybody, because "Howard" was the dominant feature of the name on the fall-board. Prefixes and suffixes are entirely disregarded by the trade and public generally. (Judge Hough's opinion, Rec. p. 47; Mr. Steinway's testimony, Rec. p. 27; Mr. Dickinson's testimony, Rec. p. 34).

> "It is the surname which catches the public, and few purchasers would notice the difference between one form and the other. In the nature of things confusion was inevitable". "Guth Chocolate Company" held to be an infringement and colorable imitation of "Guth". *Guth* vs. *Guth Chocolate Co.*, 224 Fed. (C. C. A.) 932.

"C. I. Davids Co." and "Davids Mfg. Co." were held by this Court to be infringements of the registered mark "Davids". This Court said:

> "The use of the name in this manner was a mere simulation of the complainant's mark

> which it duly registered; it constituted a 'colorable imitation' within the meaning of the Act. * * * We agree with the Circuit Court that infringement is shown". *Thad. Davids Co.* v. *Davids*, 233 U. S. 461, 469.

"William P. Stark Nurseries" held to infringe the registered trade-mark "Stark Trees". *William P. Stark* vs. *Stark Bros.*, 257 Fed. (C. C. A.) 9.

"Tucker" and "J. C. Tucker" held similar and confusing. *Brown-Forman Co.* v. *Beech Hill Dist. Co.*, 30 App. D. C. 485.

"Taylor", "Old Taylor", "G. A. Taylor", "Kentucky Taylor", are all held to be similar and confusing. *In re Wright*, 33 App. D. C. 510.

"Hoff" and "Leopold Hoff" held so similar as to create confusion. *In re Hoff*, 30 App. D. C. 233.

4. Said registrations being *prima facie* evidence of *exclusive* ownership of *valid trade-mark* of the personal name "Howard", the Baldwin Company would *prima facie* be entitled to the exclusive use of "Howard" *in any form, and in every form*, whether used with or without prefixes or suffixes.

> *Thad. Davids Co.* v. *Davids*, 233 U. S. 461;
>
> *Shredded Wheat Co.* v. *Humphrey Cornell Co.*, 250 Fed. (C. C. A.) 960;
>
> *Elgin Nat'l Watch Co.* v. *Illinois Watchcase Co.*, 179 U. S. 665.

5. Respondent is damaged by the registration of the personal name "Howard", the dominant feature of its corporate name.

As the Baldwin Company has no exclusive right to the personal name "Howard", damage and injury to respondent is implied, as a matter of law, by the improper registration of the dominant and distinguishing features of respondent's corporate name. Respondent was incorporated in 1902, appellant did not make statutory use of "Howard" prior to 1912. (Sargent's testimony Rec. pp. 31, 32).

Mansfield Tire & Rubber Co. v. *Ford Motor Co.*, 44 App. D. C. 205;
Investor Pub. Co. v. *Dobinson*, 72 Fed 603, 606 and cases cited.

6. Respondent is irreparably damaged in its foreign business by the Baldwin Company's foreign registrations of "Howard" which foreign registrations the Baldwin Company admits in its complaint (Rec. p. 8, par. 11) it has registered, basing such foreign registrations in some fifteen foreign countries on certified copies of said Registration No. 46,993 (Donegan's testimony, Rec. p. 30).

The Record shows, without contradiction, that respondent since 1902 has been doing an extensive foreign business in a long list of foreign countries (Marken's testimony, Rec. p. 26; Stower's testimony, Rec. p. 26; Barber's testimony, Rec. p. 28). The undisputed testimony is that in most, if not all, Spanish speaking and South American countries infringement of a reg-

istered trade-mark is a criminal and penal offense, subjecting dealers to the penalty of fine and imprisonment and the goods bearing the infringing mark to confiscation (Stower's testimony, Rec. p. 26; Barber's testimony, Rec. p. 28); that in Spanish speaking countries the distinction between a trade-mark and a trade-name is not understood or not recognized; that this same confusion and failure to distinguish between a trade-mark and a trade-name is found in all countries; that "the timidity of dealers in the handling of goods, the trade-name or trade-mark on which is questioned, or is the subject of dispute, is very well recognized in all countries"; that in Spanish speaking and South American countries what may be considered a "similar" marking is quite indefinite and undeterminable, but that any mark bearing any dominant feature of a registered mark would probably be considered "similar" and an infringement, with little hope of securing from any Court the right to sell under a business or trade-name which in any degree bore resemblance to a registered trade-mark. (Barber's testimony, Rec. pp. 27-30).

The distinction pointed out in some American and English decisions between a trade-name and a trade-mark is not generally recognized by dealers, the public or even by the Courts; even the American and English Court decisions are full of such confusion.

> "The terms' trade-mark', 'trade-name' and 'technical trade-mark' are confused constantly, both in Court opinions and in the public press. This confusion is natural, and arises out of the manner in which the law of trade-marks has been developed in English

and American jurisprudence * * * Much confusion exists due to the loose use to which it (the term 'Trade-mark') is constantly put in legal literature". *Nims, on Unfair Competition and Trade-Marks*, p. 372-5 (2nd Ed.).

Furthermore, it is respectfully submitted, the *fact* that respondent is damaged and injured by said trade-mark registrations was fully adjudicated and established in said Cancellation proceedings, and that said adjudication should now be accepted as fully establishing such fact.

Sec. 4915 R. S. Should not be Extended by "Interpretation".

In *Morgan* v. *Daniels*, 153 U. S. 120, 124, which was an action for a patent under Sec. 4915, the Court said:

"But this is something more than a mere appeal. * * * It is something in the nature of a suit to set aside a judgment, and as such is not to be sustained by a mere preponderance of evidence. *Butler* v. *Shaw*, 21 Fed. Rep. 321, 327. It is a controversy between two individuals over a question which has once been settled by a special tribunal entrusted with full power in the premises. As such it might be well argued, were it not for the terms of this statute, that decision was a finality upon every matter of fact. *Johnson* v. *Towsley*, 13 Wall, 72, 86".

The Court of Appeals in the First Circuit, in *Greenwood* v. *Dover*, 194 Fed. (C. C. A.) 90, 94, an action for a patent under Sec. 4915 R. S., said:

> "It is to be regretted that Congress has not provided that decisions like that in the Court of Appeals (of the District of Columbia) in Greenwood v. Dover should be conclusive, in the same way in which any decisions of the Superior Courts of federal or state jurisdiction are ordinarily held effectual. * * * they have all the elements of the fundamental principles of the 'law of the land', and might well have been pronounced by Congress to end the litigation accordingly, and thus to avoid the opportunity of further holding up of patents, and of leaving the rights of both the public and the patentee indecisive for another series of years. The entire proceeding contains the great elements required by the 'law of the land', namely, opportunity for both parties to be heard, and finally a decision by a Court of high authority, endowed with all machinery of Superior Courts of Judicature. As it is, however, we are compelled to accept in this single particular the view claimed by Dover, that the judgment of the Court of Appeals stands akin to a departmental decision, although no court could avoid the impression that in a certain sense and to a certain extent it is of greater weight. It is sufficient for us, however, to apply to this case the rule of *Morgan* v. *Daniels*, that there must be a clear conviction on this record

that the conclusion of the Court of Appeals was erroneous." * * *

"The conclusion in *Morgan* v. *Daniels* was not a peculiar outgrowth of the patent system. It was simply a phase of the general rules with reference to the determinations of the executive departments, where the statutes authorize them to investigate and decide questions of fact preliminary to a grant on which private rights are to rest. We need cite in this particular only the *Maxwell Land Grant* case, 121 U. S. 325, 7 Sup. Ct. 1015, 30 L. Ed. 949 and *United States* v. *Bell Telephone Company*, 167 U. S. 224, 17 Sup. Ct. 809, 42 L. Ed. 144".

See also Judge Aldrich's concurring Opinion (same case p. 97), but to the effect that an action under Sec. 4915 R. S. should only be possible and the decision of the Court of Appeals of the District of Columbia should not be disturbed

"except upon a bill which states a case for equitable relief and a case so clear upon the evidence as to show that the results were promoted by fraud, accident or mistake", that is, upon the same basis as general property rights are safeguarded. And that "where questions of fact have been determined and established by such a court of competent jurisdiction, in an inter partes case, that the result of the decision will not be overthrown except upon such grounds as relief is granted from judgments at law and decrees in equity, under the broad sense in which equity and common law jurisdic-

tions are understood in this country and in England."

Judge Aldrich also points out that Sec. 4915 R. S. is a statute that has come down to us without substantial change from a time when there was no judicial review of decisions of the Commissioner of Patents. Its language may be traced back to the Patent Act of 1836 when there was created an appeal to a board of examiners composed of three disinterested persons whose decision was to be certified to the Commissioner of Patents who "shall be governed thereby in the further proceedings to be had on such application". (*U. S.* v. *Duell*, 172 U. S. 576). It was not until 1870 that a judicial review of the Commissioner's decisions was provided, by an appeal to the Supreme Court of the District of Columbia sitting in banc, and not until 1893 that a judicial appeal was allowed in interference cases (probably the most important class of Patent cases). It is yet authoritatively to be determined whether or not it is necessary to appeal to the Court of Appeals of the District of Columbia before bringing action under Sec. 4915 R. S.

The United States Circuit Court of Appeals in the Second Circuit in *Gold* v. *Newton*, 254 Fed. 824, 827, which was an application for a patent under Sec. 4915 after refusal by the Court of Appeals of the District of Columbia, in which it was urged that the proceeding was not an appeal but an original action, said:

> "In form this is true, but in substance we do not think it is. * * * In respect to actions like this, solely against the Commissioner,

the jurisdiction still existing under R. S. Sec. 4915 (Comp. St. Sec. 9460, is, to say the least, a singularity in law making. * * *

"Further, a Court appealed to under Sec. 4915 must by the evidence shown it, whether new or old, be very fully and amply persuaded of plaintiff's merits before granting relief. * * *

"But, in a proceeding under Sec. 4915, (for a patent) * * * the Court * * * must treat the conclusions * * * of the Court of Appeals as a finding of a tribunal having jurisdiction with matters determined in the Patent Office, and upon appeal therefrom, and insofar as these determinations are shown to have been made upon the same facts as those presented to the Court in the action under Section 4915, they should not be disturbed unless shown to be plainly and unmistakably erroneous. * * * All reasonable doubt must be removed and thorough conviction must be had".

General Elec. Co. v. *Steinberger,* 208 Fed. 699, 700.

In *Richards* v. *Meissner,* 163 Fed. 957, 960, which was an action for a patent under Sec. 4915 the Court said:

"It is a rule well-nigh or quite universal in its application and enforcement that, when questions of fact are submitted for finding to an officer or tribunal, such findings of fact, when free from fraud, accident, or mistake, are conclusive, and cannot be modified or

set aside by a court, provided always that the officer or tribunal had the statutory authority to make such findings pursuant to official duties". * * *

"But for Section 4915 of the Revised Statutes no one could doubt but that the decision of the Court of Appeals for the District of Columbia was the end of the litigation, because that Court had jurisdiction of the subject matter and of the parties thereto, who with their privies are now before this Court litigating the same questions as in that Court litigated; and the force of this is not lessened from the fact that there is no provision for an appeal from that Court to the Supreme Court, because the right to an appeal is not a common-law right, but can only exist when expressly conferred by statute, so that the decision of the District of Columbia Court is res adjudicata, except as controlled by Section 4915 of the Revised Statutes". (McPherson, J.)

To same effect in same case, 158 Fed. 109 (Philips, J.)

In view of the foregoing citations (and others which might be quoted), it would seem unnecessary, if not undesirable, to extend, *to any extent,* the application of Section 4915 R. S.; and even though Sec. 4915 R.. S. be extended to *securing* the registration of trade-marks, it would seem quite beyond the power of the Court to extend this Section to the *cancellation* of trade-mark registrations. It might be said, as stated by this Court in *Butterworth* v. *Hoe, supra,* where the

issue was whether or not the Secretary of the Interior could review a decision of the Commissioner of Patents, if Congress had intended Section 4915 R. S. to apply to trade-marks it would have included such provision in the Section.

The present Trade-Mark Act has been passed, and amendments in several particulars have been made from time to time since its passage; it is respectfully submitted that if Congress had deemed it desirable that trade-marks should be included in Section 4915 R. S. it would have so provided. Such provision would appear necessary as respects the *cancellation* of a trade-mark registration inasmuch as Section 4915 R. S. does not apply to the *cancellation* of a patent.

To include in Sec. 4915 R. S. the *cancellation* of a trade-mark registration requires the incorporation into the Section of words entirely foreign to its present plain language.

Congress Refused a Section Similar to 4915 R. S.

A provision similar to Section 4915 R. S. was recommended to Congress by the report of the Commission appointed by the President to revise the Trade-Mark Laws (Senate Document No. 20, 56th Congress), which report became the basis of the present Trade-Mark Act (See H. R. Report No. 3147, 58th Congress). Notwithstanding such recommendation, **Congress refused to include such Section in the Trade-Mark Act,** which would appear clearly to indicate that it was not the intention of Congress to apply provisions similar to Section 4915 R. S. to trade-marks.

Section 9 of the Trade-Mark Act of 1905.

Section 9 of the Trade-mark Act of 1905, by its plain language, as well as its history (see H. R. Report No. 3147, 58th Congress, third Session) applies *only* to proceedings on appeal from the Patent Office to the Court of Appeals of the District of Columbia respecting trade-marks; that is, respecting registration, interference, opposition, and cancellation of trade-marks.

In the face of its plain language, this Court is now asked to hold that an action by bill in equity under Sec. 4915 R. S. (extended by said Sec. 9 through some occult interpretation) is provided in trade-mark registration proceedings, in trade-mark interference proceedings, in trade-mark opposition proceedings, and in proceedings to cancel trade-mark registrations. It is respectfully submitted that this is preposterous and a stretching of the wording of said Section beyond all reason, constituting a judicial interpretation running contrary to every reasonable presumption of Congressional intention.

Reference is again made to the exhaustive discussion of said Sec. 9 which is contained in the Opinion of the Court below (Rec. p. 79).

The Section Rejected by Congress.

The section of the proposed Trade-Mark Act recommended by said committee, but rejected by Congress, read as follows:

> "Sec. 20. Whenever registration on application is refused, either by the Commissioner

of Patents, or by the Court of Appeals of the District of Columbia upon appeal from the Commissioner, or by the Supreme Court of the United States upon appeal from the Court of Appeals of the District of Columbia, the applicant may have remedy by bill in equity; and the court having cognizance thereof, on notice to adverse parties and other due proceedings had, may adjudge that such applicant is entitled, according to law, to registration of the mark for which he has applied. If such adjudication be in favor of the applicant, the Commissioner shall register the mark upon the applicant filing in the Patent Office a copy of the adjudication, and otherwise complying with the requirements of law. In all cases, where there is no opposing party, a copy of the bill shall be served on the Commissioner; and all the expenses of the proceeding shall be paid by the applicant, whether the final decision be in his favor or not." (Senate Document, No. 20, 56th Congress, 2nd Session, pp. 70, 71).

Prior to the Trade-Mark Act of 1905, no appeal or review (judicial or otherwise) from the decisions of the Commissioner of Patents was provided in trade-mark cases, either as to registration or interference; oppositions to registration were included in interferences; there were no provisions for cancellation of a trade-mark registration.

It is submitted, most respectfully, that to extend jurisdiction under Sec. 4915 R. S. to trademark cancellation proceedings would be judicial legislation of the broadest character, and legislation which Congress refused after the same had been recommended to it by a Committee expressly created by Congress to formulate a Trade-Mark Act.

Respectfully submitted,

R. S. HOWARD COMPANY,
by Samuel S. Watson,
Its Attorney,
2 Rector Street,
New York City, N. Y.

(5838)

APR 24 1924
WM. R. STANSBURY
CLERK

SUPREME COURT OF THE UNITED STATES.

OCTOBER TERM, 1923.

No. 261.

THE UNITED STATES OF AMERICA *EX RELATIONE* THE BALDWIN COMPANY, APPELLANT,

vs.

THOMAS E. ROBERTSON, AS COMMISSIONER OF PATENTS; E. S. HOWARD COMPANY, INTERVENING DEFENDANT.

ON APPEAL FROM THE COURT OF APPEALS OF THE DISTRICT OF COLUMBIA.

ALSO

ON APPLICATION FOR WRIT OF CERTIORARI TO SAID COURT OF APPEALS.

BRIEF FOR APPELLANT.

FREDERIC D. MCKENNEY,
JOHN STALDING FLANNERY,
For Appellant and Petitioner.

LAWRENCE MAXWELL,
Of Cincinnati, Ohio;
JOHN E. CROW,
Of Baltimore, Maryland,
Of Counsel.

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SUPREME COURT OF THE UNITED STATES.

OCTOBER TERM, 1923.

No. 251.

THE UNITED STATES OF AMERICA *EX RELATIONE* THE BALDWIN COMPANY, APPELLANT,

vs.

THOMAS E. ROBERTSON, AS COMMISSIONER OF PATENTS; R. S. HOWARD COMPANY, INTERVENING DEFENDANT.

ON APPEAL FROM THE COURT OF APPEALS OF THE DISTRICT OF COLUMBIA,

ALSO

ON APPLICATION FOR WRIT OF CERTIORARI TO SAID COURT OF APPEALS.

BRIEF FOR APPELLANT.

GENERAL STATEMENT OF CASE.

In essence the controversy here presented arises under the trade-mark law of the United States and

revolves about the differing contentions of The Baldwin Company as owner of two certain registered trade-marks used by it to mark and identify pianos of its manufacture shipped and sold in interstate and foreign commerce, and of R. S. Howard Company, who insists that said trade-marks were improperly admitted to registry and has applied to the Commissioner of Patents to cancel same.

The Commissioner of Patents, acting upon the facts and his understanding of the provisions of applicable law, declined to cancel either of the marks in controversy, but upon appeal to the Court of Appeals of the District of Columbia the decision of the Commissioner of Patents was reversed and the Clerk of that Court was directed "to certify these proceedings (to the Commissioner) as by law required."

48 D. C. Apps. 437.

On application of The Baldwin Company, an appeal to this Court was granted and subsequently it also filed here an application for certiorari. Upon consideration, this Court, being of opinion that the decision of the Court of Appeals of the District of Columbia was "in no sense a final judgment reviewable here upon writ of certiorari or appeal," denied application for the former and dismissed the latter.

Mr. Justice Day, speaking for the Court, stated the case as it then was and the conclusions of the

Court with respect thereto as follows (256 U. S. 35, 36):

> "The Commissioner of Patents refused to cancel the certificates of registration of a trade-mark consisting of the word 'Howard' registered by the Baldwin Company, October 17, 1905, and made a like ruling refusing to cancel the certificate of registration of the word 'Howard' arranged in monogram with the initials 'V. G. P. Co.' registered March 8, 1898, which marks were registered as trade-marks for pianos. The appeals were heard together in the District Court of Appeals upon the appeal of the Howard Company.
>
> "Proceedings were brought in the Patent Office by the Howard Company against the Baldwin Company to cancel the certificates of registration. It appears that a suit was begun in the District Court of the United States for the Southern District of New York by the Baldwin Company against the Howard Company while the cancellation proceedings were pending, which resulted in a decree in favor of the Baldwin Company restraining the Howard Company from making or selling pianos bearing the word 'Howard,' but permitting it to use the marks 'R. S. Howard Company' and 'Robert S. Howard Company.' 233 Fed. Rep. 439. This decree was affirmed by the Circuit Court of Appeals for the Second Circuit. 238 Fed. Rep. 154."
>
> "The Baldwin Company filed in the Patent Office a certified copy of the record in

the federal courts in New York, and in the Patent Office the Examiner of Interferences and the Commissioner of Patents, on appeal to him, held that the adjudication in the New York courts was a bar to the claim of the R. S. Howard Company to cancel the certificates of registration of the trade-mark 'Howard,' and dismissed the petition of the Howard Company; thereupon, appeal was taken from the decision of the Commissioner to the Court of Appeals of the District. That court reversed the decision of the Commissioner of Patents, and directed the clerk to certify its decision as required by law.

"The application in the Patent Office to cancel the trade-marks was under Sec. 13 of the Trade-Mark Act of February 20, 1905, c. 592, 33 Stat. 728, which provides:

" 'SEC. 13. That whenever any person shall deem himself injured by the registration of a trade-mark in the Patent Office he may at any time apply to the Commissioner of Patents to cancel the registration thereof. The Commissioner shall refer such application to the examiner in charge of interferences, who is empowered to hear and determine this question and who shall give notice thereof to the registrant. If it appear after a hearing before the examiner that the registrant was not entitled to the use of the mark at the date of his application for registration thereof, or that the mark is not used by the registrant, or has been abandoned, and the examiner shall so decide, the

Commissioner shall cancel the registration. Appeal may be taken to the Commissioner in person from the decision of examiner of interferences.'

"The appeal from the decision of the Commissioner to the Court of Appeals of the District was under Sec. 9 of the act, which provides:

" 'SEC. 9. That if an applicant for registration of a trade-mark, or a party to an interference as to a trade-mark, or a party who has filed opposition to the registration of a trade-mark, or party to an application for the cancellation of the registration of a trade-mark, is dissatisfied with the decision of the Commissioner of Patents, he may appeal to the Court of Appeals of the District of Columbia, on complying with the conditions required in case of an appeal from the decision of the Commissioner by an applicant for patent, or a party to an interference as to an invention, and the same rules of practice and procedure shall govern in every stage of such proceedings, as far as the same may be applicable.'

"A motion is made to dismiss the appeal. No specific provision is made for an appeal from the decision of the District of Columbia Court of Appeals reviewing the decision of the Commissioner of Patents, but the decision is to be certified to the Commissioner to govern further proceedings in the case. Section 4914, Rev. Stats.; 8 U. S. Comp. Stats., Sec. 9459.

"If the decision of the Court of Appeals

of the District of Columbia is not final, then the motion to dismiss the appeal should be sustained, and we have no authority to grant a writ of certiorari. Judicial Code, Secs. 250, 251.

"The nature of proceedings of the character now under consideration was considered in FRASCH *v.* MOORE, 211 U. S. 1, in which the opinion of Chief Justice Alvey, speaking for the Court of Appeals of the District of Columbia in ROUSSEAU *v.* BROWN, 21 App. D. C. 73, 80, explaining the nature of this statutory proceeding and affirming that it did not authorize a judgment but only the return by the Court of Appeals of a certificate to the Commissioner of Patents, to be there entered of record to govern further proceedings in the case, was fully approved.

"In ATKINS & Co. *v.* MOORE, 212 U. S. 285, application for registration of a trade-mark was refused by the Examiner, which action was approved by the Commissioner, and affirmed on appeal by the Court of Appeals of the District of Columbia, an appeal and writ of error were allowed, both of which were dismissed in this court. The previous decisions of this court were reviewed by Chief Justice Fuller, speaking for the court, and in concluding the opinion he said: 'In the light of the various details of the Act of February 20, 1905, and of the specific provisions of Sec. 9, we were of opinion (GAINES *v.* KNECHT, 212 U. S. 561) that proceedings under the act were governed by the same rules of practice and procedure as

in the instance of patents, and the writ of error was accordingly dismissed. The same result must follow in the present case. Under Sec. 4914 of the Revised Statutes no opinion or decision of the Court of Appeals on appeal from the Commissioner precludes 'any person interested from the right to contest the validity of such patent in any court wherein the same may be called in question,' and by Sec. 4915 a remedy by bill in equity is given where a patent is refused, and we regard these provisions as applicable in trade-mark cases under Sec. 9 of the Act of February 20, 1905.'

"We are of opinion that the principle there announced controls this case. No provision is made which permits this statutory proceeding to be carried beyond the decision of the Court of Appeals of the District of Columbia, the decision of which court is directed to be certified to the Commissioner of Patents. It is in no sense a final judgment reviewable here upon writ of certiorari or appeal. * * *

"It follows that the appeal must be dismissed, and the petition for a writ of certiorari denied."

This opinion was delivered April 11, 1921, and within thirty (30) days thereafter, that is on May 7th, 1921 (R. 11, 71), The Baldwin Company filed and served upon the defendant Robertson, Commissioner of Patents, its original verified bill of complaint in the present case and on May 17, 1917, rule to show cause why a writ of injunction should

not be issued restraining and enjoining said defendant Robertson from cancelling the trade-mark registrations in question was issued (R. 11).

Basis for instituting this action in equity is found in the provisions of section 9 of the Trade-mark Act in connection with section 4915 of the Revised Statutes U. S. as construed in BALDWIN Co. *v.* HOWARD Co., 256 U. S. 35, *supra,* and the cases therein cited. Since institution of this suit and its disposition by the Court of Appeals of the District of Columbia, this Court has announced its opinion and decree in AMERICAN STEEL FOUNDRIES *v.* ROBERTSON, COMMISSIONER OF PATENTS *et al.*, 262 U. S. 209, to which reference is made as a strongly supporting authority.

Defendant Robertson as Commissioner of Patents, by way of showing cause, answered, admitting all pertinent averments of fact set forth in The Baldwin Company's bill of complaint, but asserted that his further official action in the premises was to be controlled solely by the conclusions expressed by the Court of Appeals of the District of Columbia as certified to him by the Clerk of said Court, same being set forth and reported in 48th Apps., D. C., 437 *et seq.,* and therefore he prayed that the injunction *pendente lite* asked by plaintiff, The Baldwin Company, be denied and the bill of complaint be dismissed (R. 11-12).

May 17, 1921, before further action had been had in the trial court, R. S. Howard Company filed its petition for leave to intervene in the cause as a party defendant (R. 70). Its petition in such regard was granted May 27th, 1921, and on the same day it filed answer to plaintiff's bill of complaint, contending, among other things, that under the circumstances set forth in and by said bill of complaint the Supreme Court of the District of Columbia was without jurisdiction to grant the relief prayed therein or any thereof, and asked that said bill of complaint be dismissed.

Thus the litigation stood until October 13th, 1921, when plaintiff, The Baldwin Co., filed its amended bill of complaint, naming both the original defendant, Robertson, Commissioner of Patents, and the intervener, R. S. Howard Company, as parties defendant and somewhat amplifying the allegations of its original bill. It averred its ownership of the registered trade-marks numbered, respectively, 31,411, dated March 8th, 1898, consisting of the word—Howard—accompanied by the initials V. G. P. Co. arranged in a monogram, and 46,993 dated October 17th, 1905, consisting of the word—Howard— standing alone, the word—Howard—in both instances "being written or impressed in a particular and distinctive manner, that is, in old English letters"; the continuous use of each of said trade-marks in its business of manufac-

turing and selling pianos in interstate and foreign commerce, and the broad and valuable good will which had been built up in connection with such use; its exclusive and legal right to appropriate and use said trade-marks; the proceedings in the United States District Court for the Southern District of New York and in the Circuit Court of Appeals for the Second Circuit, to which R. S. Howard Company was a party and which had eventuated in a decree to effect

> "That the name 'Howard' without prefix or suffix, on pianos, or contained in advertisements or otherwise used in connection with pianos, indicates that the pianos bearing or referred to by said name, are the product of the plaintiff, the Baldwin Company" and that the plaintiff the Baldwin Company alone was "entitled to use the word 'Howard' without prefix or suffix in the name of any company, firm or corporation that manufactures pianos bearing said name"

and enjoining any infringement of such exclusive right of user (R. 5); the orders of the examiner of interferences affirmed by the Commissioner of Patents dismissing R. S. Howard Company's applications for cancellation of said trade-marks (R. 6); the proceedings subsequently had in the Court of Appeals of the District of Columbia, and the absence of possibility of any damage to R. S. Howard Company from the continued registration of rec-

ord of trade-marks (R. 7); that the Baldwin Company had obtained registration of said trade-mark 'Howard' in numerous foreign countries based alone on the registration of said mark in the United States Patent Office, and that cancellation of such registration in said Patent Office would cause the cancellation of such registrations in such foreign countries, so that the foreign business of plaintiff, which is largely based upon such foreign registrations of its trade-marks, "would be seriously threatened and greatly and irreparably injured by the cancellation of either or both of said trade-marks in the United States Patent Office" (R. 8); that plaintiff is possessed of a vested property interest and right in the continued maintenance of said registrations of record in the United States Patent Office, and that in the circumstances narrated the cancellation of such registrations "would constitute a deprivation of plaintiff's property without due process of law, contrary to the provisions of the Fifth Article of Amendment to the Constitution of the United States (R. 9), and prayed that the defendant Robertson be enjoined from cancelling such registrations, and that R. S. Howard Company, intervener, be decreed to be without any such right or interest in the word "Howard" standing alone, without prefix or suffix, as is requisite to enable it to carry on proceedings for cancellation of said trade-marks, and for general relief (R. 10).

On October 13, 1921, intervener, R. S. Howard Company, filed an elaborate answer to plaintiff's amended bill of complaint (R. 12-66), and on the same day filed separate motion to dismiss said bill upon the ground—among others not now important—that the Supreme Court of the District of Columbia was "without power or authority to grant the relief prayed for, or any relief in the premises (R. 66).

The Baldwin Company's application for preliminary injunction and R. S. Howard Company's motion to dismiss plaintiff's amended bill of complaint were brought on for hearing at one and the same time before Hoehling, Associate Justice. Defendant, the Commissioner of Patents, submitted to "such action as the court may deem proper" agreeing, in open court, "that, pending the determination of the application for preliminary injunction and motion to dismiss, the status of the registration of the trade-marks would be preserved unimpaired, so far as the Patent Office is concerned" (R. 71).

After hearing full argument, the learned trial Justice on February 20th, 1922, first having stated the previous history of the controversy between the parties and the disposition thereof made by this Court in Baldwin Co. *v.* Howard Co., 256 U. S., 35, continued and concluded as follows (R. 72):

> "In view of the holding of the Supreme Court of the United States, *supra*, to the effect that the decisions of the Court of Ap-

peals of this District, both in patent and trade-mark cases, are in no sense a final judgment reviewable upon certiorari or appeal, but are only the return by that court of a certificate to the Commissioner of Patents to be there entered of record to govern further proceedings in the case; in view of the further holding of said Supreme Court that Secs. 49[illegible] and 4915 R. S., U. S., are applicable in trade-mark cases; and, finally, in view of the express holding of the Supreme Court that this case is controlled by the principles so announced; the conclusion seems necessarily to follow that the Supreme Court, having before it an application to review the adverse holding of the Court of Appeals, *supra*, and finding itself without jurisdiction to entertain the same, either on appeal or by certiorari; nevertheless, in direct and express terms and language, pointed out a method and way in which such judicial review of the questions might be secured.

If that be not the true intent and meaning of the decision of that court, then the language of the opinion must be denied its ordinary, plain, and usual meaning.

If, therefore, there be open to the plaintiff, Baldwin Co., an opportunity for judicial review of the questions raised in this suit, under said Sections 4914 and 4915 R. S., U. S., and the Supreme Court apparently has so held; then pending the proceeding, the status of the subject-matter of the litigation should be preserved unimpaired; since

the remedy so given would be futile if, pending the proceeding, the trade-mark registrations be permitted to be canceled.

Accordingly, the court is of opinion that the motion of defendant, Howard Co., to dismiss should be overruled, and that the application of plaintiff, Baldwin Co., for preliminary injunction should be granted. Appropriate order in that behalf may be prepared by counsel and submitted, upon due notice.

As the case now stands on the pleadings, the rule to show cause was issued upon the original bill of complaint, answer to which original bill was made and filed by said defendant, Howard Co. The court has deemed it proper to consider that answer in connection with the application for preliminary injunction which was carried forward in the amended bill of complaint.

The motion to dismiss the cause, however, was filed in response to the amended bill of complaint, and which latter supersedes and takes the place of the original bill. Hence, the motion to dismiss must be and has been determined upon the allegations of said amended bill, and the matters of law urged in opposition thereto."

It was accordingly decreed (R. 73):

"(1) That the motion of intervener-defendant, R. S. Howard Company, to dismiss plaintiff's bill of complaint herein both as filed and as amended be, and same is hereby denied;

> (2) That pending final disposition of this cause, defendant Thomas E. Robertson, Commissioner of Patents, his assistants, agents, subordinates and successors be and they are and each of them is hereby restrained and enjoined from cancelling or erasing from the records of the United States Patent Office or in any other manner interfering with the registration in said United States Patent Office of the two several trade-marks described in said bill of complaint."

To review that decree, R. S. Howard Company and the Commissioner of Patents each prayed and perfected general appeals to the Court of Appeals of the District of Columbia, but the case was heard by the Court of Appeals as on "special appeal" (27 Stats. 436) by the R. S. Howard Company (R. 79).

It is said in the opinion of the Court of Appeals (Smyth, Ch. J., speaking for the majority):

> "The case turns upon the jurisdiction of the Supreme Court of the District to entertain the suit. Registration of trade-marks, opposition to registration, cancellation of registration, and interference proceedings are all governed by statute (33 Stat., sec. 724, *et seq.*). The solution of any question which arises with respect to these matters must be in harmony with the terms of the statute (citing cases). If there is no statutory authority for bringing the suit, then the

> action of the lower court must be reversed and the amended bill dismissed" (R. 79, *et seq.*).

After discussing at some length the relative characteristics of letters patent and trade-marks under the United States statutes and the existence or absence of "property right" in one and the other, and after reviewing the opinions of this court in ATKINS & Co. *v.* MOORE, and BALDWIN Co. *v.* HOWARD Co., *ubi supra*, the learned chief justice concludes discussion with the statement that (R., 83)

> "The court (Supreme Court U. S.) had no occasion to determine whether section 4915 gave a defeated applicant for registration the right to commence a proceeding in equity, and we do not think it intended to so decide. In this we are supported by a statement in the last opinion of the court upon the subject. BALDWIN Co. *vs.* HOWARD Co., *supra*. Mr. Justice Day, who spoke for the court in that case, after referring to the decisions in the Frasch, Atkins, and Gaines cases, wherein the various statutory sections about which we have been writing were referred to, said: 'No provision is made which permits this statutory proceeding to be carried beyond the decision of the Court of Appeals of the District of Columbia, the decision of which court is directed to be certified to the Commissioner of Patents.' The statutory proceeding referred to is the one relating to the registration of trade-marks, the decisions of the Commissioner touching the

same, and the review of his decisions by this court. This proceeding, according to the learned justice, cannot be carried beyond the decision of the Court of Appeals. In other words, the questions of registration, cancellation, opposition, and interference in trade-mark cases are ended by our decision. The only thing decided in such a proceeding is as to whether or not the mark shall be registered, or, having been registered, whether or not it shall be cancelled. The effect of the registration, as we have seen, is simply to provide a rule of evidence which under section 16, *supra*, casts upon him who would attack the right of the registrant to the mark the burden of establishing his claim in an infringement, unfair competition, or other proper proceeding. We think the court had this in mind when it said that there was no authority for carrying the statutory proceeding beyond the decision of the Court of Appeals.

Believing that there is no authority for the maintenance of this suit we reverse the decision appealed from and remand the case with instructions to dismiss the suit, costs to be assessed against appellee."

From this conclusion, as well as from the reasoning of the majority upon which it was based, Mr. Justice Robb dissented, saying in part (R. 84):

* * * "Were this an open question, the force of the argument of my Associates would lead me to their conclusion that the provision last quoted refers only to proceed-

> ings in this court, and that view would be further strengthened by the specific provisions of Section 22 of the Trademark Act, which apparently were intended to restrict and limit the right to equitable relief to parties to 'interfering registered trademarks.' However, as I read the opinion of the court in BALDWIN Co. *vs.* HOWARD Co., 256 U. S. 35, 39, it there is intimated that Section 4915 R. S. authorizes a remedy by bill in equity in a case like the present. Therefore, while it is quite possible that, when the provisions of Section 22 of the Trade-mark Act are brought to the attention of the Supreme Court and a definite ruling invoked, the conclusion reached by my associates will be approved, I now feel constrained to give full force and effect to the suggestion in the Howard case and to dissent here."

Pursuant to the conclusions of the Court of Appeals as expressed by its majority members, the decree of the Supreme Court of the District of Columbia overruling (February 5, 1923) R. S. Howard Company's motion to dismiss and granting plaintiff's application for an injunction *pendente lite* was reversed with costs, and the cause was "remanded to said Supreme Court with instructions to dismiss the suit" (R. 84).

The jurisdiction of the Supreme Court of the District of Columbia to entertain this suit in any

aspect or at all, and also the construction of Sec. 9 of the Trade-mark Act in association with Sec. 4915 R. S. U. S. (one of the patent laws), both having been put in issue by defendant's motion to dismiss plaintiff's amended bill of complaint, and said motion to dismiss having been granted because of want of jurisdiction on part of Supreme Court of the District of Columbia in the premises, The Baldwin Company prayed for and was allowed appeal (R. 85) to this Court to review said decree of the Court of Appeals (Sec. 250 Jud. Code), which was allowed (R. 87) and duly perfected (R. 87-89).

In its primary and substantial aspect The Baldwin Company's suit is an assertion of vested property rights under the Trade-mark Statute and the Due Process clause of the Fifth Amendment of the Federal Constitution. The enforcement of such rights so asserted is attempted, in part at least, by invoking supposedly applicable provisions of Section 4915 of the Revised Statutes of the United States, which section, on its face and as written, is a "Patent law" of the United States.

Jurisdiction of the Supreme Court of the District of Columbia to entertain any such suit to enforce any such rights is denied by the R. S. Howard Company and its denial has been upheld by the Court of Appeals of the District of Columbia.

Such combination of written law and circumstantial facts has seemed to us to require considera-

tion of an exception to the general right of appeal granted in Section 250 of the Judicial Code, under which the appeal to this Court was prayed and allowed. That exception reads,

> "The judgments and decrees of said Court of Appeals (of the District of Columbia) shall be final in all cases arising under the patent laws * * * and except as herein provided in the next succeeding section (that is Sec. 251) the judgments and decrees of said Court of Appeals shall be final in all cases not reviewable as hereinbefore provided."

In connection with the exception so expressed it is also to be noted that Section 18 of the Trademark Act of February 20th, 1905, as amended (33 Stats. 724, 729), similarly provides

> "That writs of certiorari may be granted by the Supreme Court of the United States for the review of cases arising under *this Act* in the same manner as provided for patent cases by the Act creating the Circuit Court of Appeals."

In view of the doubt so engendered as to whether review by this Court of the decree of the Court of Appeals of the District of Columbia in the instant cause should be sought by way of appeal or certiorari, The Baldwin Company, on April 25th, 1923, well within the time limited by the provisions of the Act of September 6th, 1916, filed in this Court

its petition for certiorari, and submitted same to the Court as required by its Rules of Practice, on May 21st, 1923, and the same is still held *sub judice,* final disposition having been postponed to this hearing of the case on its merits.

Because of the expressions used and declarations made by this honorable Court in

> Hutchinson, Pierce & Co. *v.* Loewy, 217 U. S. 457, 460, 461;
> Street & Smith *v.* Atlas Mfg. Co., 231 U. S. 348, 352;
> Chott *v.* Ewing, 237 U. S. 197, 199-202;

it may appear that in cases such as here at bar certiorari rather than appeal may be the preferred method for which to seek review of decrees of the Court of Appeals of the District of Columbia as well as of the United States Circuit Courts of Appeal located in the several Circuits.

Assignment of Errors.

The Baldwin Company duly assigned errors (R. 87) as follows:

> "1. Error on part of the Court of Appeals of the District of Columbia in holding that the Supreme Court of the District of Columbia was without jurisdiction to entertain this suit.

"2. Error on part of the Court of Appeals of the District of Columbia in reversing the decision and order of the Supreme Court of the District of Columbia, appealed from, for want of jurisdiction and remanding the cause with directions to dismiss plaintiff's bill of complaint with costs."

ARGUMENT.

Since announcement of the decision of the learned Court of Appeals in the case at bar this honorable Court again has had occasion to consider the jurisdiction of the District Courts of the United States under Sec. 4915, R. S. U. S., to entertain bills of complaint brought by a defeated party for registration of trade-marks, and, following its earlier decisions in Gandy *v.* Marble, 122 U. S. 285, and Baldwin Co. *v.* Howard Co., 256 U. S. 35, it again has declared that all such courts have jurisdiction of suits in equity brought against the Commissioner of Patents and an intervening party (as here R. S. Howard Co.) to determine such plaintiff's right to have trade-mark registered. American Steel Foundries *v.* Robertson, Commissioner, &c., 262 U. S. 209. In that case the plaintiff, American Steel Foundries, had filed application in the Patent Office for registration of its trade-mark "Simplex," which was refused by the Examiner of Interferences and such action was affirmed by the Commission. On appeal to the Court of Appeals of the District of Columbia the rejection by

Patent Office officials was affirmed and the action of the court was certified to the Commissioner to govern the further proceedings in the cause as required by law. Application to this court for certiorari was granted and subsequently dismissed for lack of jurisdiction, on the ground that the decree of the Court of Appeals of the District of Columbia was not a final decree (American Steel Foundries *v.* Whitehead, Commissioner, 256 U. S. 40, 41). American Steel Foundries thereupon filed its bill in equity under Sec. 9 of the Trademark Act of February 20, 1905 (33 Stats. 724, ch. 592), and Section 4915 R. S. U. S. Simplex Electric Heating Company promptly intervened and filed a motion to dismiss the bill for lack of jurisdiction in the District Court "over the subject-matter or alleged cause of action," and that motion was granted by the District Court without opinion. From the decree of the District Court dismissing its said bill of complaint, American Steel Foundries, by direct *appeal,* brought its case to this Court, which, upon consideration, entertained the *appeal,* reversed the decree of the District Court, and remanded the case to that court for further proceedings, saying, in course of its opinion (per Mr. Chief Justice Taft), at page 212:

> "The question in this case is whether the closing words of § 9 'and the same rules of practice and procedure shall govern in every stage of such proceedings, as far as the same may be applicable,' are broad enough in

their scope to include the 'remedy by bill in equity' granted to unsuccessful applicants for a patent in § 4915.

"In GANDY *v.* MARBLE, 122 U. S. 432, an unsuccessful applicant for a patent who had carried his application by appeal to the Supreme Court of the District, which was dismissed on its merits January 30, 1880, on May 3, 1883, filed a bill in equity in the District Supreme Court under § 4915 against the Commissioner of Patents. That Court dismissed the bill on the ground that the applicant had failed to prosecute his application within two years after the dismissal of his appeal from the Commissioner by the Supreme Court of the District, basing it on § 4894 of the Revised Statutes, reading as follows:

" 'SEC. 4894. All applications for patents shall be completed and prepared for examination within two years after the filing of the application, and in default thereof, or upon failure of the applicant to prosecute the same within two years after any action therein, of which notice shall have been given to the applicant, they shall be regarded as abandoned by the parties thereto, unless it be shown to the satisfaction of the Commissioner of Patents that such delay was unavoidable.'

"This section applies to proceedings in the Patent Office and before the Commissioner, and it was pressed upon this Court that it could not apply to such an independent proceeding as the bill in equity provided for in § 4915. But this Court held

that § 4894 did apply. Mr. Justice Blatchford, speaking for the Court, admitted (p. 439), following BUTTERWORTH *v.* HOE, 112 U. S. 50, 61, that the proceeding by bill in equity, under § 4915 'intends a suit according to the ordinary course of equity practice and procedure, and is not a technical appeal from the Patent Office, nor confined to the case as made in the record of that office, but is prepared and heard upon all competent evidence adduced and upon the whole merits,' but continued, 'yet the proceeding is, in fact and necessarily, a part of the application for the patent.' He summed up the conclusion of the Court as follows (p. 440):

"'The presumption of abandonment, under § 4894, unless it is shown that the delay in prosecuting the application for two years and more after the last prior action, of which notice was given to the applicant, was unavoidable, exists as fully in regard to that branch of the application involved in the remedy by bill in equity as in regard to any other part of the application, whether so much of it as is strictly within the Patent Office, or so much of it as consists of an appeal to the Supreme Court of the District of Columbia under § 4911. The decision of the court on a bill in equity becomes, equally with the judgment of the Supreme Court of the District of Columbia on a direct appeal under § 4911, the decision of the Patent Office, and is to govern the action of the Commissioner. It is, therefore, clearly a

branch of the application for the patent, and to be governed by the rule as to laches and delay declared by § 4894 to be attendant upon the application.'

"This view of the intimate relation of the bill in equity allowed in § 4915 to the application for a patent and the practice and procedure provided in due course thereof is of much assistance in giving proper scope to the words of § 9 of the Trade Mark Act. After making provision for an appeal to the District Court of Appeals from a simple refusal of registration, and from decisions of the Patent Office in three different kinds of adversary proceedings therein in respect of such registration, on complying with the conditions required in case of an appeal from refusal of a patent or a decision in a patent interference proceeding, the words are 'and the same rules of practice and procedure shall govern in every state of such proceedings, as far as the same may be applicable.' If the bill in equity of § 4915 is only a part of the proceeding for an application for a patent as held in GANDY *v.* MARBLE, it is no straining of the language to make these words include a bill in equity for the registration of a trade-mark. This Court has taken exactly this view in ATKINS & CO. *v.* MOORE, 212 U. S. 285. In that case it was held that a decision of the Court of Appeals of the District of Columbia affirming the decision of the Commissioner of Patents refusing registration of a trade-mark on an appeal under § 9 of the Trade Mark Act was not a final judgment of the Court

of Appeals which could be appealed to this Court, and in the argument to show that it was not, Chief Justice Fuller, who spoke for the Court, said (p. 291):

"'Under § 4914 of the Revised Statutes no opinion or decision of the Court of Appeals on appeal from the Commissioner precludes "any person interested from the right to contest the validity of such patent in any court wherein the same may be called in question," and by § 4915 a remedy by bill in equity is given where a patent is refused, and we regard these provisions as applicable in trade-mark cases under § 9 of the Act of February 20, 1905.'

This language is quoted with approval in the opinion of this Court in BALDWIN Co. *v.* HOWARD Co., 256 U. S. 35, in which it was held that there could be no review in this Court, by appeal or certiorari, of a decision of the District Court of Appeals in respect to the registration of a trade-mark under § 9 of the Trade Mark Act.

It is pressed upon us, however, that this language in ATKINS & Co. *v.* MOORE and in BALDWIN Co. *v.* HOWARD COMPANY, was not necessary to the conclusion in those cases and is to be regarded as *obiter dictum*. It was used in *arguendo* and was the unanimous expression of the Court in both cases. It may be that the conclusion that the decision of the Court of Appeals was not final and appealable to this Court could have been reached without this argument; but, however this may be, the construction put by the Court on § 9 is most persuasive and fol-

lows so clearly from the decision in GANDY *v.* MARBLE, that we find no reason to question its correctness.

"An argument has been made to us against giving such an effect to § 9 based on the intrinsic differences between the nature of the patent right, and that in a trade-mark. We do not regard such differences as important in interpreting § 9 when it is obvious from that section and the whole of the Trade Mark Act that Congress intended to produce a parallelism in the mode of securing these two kinds of government monopoly from the Patent Office."

The Supreme Court of the District of Columbia is possessed of the same powers and exercises the same jurisdiction in all patent and trade-mark cases as the District Courts of the United States (Sec. 61, Code, D. C.), and the striking similarity in all matters, both of fact and law, in so far as matters of jurisdiction are concerned between the case at bar and the case above cited and extracted from is readily apparent.

In view of the Court's so recent and unanimous rejection of the argument based upon the *obiter dictum* theory and its deliberate reassertion of the view that its construction previously announced respecting Section 9 of the Trade-mark Act in connection with Sec. 4915, R. S., U. S., is not only persuasive, but also correct, and that in such connection not only are there no important differences between patent rights and trade-mark registra-

tions, but the Congress, by enacting Section 9 "and the whole of the Trade-mark Act, obviously intended to produce a parallelism in the mode of securing these two kinds of Government monopoly from the Patent Office," it would seem undesirable to further dwell upon the untenable character and quality of the arguments adduced by the learned Court of Appeals of the District of Columbia to effect that the statutory proceedings referred to in said Section 9 was not intended to embrace actions in equity under Section 4915, R. S. U. S.

However, in the course of the learned opinion of said Court of Appeals, it is suggested that Section 22 of the Trade-mark statute, which provides that

> "Whenever there are *interfering registered* trade-marks, any person interested in any one of them may have relief by suit in equity against the said registrant,"

calls for the application of the maxim "*Expressio unius est exclusio alterius.*" and the learned dissenting justice has intimated that, apart from certain other considerations mentioned, he would be disposed to accept such view and to "limit the right to equitable relief to parties to 'interfering registered trade-marks.' "

But said Section 22 of the Trade-mark Act forms an integral part of said Act and questions as to the general scope and effect of the Act were

being considered by the Court in the earlier as well as in the latest cited cases. It is hardly to be supposed that in reaching the conclusions expressed in its opinions announced in those cases that the Court was entirely oblivious to the presence and reasonably obvious effect of said Section 22.

But in addition to that said Section 22 differs in no important particular from Section 4918, R. S. U. S., which provides that

> "Whenever there are *interfering patents*, any person interested in any one of them * * * may have relief against the interfering patentee, and all parties interested under him, by suit in equity against the owners of the interfering patent; and the court, on notice to adverse party, and other due proceedings had according to the course of equity, may judge and declare either of the patents void in whole or in part * * * according to the interest of the parties in the patent or the invention patented." * * * (Itals. sup.)

The mere matching up of said Section 4918, R. S. U. S., with said Section 22 of the Trade-mark Act, and the consideration of the provisions of each in the light of the several cases above cited and relied upon, would seem to put at rest forever the suggestion that the provisions of Sec. 4915, R. S. U. S., are any the less applicable and potent in trade-mark because of the presence of said Section 22 than in patent applications.

The single difference of possible importance between the case at bar and Atkins *v.* Moore and American Steel Foundries *v.* Robertson lies in the circumstance that in the last-mentioned cases relief in equity was sought by defeated applicants for the registration of trade-marks, while in the case at bar the defeated applicant seeks to prevent the cancellation of record of trade-marks found to be entitled to registry and actually registered after due notice of the application therefor had been given to all the world, including the intervener at bar.

But this difference is of no real importance from the standpoint of jurisdiction, for Section 9 mentions *applicants for registration* of a trade-mark and *parties to an application for the cancellation* of such registrations in the same sentence and as upon the same footing, and this Court, noting that circumstance, remarked that

> "After making provision for an appeal to the District Court of Appeals from a simple refusal of registration, and from decisions of the Patent Office *in three different kinds of adversary proceedings therein in respect of such registration,* on complying with the conditions required in case of an appeal from refusal of a patent or a decision in a patent interference proceeding, the words are 'and the same rules of practice and procedure shall govern in every stage of such proceedings, as far as the same may be applicable.' If the bill in equity of Sec. 4915 is only part of the proceeding for an ap-

> plication for a patent as held in GANDY *v.* MARBLE, it is no straining of the language to make these words include a bill in equity for the registration of a trade-mark. This Court has taken exactly this view in ATKINS & Co. *v.* MOORE, 212 U. S. 285" (262 U. S. 209, 213-214).

In view of the statutory juxtaposition of the adversary proceedings provided in cases of applications for registration and applications for cancellation of registrations already made of record, does it require any straining either of language or the imagination to make the magic words at the end of Section 9 apply as well to the latter as to the former?

Is it not bordering upon the absurd to even suggest that the Congress was meticulously careful to protect possible rights, not even administratively admitted, in a mere applicant for registration, but deliberately denied all protection to the owner of an actually registered trade-mark with its attendant advantages and correlated statutory rights?

Cancellation of a mark solemnly admitted to registry after full compliance with statutory requirements and the exercise of the quasi-judicial function reposed in the Commissioner is of at least equal dignity and consequence with the rejection of an application to admit such a mark to registry. If mere refusal to register merits review in equity, why does not attempted cancellation justify and require at least equal consideration?

In GAINES *v.* KNECHT, 27 App. D. C. 530, 532, cited and extracted from by this Court (per Fuller, Chief Justice) in ATKINS *v.* MOORE, 212 U. S. 285, 290, wherein opposition to the registration of a trade-mark had been made upon the ground that the Act of February 20th, 1905, was unconstitutional, and "also that the applicant's mark was so similar to the mark of opponent that it would be likely to lead to confusion and enable applicant to perpetrate a fraud upon the public, the Court of Appeals, remarking that the Commissioner of Patents had "treated the statute as valid, and so he ought to have treated it until it is otherwise determined by the courts," proceeded as follows:

> "It may be true that the Commissioner acts in a judicial capacity, in determining whether the applicant is the owner of the trade-mark, and whether it is one of those marks the registration of which is prohibited, but when he has determined these in favor of the applicant, the act to be performed by him (namely, the act of registering the mark) is ministerial merely, * * *. Such judicial proceedings as there are, issue and culminate in a purely ministerial act—the mere registration of a mark which, if the statute is void, cannot possibly prejudice the right of the opponent or of anyone else. *It is not as if the culminating act interfered with the person or property of others.* * * * We think he did not err in treating the act as valid. When some case shall arise in which rights of person or property must be

> affected by the decision it will become necessary to consider the question now attempted to be raised; but to pass upon it now would be to decide a question of theory alone, and this is not the province of a court."

Whatever may be the quality of the act to be performed by the Commissioner of Patents under the advisory opinion of the Court of Appeals of this District—that is, whether it be quasi-judicial or purely administrative—it is certain that in the case at bar, if permitted to occur, it will inevitably interfere with and affect the rights "of person or property" vested, as we contend, by the lawful registration in 1898 and 1905 of the marks proposed to be cancelled, and the question distinctly reserved from decision in GAINES *v.* KNECHT (next above) would seem to have emerged.

That the Supreme Court of the District of Columbia and this Court, acting in the exercise of its appellate power, is amply endowed with authority to prevent infliction of any such a wrong is aptly illustrated by the opinion and decree of this Court in the case of NOBLE, Secretary, etc., *v.* UNION RIVER LOGGING RAILROAD CO., 147 U. S. 165, 171, and the numerous reported cases which have since cited that case with approval and relied upon the principles of right which it so ably expounds.

In this connection it is to be borne in mind that both the Examiner of Interferences and the Commissioner of Patents denied the application of R. S.

Howard Company for the cancellation of plaintiff's registrations upon the ground that as under the final decision of the Circuit Court of Appeals for the Second Circuit, The Baldwin Company had been found and held to have "used 'Howard' upon its pianos long prior to the time the R. S. Howard Company began business, and that such use was with the knowledge and consent of R. S. Howard personally" (R. 56), and, further, "that The Baldwin Company, the registrant and defendant herein, is entitled to use the word 'Howard' (*simpliciter*) upon the fall board of pianos, whereas the R. S. Howard Company, the petitioner herein, is restricted to the use of 'R. S. Howard,' 'Robert S. Howard' or 'R. S. Howard Company' (R. 55), no injury could occur to R. S. Howard Company by the continued registration of record by The Baldwin Company of its mark 'Howard' " (*simpliciter*).

On appeal from the Examiner of Interferences to the Commissioner of Patents, it was said by the latter:

> "It is well settled by a long line of decisions of the Court of Appeals of the District of Columbia that a party cannot sustain a cancellation proceeding unless he can establish that he is damaged by the registration of the mark. The rights of the parties to the use of the mark in this Country having been fully determined by the Court it is not seen how the rights of the R. S. Howard Company are in any way affected by the registration. No suit could be sustained

against the R. S. Howard Company for any use of the words 'R. S. Howard Company' or 'Robert S. Howard Company,' and it has no right to use the word 'Howard' alone.

"So far as the question of foreign registrations is concerned, there is no testimony that the R. S. Howard Company has in any way been interfered with in its trade in foreign countries where the pianos were marked with the name of the company, and they have under the Court decree no right to mark them otherwise. One of the witnesses testified that the trade of the agent of the R. S. Howard Company in Cuba would have been interfered with had the registration of the name 'Howard' in Cuba been affected by the Baldwin Company, but it does not appear whether that testimony was based upon the fact that at one time R. S. Howard had marked pianos with the word 'Howard' alone or not.

"The witness Barber testified that the registration of the word 'Howard' in certain South American countries might put an undue burden upon the R. S. Howard Company to sustain its right to sell pianos marked with the name of the company since it would be difficult to establish that the marks were not substantially the same.

"As pointed out by the Examiner of Interferences, however, the burden is upon the R. S. Howard Company to establish the injury and if goods marked with the name of the company had been held up or the importation prevented, it was encumbent upon the company to show it, which has not been done.

"It may be noted, as appears from the record and as stated in the decisions of both Courts, that the earlier registration was obtained with the full knowledge of R. S. Howard; that he made no objection to its registration and he made no objection to the use of the word 'Howard' by The Baldwin Company *for several years after he left its employ.* It is further to be noted that at one time a suit was brought in the Courts of New York by R. S. Howard to prevent the use of the word 'Howard' by The Baldwin Company, but this suit was withdrawn and The Baldwin Company continued to use the word 'Howard' for a number of years thereafter and built up a large trade without any objection on the part of R. S. Howard or the R. S. Howard Company until the cancellation proceeding was brought in 1914.

"Attention is called in the Brief to the following statement of the Commissioner rendered on a petition:

" 'It is urged that the R. S. Howard Company has not shown the injury required by the statute. But if the mark is not registrable, I think any one who is legitimately using the name "Howard" on pianos is injured by the registration sufficiently to warrant cancellation proceedings.'

"That decision was rendered before the decision in the suit and expressly states that the person who would be injured by the improper registration is one who was 'legitimately' using the name 'Howard' on pianos. But the Court proceedings determines that

the R. S. Howard Company has no right to use the word 'Howard.'

"It is urged that the name 'Howard' and the name 'R. S. Howard Company,' or 'Robert S. Howard Company,' are substantially the same, and therefore there would be likelihood of confusion. The best evidence, however, on this point is the fact that although The Baldwin Company has continuously used the word 'Howard' since a time prior to the organization of the R. S. Howard Company and the R. S. Howard Company has been in business since 1902, yet there is on the record no proof of any confusion.

"It must be held, therefore, that the petition for cancellation was properly dismissed.

"The decision of the Examiner of Interferences is affirmed." (R. 59, 60, 61.)

The learned Court of Appeals of the District of Columbia, in the course of its earlier opinion reversing the above decision of the Commissioner of Patents (R. 61), declared that "unquestionably The Baldwin Company was the first to make a trade-mark use of the word 'Howard,'" but held that this circumstance, strong as its claim to fair and equitable consideration would seem to be, was of no importance because "The mark (in question) is not only a common surname, *but the name of appellant corporation* (a mistaken statement, we submit), either of which is sufficient to prohibit the right of registration or to form the basis

of an action for cancellation." (Itals. Sup.) (R. 63.)

But the conclusion so expressed overlooks the finding of the New York courts that the use and registrations in question had been with the full knowledge and consent of R. S. Howard personally (R. 48, 50) and entirely ignores the second proviso of Section 5 of the Trade-mark Act of 1905, which authorizes registration of a mark consisting of "the name of an individual, firm, corporation or association" when "written, printed, impressed or woven in some particular or distinctive manner," as is averred to be the case with the marks in question (R. 53*j*, 53*k*, 53*l*, 53*m*, 53*n*, 53*p*, 53*q*, 53*r*, 53*s*).

Having acquiesced in the use of said mark "Howard" from 1896 (R. 47) and in its registration in the Patent Office by The Baldwin Company from 1905 on until 1914 (R. 50), when R. S. Howard Company, of which Robert S. Howard was the president, general manager, active executive head, and one of its largest stockholders (R. 24), filed in the United States Patent Office the applications for cancellation which lie at the foundation of the protracted and varied judicial proceedings which have since ensued and of which the instant proceeding is but an element; said Robert S. Howard would seem to have estopped himself by his conduct from now successfully seeking to destroy that which he knowingly permitted The Baldwin Company to create.

It is true that R. S. Howard Company is the record applicant for cancellation, and that it is R. S. Howard Company who claims and must establish its complaint of injuries to it resulting from the continued registration of "Howard." But it is certain that R. S. Howard Company has no basis of claim to or complaint of injury from such source that is not available to R. S. Howard, personally. Any course of conduct on his part which would give rise to estoppel against him personally would likewise serve to estop his creature. If he personally would be estopped by acquiescence from complaining of continued registration of "Howard," his company, upon which he conferred his name, given name as well as surname, would have no greater right for complaint, and even less basis of hope for relief.

From at least 1899 to 1914, some fifteen years. The Baldwin Company, with full knowledge on part of R. S. Howard, marked and sold pianos of its manufacture with "Howard" and built up a good will and sales trade in pianos so marked of more than one million dollars annually (R. 3).

In Old Lexington Club Distillery Co. *v.* Kentucky Distilleries and Warehouse Co., 234 Fed. R. 464, there had occurred an acquiescence of fifteen (15) years' duration in the use of a certain trademark before any steps were taken to enjoin such use or the making of remonstrance against it. In such circumstances objection was made by the user of the mark that the applicant should not be per-

mitted to register an interfering mark though older mark. The District Court (Haight, D. J.) sustained this contention in a well-considered and enlightening opinion, saying in part (p. 468):

> "I cannot see that this phase of the case can be distinguished on principle from the decision of the Circuit Court of Appeals of this circuit in PFLUGH *v.* EAGLE WHITE LEAD COMPANY, 185 Fed. 769; nor from that of the Circuit Court of Appeals of the Second Circuit in CARROLL & SON CO. *v.* MCILVAINE, 183 Fed. 22. In the first of these cases it was said that the continued, persistent, and adverse use of the trade-mark by the defendant, to plaintiff's knowledge, during 14 years showed an abandonment of an exclusive claim by the plaintiff, and on such abandonment new rights had, in the meanwhile, arisen on the part of the public. It was held that under such circumstances it would be inequitable to arrest, at that late date, the defendant's trade, which had, with the plaintiff's knowledge, been built up upon its trade-mark. In the latter case, although the plaintiff had established the prior use of the designation 'Baltimore Club' as applied to whiskies, it was held that a delay of nearly 20 years, after knowledge of the use of the same designation by the defendant and its predecessors, to prevent such later use, was laches, which would disentitle the plaintiff to an injunction against defendant's use, at least in the territory where the defendant had always used the trade name and where

the plaintiff had not competed with it. True, in each of these cases there were other circumstances mentioned in the opinions; but they in no way affected the decisions on the point in question. To the same effect is VALVOLINE OIL CO. *v.* HAVOLINE OIL CO. (D. C. S. D. N. Y.) 211 Fed. 189, 194."

* * * * *

"In SAXLEHNER *v.* EISNER & MENDELSON CO., 179 U. S. 19, 37, it was held that the failure of one for 20 years to seek to prevent others in this country, although such efforts had been made abroad, from using a trade-name, was such laches as prevented relief, although there was no proof of actual knowledge of infringement in this country, Mr. Justice Brown remarking: 'By 20 years of inaction he has permitted the use of the word by numerous other importers, and it is now too late to resuscitate her original title.'

"FRENCH REPUBLIC *v.* SARATOGA VICHY CO., 191 U. S. 427, 436, is to the same effect.

"It would, in my judgment, be most inequitable to interfere with the defendant's trade under the circumstances of this case. The plaintiff has known of the defendant's use of its trade-name, and has taken no steps whatsoever to prevent it for at least 15 years, during all of which time defendant has been building up its business, which is far greater and more extensive than that of the plaintiff. For one to permit another to build up a reputation for one's goods under a trade-name for a long period of time, and then to assert an exclusive right to that name, and

thereby acquire the benefit of the reputation and trade which the other has built up, when it lay in the power of the former at any time to have arrested the use of the trade-name by the latter, seems to me most inequitable, because, if the right had been asserted before the reputation was acquired the infringer could have adopted another name and built his reputation on it. It would also tend to further deception upon the public, one of the results which injunctive relief in trade-mark cases seeks to prevent. Of course, if one knowingly and willfully adopts a name which has been used by another, a different situation might be presented. Such a case would exhibit actual fraud, and such, I think, is the distinguishing feature between cases such as this and MENENDEZ *v.* HOLT, *supra*. See SAXLEHNER *v.* EISNER & MENDELSON, *supra*, 179 U. S. 39, But nothing of that kind appears in this case.

"It remains, therefore, to consider whether such a defense is applicable to this kind of a suit. The statute provides that the registration of of trade-mark 'shall be *prima facie* evidence of ownership.' Section 16. Section 6 permits any one who believes he would be damaged by the registration of a trade-mark to oppose the same. This latter section has been construed to mean, and I think properly so, that the objector must show such interest in the proposed trade-mark that damage may be inferred. BATTLE CREEK *v.* FULLER, 30 App.

D. C. 411; UNDERWOOD *v.* DICK, 36 App. D. C. 175.

"It is urged by the plaintiff that as it has shown a prior adoption and use of the mark, and as the registration thereof would be only *prima facie* evidence of ownership, the defendant could not be damaged by the registration, because it would have the same right to assert the defense, which it now urges, in any suit which might be brought for an infringement of the trade-mark so registered, as if it were not registered. There are, I think, several answers to this contention. In the first place, I think that the principle under which relief is denied in the cases before mentioned is that the one asserting the exclusive right, although he had such a right at one time, no longer has it, either on the theory that the right has been lost *or that he is estopped from asserting it*, or from denying that it has been abandoned. The latter was considered by the Circuit Court of Appeals of the Eighth Circuit in LAYTON PURE FOOD CO. *v.* CHURCH & DWIGHT, 182 Fed. 35, 41, and apparently by the Circuit Court of Appeals of this Circuit in the Eagle White Lead Suit, *supra*, to be the principle underlying such cases.

"Under any of these theories the defendant would be damaged by the registration of the trade-mark, because it would confer upon the plaintiff a right to which it is not entitled, and which it could assert against the defendant, namely, a *prima facie* title. *Further, it would seem to be ridiculous for*

> *a court to direct the registration of a trade-mark over the opposition of another, when, under the facts presented, it would not permit the owner of the trade-mark the exclusive right to use the same as against the other. In addition, I can readily see that damage would result to the defendant if the plaintiff were permitted to register this trade-mark, because in any suit hereafter brought against the defendant for infringement thereof the burden of disproving the plaintiff's title to the trade-mark as against the defendant would be cast upon the latter.* (Italics supplied.)

Such arguments, *mutatis mutandis*, are equally applicable to the concourse of circumstances which define the case at bar.

It would be most inequitable to permit R. S. Howard either personally or in the name of his creature corporation, to maintain action either in the Patent Office or elsewhere to dislodge from the records a registered trade-mark in the registration of which he had acquiesced with full knowledge for more than fourteen (14) years.

It would be ridiculous for a court to direct or permit such a registered trade-mark, associated for more than fourteen (14) years with an increasing good will and a lucrative business to be cancelled at the instance of one who has been decreed to be without right and enjoined finally and perpetually from making use of the mark in the form registered and finally it is easily to be perceived

that by such cancellation if permitted to occur, damage would necessarily result to The Baldwin Company by reason of the loss of the favored position conferred by statute upon the holder of a registered mark, both with respect to the burden of proof and the right to triple damages in cases for infringement.

Again, R. S. Howard Company suggests that this suit under Section 4915 R. S. U. S. "was not brought in time," that is, "within one year after any action" had in the Patent Office, of which the *applicant* had been given notice.

It is to be noted that in the case at bar R. S. Howard Company is the *applicant,* not The Baldwin Company, as learned counsel for the former would seem to imply.

It was the Howard Company—not the Baldwin Company—that filed application, not for the registration of a trade-mark, but for the cancellation thereof and which required prosecution in the Patent Office under Section 13 of the Trade Mark Act; it was the Howard Company, not The Baldwin Company, that appealed to the Court of Appeals of the District of Columbia under Section 9 of the Trade Mark Act from the refusal by the Commissioner of Patents to cancel The Baldwin Company's registered mark and his dismissal of the Howard Company's application to cancel such registration.

It is true that the Court of Appeals of the Dis-

trict of Columbia, by its opinion filed March 3, 1919, reversed the order of the Commissioner of Patents dismissing the Howard Company's application for cancellation and, further, that the original bill of complaint in the case at bar was only filed May 7, 1921, but it is also true that said bill of complaint was filed in the Supreme Court of the District of Columbia within 30 days after disposition had been made by this Court of the previous proceedings in the cause. It is suggested, however, by our learned opponents that the bar of one year prescribed by Section 4894, R. S. U. S., as amended, takes no account of and makes no allowances for mistake on part of litigants or their counsel, who are so unfortunate as to seek relief in a wrong tribunal. If no other justification for the course pursued by The Baldwin Company were available in the instant suit, it would seem to be reasonably satisfactory and sufficient to call attention to the fact that at the date of the allowance of the appeal to this court the former proceedings, viz., June 9, 1919, and the submission of application by The Baldwin Company for allowance of *certiorari* therein, this honorable court had then pending on its docket the case of Estate of P. D. Beckwith, Inc., *v.* Commissioner of Patents, 250 U. S. 538, involving questions under the Trade Mark Act similar to those in the instant cause in which *certiorari* had been granted November 4, 1918, 248 U. S. 556, and which was considered fully and disposed of on the merits April 19, 1920. It

was not until April 11, 1921, that this court, when disposing of the former phases of the present controversy repudiated jurisdiction in such cases (256 U. S. 40).

Under such circumstances surely equity would not be astute to wring penalties from obscure sources and lead them through tortuous channels, to the detriment of its willing though possibly misinformed devotees.

But we venture to think, and with confidence to submit, that as in GANDY *v.* MARBLE, 132 U. S. 432, and in WESTINGHOUSE ELECTRIC CO. *v.* OHIO BRASS CO., 186 Fed. 518, the ascertained penalty for abandonment, whether actual or putative, was limited solely to the *applicant for the issuance of patent* and by analogy should be limited also to *applicants* for the registration of trade-mark, nevertheless the doctrine invoked by learned opponents has no application here, for so long as the trade-marks in question remain intact of record in the Patent Office and continue to be used by The Baldwin Company in its daily and increasing business, no basis was or can be furnished upon which an envious rival seeking to share improperly in registrant's business can predicate a charge of abandonment, for as The Baldwin Company had no application pending which required prosecution it could not by failing to prosecute that which did not exist be rightly charged with abandonment of the nonexistent.

The Circuit Court of Appeals for the Sixth Cir-

cuit, Denison, Circuit Judge, speaking for the court, in CLEMENTS *v.* KIRBY, 274 Fed. 575, wherein a bill in equity under Revised Statutes, Section 4915, "to procure for Clements the patent issued to Kirby" was under consideration, would seem satisfactorily to have disposed of a like question, as follows (p. 582):

> "Was, then, the filing of this bill barred by the delay of more than one year between May 28, 1915, and June 16, 1916? There is no limitation statute which provides that a bill, under Section 4915, *based upon a refusal by the Commissioner or the Court of Appeals,* must be filed within one year after such refusal—as counsel in argument seem more or less to assume. The only limitation of this character results from the decisions that to file a bill under Section 4915 is, within the contemplation of Section 4894, to 'prosecute' the application for patent, as must be done 'within one year after any action therein,' in order to avoid the inference that the application shall be regarded as abandoned'—unless, even then, the delay may be found to have been unavoidable.
>
> "The question, therefore, is whether this application was abandoned by a failure to prosecute for more than a year. The mere recital of the facts furnishes an indisputable answer. So far from being abandoned, the application was prosecuted with the utmost diligence and persistence. It is true that Clements made no further effort to get these two claims which had been in interference;

but the application is and continues to be a unit, and it is plainly not abandoned unless it is wholly so. Even if it were true that Clements' theory of the further action which should be taken was wholly erroneous, and he was asking action which he should have known he could not get, or even if the Patent Office had lost jurisdiction to do anything except issue the patent, the inference of abandonment would not follow. It is a familiar principle that, though a tribunal may have no power to grant the relief asked, it has jurisdiction to hear and determine the question of power; and we perceive no tenable theory upon which it may be said that Clements' two applications to the Commissioner in June and July, 1916, each followed by 'action' by the Commissioner, are consistent with a then maturing abandonment by him of his application. Even the language of Patent Office Rule 171, 'such proper action as the condition of the case may require,' cannot mean that a request is not 'prosecution' unless it is grantable.

"That inference of abandonment is as much without support in authority as in principle. In GANDY *v.* MARBLE, 122 U. S. 432, 7 Sup. Ct. 1290, 30 L. Ed. 1223, one year and four months more than the specified time had elapsed after the decision of the appeal from the Commissioner, and *no step of any kind had been taken.* It was not denied that the application had been abandoned under Section 4894, if that section applied at all to a suit under Section 4915. In WESTINGHOUSE CO. *v.* OHIO CO. (C. C.)

186 Fed. 518, the facts in this respect are not stated, but it is assumed that the requisite time had elapsed *without the taking of any step in prosecution*—except the filing of a previous bill under Section 4915, which was wholly ineffective because not filed against the right party; and manifestly whether certain action may properly be characterized as prosecution of the claim presents materially and perhaps vitally different questions when it is taken in a tribunal with general jurisdiction and when application is made in a forum which is open in one particular situation only.

* * * * *

"The present situation is not like a writ of error, which is followed in the wrong court until the statutory time for application to the right court is gone. There the limitation runs from the day of the act to be reviewed; here it runs from the time when the plaintiff becomes acquiescent and begins to do nothing. From these considerations, it necessarily follows that, as to the two claims which were in interference, Clements' application for patent had been refused within the meaning of Section 4915, and that it had not been abandoned within the meaning of Section 4894." (Italics supplied.)

As no action of any sort had or has been taken in the Patent Office since the filing by R. S. Howard Company of its applications for cancellation herein, applications did not at any time call for affirmative action by way of "prosecution" or other-

wise, on part of The Baldwin Company, and as the latter's registered marks still remain of record as they have at all times in question heretofore, and as the proceedings initiated by The Baldwin Company at all times since initiation have been judicial in character and have sought but that protection from wrong which the Constitution and the Statutes of the United States guarantee in such and similar cases, such proceedings have been as prompt and as unceasing as the judicial progress through established courts as their processes would permit, it seems to be quite evident that any allegation of "abandonment" or "acquiescense" on part of The Baldwin Company is without foundation in fact or in law.

In addition to the foregoing suggestions, it may pertinently be remarked that no question of merits was presented to or considered by either of the lower courts, save only as the motion to dismiss filed by R. S. Howard Company must be taken as admitting as true all facts properly averred in plaintiff's bill of complaint, and the action of the trial court in granting plaintiff's prayer for an injunction *pendente lite* is to be taken as but evidencing the court's view that the matters and things set forth in defendants' answer and exhibits thereto even though accepted as truth show no sufficient basis for immediate proceedings in the Patent Office under the certificate of conclusions reached by the Court of Appeals, the correctness of which conclusions both in regard to facts assumed and principles of law deemed by said court to be

applicable is seriously and in the only manner permitted to it so to do, being tested out in the case at bar.

Such proceedings as this (under R. S. U. S. 4915) constitute a suit according to the ordinary course of equity practice and procedure. It is not an appeal technical or otherwise from the action of the Commissioner of Patents, nor is the plaintiff to be confined to the record as made in the Patent Office, but his complaint is to be heard upon all competent evidence which he may adduce.

BUTTERWORTH *vs.* HOE, COMMISSIONER, 112 U. S. 50; GANDY *vs.* MARBLE, 122 U. S. 432.

The testimony taken before the Patent Office though touching the same subject matter and between the same "*parties is both incompetent and inadmissible unless a foundation is laid for its introduction as secondary evidence.*"

DOVER *v.* GREENWOOD, 154 Fed. 854;
MANSEN *v.* SLICK, 216 Fed. 164.

The so-called pleas of *res judicata* are not open here at this time, nor is it permissible to discuss the soundness of the conclusions reached by the learned Court of Appeals in its original opinion herein to effect "Howard" being "not only a common surname, but the name of appellant (R. S. Howard Company) Corporation" *sic* was incapable of lawful registry and at the instance of R. S. Howard Company afforded basis for cancellation (R. 63). But The Baldwin Company claims that

the registration in question was had with full consent of the particular Howard who now seeks cancellation and further that "Howard" though "the name of an individual" is so written and impressed as to justify registration under the permissive clause of the Trade Mark Act of 1905 and as amended.

In this connection see Brown on Trade Marks, Vol. 1, 2d Ed., p. 325, Section 326, and elsewhere.

In OLD LEXINGTON CLUB DISTILLERY CO. *v.* KENTUCKY DISTILLERIES & WAREHOUSE COMPANY, 234 Federal 464, and above referred to, objection was made to the registration of a mark to which priority in use was conceded, but for the protection of which and against the use of which over a period of years by a rival, the owner had taken no steps nor made protest. Registration was denied and such administrative action was supported in its entirety by the courts.

In the case at bar application for cancellation of registered marks is made by an envious trade rival after at least fourteen years of acquiescent knowledge of the existence of such registration and after two courts of competent jurisdiction and high repute have declared that as trade designations the marks were the property of and were to be used by The Baldwin Company alone, and had enjoined and debarred R. S. Howard Company from making any trade use thereof in the form registered.

As in the Old Lexington Club Distillery Company case last above cited, the District Court of the

United States for the District of New Jersey declined to adjudicate the rights of the contending parties on demurrer, so in the case at bar and no doubt for similar reasons, the Supreme Court of the District of Columbia denied R. S. Howard Company's motion to dismiss plaintiff's bill of complaint.

As in the last cited case the United States District Court for the District of New Jersey refused to permit registration pending the final determination on its merits of the controversy between the parties, so in the case at bar, the Supreme Court of the District of Columbia enjoined the defendant Robertson, as Commissioner of Patents, *pendente lite*, from cancelling the registrations of the trade-marks in question or from otherwise interfering with the *status quo*.

As upon the record pending before this Court, there is and can be no dispute whatever with regard to matters of fact and the sole question of law attempted to be adjudged in each of the lower courts was but the single question as to the existence of jurisdictional power to entertain such a suit at all, it is submitted with deference that the only question before this Court for determination is still the question of jurisdiction about which the two lower courts differ. Upon the strength of the statutes referred to as construed in the cited cases decided by this Court, such question should be resolved in favor of the existence of controlling judicial power and against the existence of the

suggested executive right to destroy private property and interests therein free from judicial control. Noting the obvious similarity between letters patent of the United States duly issued and commercial trade-marks in active use duly registered, it is suggested that as the former cannot be made void or cancelled subsequent to issue by action of the Patent Office alone, so also, in the case of registered trade-marks, the ultimate right of cancellation when contested should rest with the courts, which upon well-known principles, will yield to executive action, especially when concurrent in two or more branches, the fullest consideration. In connection with this final suggestion, it should steadily be borne in mind that in the case at bar, both the Examiner of Interferences and the Commissioner of Patents who are charged in the written statutes with the primary duty of determining all applications for cancellation of registrations, have concurred in the view and determination that the trade-marks here under consideration are valid and are not reasonably subject to cancellation.

FREDERIC D. MCKENNEY,
JOHN SPALDING FLANNERY,
For Appellant and Petitioner.

LAWRENCE MAXWELL,
Of Cincinnati, Ohio;
JOHN E. CROSS,
Of Baltimore, Maryland,
Of Counsel.

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SUPREME COURT OF THE UNITED STATES

October Term, 1923.

No. 251.

THE UNITED STATES OF AMERICA,

ex relatione, THE BALDWIN COMPANY,

Appellant-Petitioner,

vs.

THOMAS E. ROBERTSON, as Commissioner of Patents, and R. S. HOWARD COMPANY, Intervenor.

BRIEF OF R. S. HOWARD COMPANY.

SAMUEL S. WATSON,
Attorney for R. S. Howard Company,
2 Rector Street,
New York City, N. Y.

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SUPREME COURT OF THE UNITED STATES

October Term, 1923.

No. 251

THE UNITED STATES OF AMERICA, *ex relatione*, THE BALDWIN COMPANY,

Appellant-Petitioner,

vs.

THOMAS E. ROBERTSON, as Commissioner of Patents, and R. S. HOWARD COMPANY,

Intervenor.

BRIEF ON BEHALF OF R. S. HOWARD COMPANY.

Statement of the Case.

This action was brought to enjoin the Commissioner of Patents from cancelling two Trade-Mark Registrations which the Court of Appeals of the District of Columbia has ordered cancelled (48 App. D. C. 437; Rec. pp. 61-65).

Said Registrations are No. 31,411 registered March 8, 1898, by the Valley Gem Piano Company, and No. 46,993 registered October 17, 1905, by The Baldwin Company, appellant.

Both said Registrations are for pianos and both are claimed to be owned by The Baldwin Company, and *use* of both marks is claimed since December 15, 1896.

The "10-year" clause of Sec. 5 of the Trade-Mark Act o 1905 is not involved, because *use* of the marks is *not* claime for the requisite "10-year" period.

Registration No. 31,411 is reproduced on pages 53-r, 53- of the Record; the essential features of this mark "consist of the word 'Howard' in connection with the initials 'VGPCo.' in the form of a monogram".

Registration No. 46,993 is reproduced on pages 53-p, 53-q of the Record and consists solely of the common personal name "Howard".

Appeals to this Court from the Decree of the Court of Appeals of the District of Columbia, decreeing the cancellation of said Registrations, were dismissed, and petitions for writs of certiorari were denied. (256 U. S. 35; 41 Sup. Ct. Rep. 405).

Before the Commissioner of Patents had cancelled said Registrations, pursuant to said decision and decree of the Court of Appeals of the District of Columbia, The Baldwin Company filed its bill of complaint, at bar, in the Supreme Court of the District of Columbia, under Sec. 4915 Rev. Stat., praying that the Commissioner be enjoined from cancelling said Registrations, *pendente lite* and perpetually, and obtained a temporary restraining order.

The R. S. Howard Company (which intervened) filed its answer and moved to dismiss the bill of complaint.

The Supreme Court of the District of Columbia *denied* the motion to dismiss the complaint and *granted* the injunction *pendente lite.*

The Commissioner of Patents and the R. S. Howard Company appealed to the Court of Appeals of the District of Columbia from the decree denying the motion to dismiss the Complaint and granting the injunction *pendente lite.*

The Court of Appeals of the District of Columbia reversed the decision of the Supreme Court of the District of Columbia and ordered that the bill of complaint be dismissed (Rec. pp. 79-84; 287 Fed. 942; 52 App. D. C. 368) saying:

"Believing that there is no authority for the maintenance of this suit we reverse the decision appealed from and remand the case with instructions to dismiss the suit, with costs to be assessed against appellee". (Rec. p. 83).

Thereupon The Baldwin Company appealed to this Court and petitioned for a writ of certiorari. The appeal is now at bar and consideration of the petition for certiorari has been postponed until the hearing upon this appeal.

Appellant now seeks to re-try, *de novo,* said Cancellation Proceedings and claims that Section 4915 R.S. authorizes this action and such re-trial.

Appellant does not attempt to impeach the decree in said Cancellation Proceedings "for fraud, accident or mistake", or for any irregularity in the Cancellation Proceedings, or on the ground that the Court of Appeals of the District of Columbia was without the jurisdiction of the parties or the subject-matter, or on the ground of newly discovered evidence, nor is this action sought to be maintained upon the general principles of equity, but *solely* under Sec. 4915 R.S. (Complaint par. 12, Rec. p. 9).

Respondent contends that Sec. 4915 R. S. does not authorize this action; that the Trial Court is without authority or power to hear or determine this cause; that the trial Court is without power or authority of law to adjudicate concerning the subject-matter of this action or to grant any relief in the premises.

In addition, respondent contends that the claim set forth in the complaint is so unsubstantial as to be without color of merit, and that the action should be dismissed on that ground.

Furthermore, respondent contends that the issue here involved is *res adjudicata,* by reason of the adjudication and determination of the identical issue between the same parties in a former Equity Action in the Federal Courts of the Sec-

ond Circuit wherein every material fact and circumstance alleged at bar was alleged, litigated and *determined* and the identical relief, in substance and effect, now prayed, was *denied.* (See *infra,* pp. 61-64).

The Record before this Court on this Appeal.

Appellant has pleaded the decree in a former Equity Action between appellant and respondent (Rec. pp. 4, 5, 7, 8) and, in its complaint, has made extensive reference to both said Equity Action and the Patent Office Cancellation Proceedings between appellant and respondent (Rec. pp. 5, 6, 8).

Respondent in support of its motion to dismiss the complaint, submitted its answer in which it pleaded the entire record in said Patent Office Cancellation Proceedings, which record includes the record of both Courts in said Equity Action (Complaint, Rec. p. 5).

The issue here and every material allegation and the entire subject-matter of this action *were involved* and *determined* in said former Equity Action between appellant and this respondent (*The Baldwin Co.* v. *R. S. Howard Co.,* 233 Fed. 439; 238 Fed. 154; 243 U. S. 636), the complete record of which is a part of the records of this Court (Case No. 916, October Term, 1916).

The entire subject-matter of this action was also involved in said Patent Office Cancellation Proceedings between this respondent and appellant (*R. S. Howard Co.* v. *The Baldwin Co.,* 48 App. D. C. 437; 256 U. S. 35), the complete record of which is also a part of the records of this Court (Cases Nos. 113 and 139, October Term, 1920).

The portions of said records which appear to counsel to be material and relevant to the issues at bar are contained in the printed record at bar. The matters submitted are the complaint, uncontradicted and unmodified *sworn admissions* of appellant's officers, *public records* and *Court proceedings,* as to which there can be no dispute.

This Court takes judicial notice of its own records; here the parties and the subject-matter are the same.

de Bearn v. *Safe Deposit Co. of Baltimore,* 233 U. S. 24;
Butler v. *Eaton,* 141 U. S. 240;
Bienville Water Co. v. *Mobile,* 186 U. S. 212, 217;
Craemer v. *Washington State,* 168 U. S. 124, 129;
Dimmick v. *Tompkins,* 194 U. S. 540, 548.

Federal Courts take judicial notice of the Rules of the United States Patent Office and of the Trial Court.

U. S. Shipping Board Fleet Corp. v. *Sullivan,* 261 U. S. 146, 148;
Caha v. *United States,* 152 U. S. 221, 222, and cases cited.
Hanley v. *Donoghue,* 116 U. S. 1, 6.
United States v. *Eliason,* 16 Pet. 291;
Gratiot vs. *United States,* 4 How. 80;
James v. *Germania Iron Co.,* 107 Fed. 597, 609.

The Baldwin Company not the first to use "Howard" as a mark for pianos.

R. S. Howard Company was incorporated in April, 1902, forthwith acquired a going piano factory and began and has since continued the manufacture and sale of pianos which it sold throughout the United States from the Atlantic to the Pacific and in a long list of foreign countries, which pianos were marked "Howard" and "R. S. Howard & Co." (Rec. pp. 23-26).

R. S. Howard Company upon its incorporation succeeded to the business, good-will, trade-names and trade marks of Robert S. Howard, its principal organizer, who became and has since continued to be its president and general manager. Robert S. Howard has been continuously in the piano business since 1877 and was selling pianos to dealers in the prin-

cipal cities of the United States from the Atlantic to the Pacific continuously for more than twenty years prior to 1902. (Rec. pp. 23-25).

From 1889 to 1896 Robert S. Howard was continuously selling pianos, made by the New England Piano Company of Boston, Mass. which pianos, at his suggestion and request, were marked "Howard" and "R. S. Howard & Co."; also, beginning in 1893, "Howard & Co." (Rec. pp. 24, 25).

In said Equity Action between appellant and respondent, Judge Hough found that *prior to 1896,* and prior to appellant's claimed use of "Howard",

> "there were thousands sold under the title 'R. S. Howard & Co.', 'Howard, New York', 'Howard & Co., Boston', and 'R. S. Howard & Co., Boston'," and that "no other salesman except Howard sold pianos with the 'Howard' mark upon them". (Rec. p. 47).

Respondent's Motion to Dismiss the Complaint.

This respondent moved in the Trial Court, to dismiss the bill of complaint and urged three separate and distinct grounds (Rec. p. 66):

(a) That the bill of complaint fails to state a cause of action, and is bad in substance;

(b) That said Court is without power or authority to grant the relief prayed for, or any relief in the premises;

(c) That all issues involved in the said above-entitled action are *res adjudicata,* as a matter of law, as appears from the allegations and admissions contained in the bill of complaint and the matters of record, admitted and of which the Court will take judicial notice.

Rules of the Supreme Court of the District of Columbia.

Under the Equity Rules of the Supreme Court of the District of Columbia "demurrers and pleas are abolished", and respondent has pursued the only permissible procedure to secure consideration of the several grounds urged in support of its motion to dismiss. The Equity Rules of the Supreme Court of the District of Columbia provide:

> Rule 32.—"Demurrers and pleas are abolished. Every defense in point of law arising upon the face of the bill, shall be made by motion to dismiss. Every defense heretofore presentable by plea in bar or abatement shall be made in the answer, and may be separately heard and disposed of before the trial of the principal case in the discretion of the court. If the defendant move to dismiss the bill, or any part thereof, the motion may be set down for hearing by either party upon five days' notice, and, if it be denied, answer shall be filed within five days thereafter or a decree *pro confesso* entered."

I.

Has this Court Jurisdiction?

Appellant appears to be in doubt of the jurisdiction of this Court (See Appellant's brief, p. 6, and petition for certiorari, p. 19).

This action is purely a statutory proceeding, brought under Section 4915 R. S., (Complaint par. 12, Rec. p. 9) which appellant asserts is a Patent Law of the United States. (Appellant's brief p. 6).

This Court has foreclosed the question of the right of appeal to this Court in an action under the Patent Laws

of the United States, and has directly held that there is no appeal.

Chott v. *Ewing*, 237 U. S. 197;
Hutchinson v. *Loewy*, 217 U. S., 457;
Gompers vs. *United States*, 233 U. S., 604;
Chapman vs. *United States*, 164 U. S., 436.

In *Durham* v. *Seymour, Com. of Patents*, 161 U. S. 235, 237, 239, which was an appeal from the Court of Appeals of the District of Columbia in an action for a patent under Sec. 4915 R. S., decided before the adoption of the Judicial Code, this Court held that it was without jurisdiction and that there was no right of appeal, saying:

> "the matter in dispute was whether Durham was entitled to a patent as for a patentable invention. * * * the proceeding is in fact necessarily a part of the application for the patent. Considered in this light it is clear that the validity of a patent was not involved.
>
> "And we may add that it appears to us to be quite inconsistent with the intention of Congress for this Court to take jurisdiction on appeals of applications for patents in view of the provisions in relation to appeals from the Circuit Courts of Appeals under the Act of March 3, 1891, c. 517, 26 Stat. 826. *United States* v. *Amer. Bell Telephone Co.*, 159 U. S. 548".

II.

Section 4915 R. S. does not Authorize this Action.

Sec. 4915 R. S. is a statutory provision to *secure* a purely statutory right; that is, to *secure* a patent. Critical attention is respectfully requested to the language of the statute. It reads:

"Sec. 4915. Whenever a patent on application is refused, either by the Commissioner of Patents or by the Supreme Court of the District of Columbia upon appeal from the Commissioner, the applicant may have remedy by bill in equity; and the court having cognizance thereof, on notice to adverse parties and other due proceedings had, may adjudge that such applicant is entitled, according to law, to receive a patent for his invention, as specified in his claim, or for any part thereof, as the facts in the case may appear. And such adjudication, if it be in favor of the right of the applicant, shall authorize the Commissioner to issue such patent on the applicant filing in the Patent Office a copy of the adjudication, and otherwise complying with the requirements of law. In all cases, where there is no opposing party, a copy of the bill shall be served on the Commissioner; and all the expenses of the proceeding shall be paid by the applicant, whether the final decision is in his favor or not."

By Act of Feb. 9, 1893, ch. 74; 27 Stat. L., 434, the Court of Appeals of the District of Columbia was substituted for the Supreme Court of the District of Columbia in Sec. 4915 R. S.

It is difficult to conceive in what words Sec. 4915 R. S. could be more explicitly stated. Its language is unmistakably plain.

In *Sweet* v. *United States*, 228 Fed. (C. C. A.) 421, 423, the Court said:

"The conclusive legal presumption is that the legislative body means what it said, and the duty of the Courts is to give effect to its acts, not to amend or repeal them".

In *United States* v. *Chase*, 135 U. S. 255, 262, the Court said:

"It is safe to adopt what the legislature have actually said than to suppose what they meant to say".

Caminetti v. *United States*, 242 U. S. 470;
Hamilton v. *Rathbone*, 175 U. S. 414, 421;
United States v. *Hartwell*, 6 Wall. 385, 396;
United States v. *Goldenberg*, 168 U. S. 95.

Sec. 4915 R. S. (as pointed out by Judge Aldrich in *Greenwood* v. *Dover*, 194 Fed. (C. C. A.) 90, 97) has come down to us without substantial change from the time when there was no review by any Court or Judge of decisions of the Commissioner of Patents. Its language goes back to the Patent Act of 1836 when there was first created a Board of Examiners.

In *Butterworth* v. *Hoe*, 112 U. S. 50, and in *United States* v. *Duell*, 172 U. S. 576, this Court summarized all the instrumentalities provided by Congress since the foundation of the Government for the granting of patents and traced the development of appeals, viz:

In 1793 appeals might be taken to three arbitrators; in 1836 appeals might be taken to the Board of Examiners composed of three dis-interested persons whose decision was to be certified to the Commissioner of Patents who "shall be governed thereby in further proceedings to be had on such application," and remedy by bill in equity was first provided; in 1839, somewhat modified in 1849 and 1852, appeal was provided from the Commissioner to one of the Judges of the Circuit Court of the District of Columbia; in 1870 an appeal was provided from the decision of the Commissioner to the Supreme Court of the District of Columbia sitting in banc "whose decision was to govern further proceedings in the case"; in 1893 appeals were transferred from the Supreme Court of the District of Columbia sitting in banc to the Court of Appeals of the District of Columbia, which is the present status.

Patents and Trade-Marks are substantially different.

In *United States* vs. *Duell*, 172 U. S., 576, 586, (quoting with approval from *Butterworth* v. *Hoe*, 112 U. S. 50), "in deciding whether a patent shall issue or not", the Court said:

> "The questions of fact in this field find their answer in every department of physical science, in every branch of mechanical art; the questions of law, necessary to be applied in the settlement of this class of public and private right, have founded a special branch of technical jurisdiction. The investigation of every claim presented involves the adjudication of disputed questions of fact, upon scientific or legal principles, and is, therefore, essentially judicial in its character, and requires the intelligent judgment of a trained body of skilled officials, expert in the various branches of science and art, learned in the history of invention, and proceeding by fixed rules of systematic conclusions".

While Congress provided for the granting of patents in 1790 (Ch. 7, 1 Stat. 109) it made no enactment in any way relating to trade-marks until 1870, and no valid enactment prior to 1881. That there is a wide and substantial difference between patents and trade-marks is shown by a comparison of the language quoted above from *Butterworth* v. *Hoe*, and that found in the *Trade-Mark cases*, 100 U. S. 82, 94, where the Court said:

> "Any attempt, however, to identify the essential characteristics of a trade-mark with inventions and discoveries in the arts and sciences, or with writings of authors, will show that the effort is surrounded with insurmountable difficulties.
>
> "The ordinary trade-mark has no necessary relation to invention or discovery. The trade-mark recognized by the common law is generally the growth of a considerable period of use, rather than a sudden invention.

It is often the result of accident rather than design, and when under the Act of Congress it is sought to establish it by registration, neither originality, invention, discovery or science nor art, is in any way essential to the right conferred by the Act."

The registration of a Trade-Mark is solely a statutory privilege and the statutory limitations are strictly construed.

When the exercise of power depends wholly on statute, the limitations and scope of the statute become jurisdictional problems.

In *United States* v. *Am. Bell Telephone Co.*, 167 U. S. 224, 247, referring to the provisions of the Patent Statutes, the Court said:

> "These are questions not of natural but purely statutory right. * * * No Court can disregard any statutory provisions in respect to these matters on the ground that in its judgment they are unwise or prejudicial to the interests of the public".

That the statutory limitations of the Trade-Mark Acts have been *strictly construed* is illustrated by a host of cases, of which the following are a few:

Stark Bros. v. *Stark*, 255 U. S., 50. Held: No damages can be recovered in an action for infringement of registered trade-mark except on proof that defendant was notified of the registration by actual notice or constructive statutory notice by marking the goods as required by the statute, and notice to "discontinue the unfair competition and infringement of our rights" not sufficient as a basis to recover damages under the Trade-Mark Statute.

Elgin Nat'l Watch Co. v. *Illinois Watchcase Co.,* 179 U. S., 665. Held: Where a word or name had been improperly registered, or registered without authority of Law, the registration conferred no rights or benefits under the Trade-Mark Statutes. He can register only what he has used in foreign commerce or lawful commerce with Indian tribes. *Warner* v. *Searle & Hereth Co.,* 191 U. S. 195.

Ryder v. *Holt,* 128 U. S. 525. Held: Where bill did not allege that the mark was used by defendant on goods intended to be transported to a foreign country, the Federal Court had no jurisdiction, and where proof of that fact was not presented the bill was dismissed. *Warner* v. *Searle & Hereth Co.,* 191 U. S., 195, to the same effect.

Corbin v. *Gould,* 133 U. S., 308: Held: That use and registration of the words "The Tycoon Tea" enclosed in a diamond shaped figure, "the essential features of which are the symbol of a diamond and the arbitrary selected word 'Tycoon'," conferred no exclusive right to the word "Tycoon" *simpliciter.*

A. Leschen Rope Co. v. *Broderick Co.,* 201 U. S., 166; Held: The use of a strand of rope painted red did not support the registration of a mark consisting "of a red or distinctively colored streak applied to or woven in a wire rope."

Ammon & Person v. *Narragansett Dairy Co.,* 252 Fed., 276; 262 Fed. (C. C. A.) 880. Held: That use of "Queen of the West" did not show the prerequisite statutory use to authorize the registration of "Queen", *simpliciter.*

Armour & Co. v. *Louisville Prov. Co.*, 283 Fed. (C. C. A.) 42, Held: That the use of "Armour's Star" was not adoption or use of "Star," and the registration of "Armour's Star" did not support a claim for infringement of "Star."

Diederich v. *Schneider Co.*, 195 Fed. (C. C. A.) 31. Held: That one acquires no right to register a trade-mark unless the mark is used on a vendable commodity and plaintiff can have no relief under the Registration Statutes unless the mark is placed by the defendant on a vendable commodity sold or intended to be sold in commerce among the States, foreign nations, or Indian tribes; *Warner* v. *Searle & Hereth Co.*, 191 U. S., 195.

Bronson v. *Duell*, 17 App. D. C., 471. Held: "The lawful right to convert a mark or symbol into a trade-mark was intended to remain a prerequisite to registration", and that the mark must be such a mark as could be lawfully exclusively appropriated.

The Trade-Mark Registration Provisions are not only statutory but arbitrary.

The possession of a technical trade-mark, good at common law, does not necessarily confer the privilege to register.

By the Trade-Mark Act, Congress Granted Power to Cancel Trade-Mark Registrations Exclusively to the Commissioner of Patents, Subject only to Review by the Court of Appeals of the District of Columbia.

Prior to the Trade-Mark Act of 1905, there was no provision for cancelling a trade-mark registration, and there was no direct review, judicial or administrative, by appeal or

otherwise, of decisions of the Commissioner of Patents upon matters relating to the registration of trade-marks. (*South Carolina* v. *Seymour,* 153 U. S. 353, 355).

No Court has ever assumed the right to cancel a trade-mark registration, except the Court of Appeals of the District of Columbia by the procedure expressly provided by the Trade-Mark Act itself.

The Trade-Mark Act of 1905 (33 Stat. 724 et seq.) provides for the cancellation of trade-mark registrations as follows:

> "Sec. 13. That whenever any person shall deem himself injured by the registration of a trade-mark in the Patent Office he may at any time apply to the Commissioner of Patents to cancel the registration thereof. The commissioner shall refer such application to the examiner in charge of interferences, who is empowered to hear and determine this question and who shall give notice thereof to the registrant. If it appear after a hearing before the examiner that the registrant was not entitled to the use of the mark at the date of his application for registration thereof, or that the mark is not used by the registrant, or has been abandoned, and the examiner shall so decide, the commissioner shall cancel the registration. Appeal may be taken to the commissioner in person from the decision of examiner of interferences."

By Sec. 9 of the Act, (33 Stat. 727) appeal may be taken from the Commissioner to the Court of Appeals of the District of Columbia.

The "use" referred to in the first condition has been repeatedly held "to mean the right of exclusive use." *Magic Curler Co.* v. *Porter,* C. D. 1907, 163.

In *Planten* v. *Gedney,* 224 Fed. (C. C. A.) 382, 384, 385, Judge Lacombe, writing for the Court of Appeals of the 2nd Circuit, respecting registrations improperly or improvidently granted, said of this cancellation Section:

"The remedy is full, fair and summary, with appeal from the Examiner to the Commissioner, and with no time limit for the application."

Section 22 (33 Stat. 729) of the Trade-Mark Act of 1905 provides for the cancellation of trade-mark registrations when there are *interfering registrations*, and reads as follows:

"Sec. 22.—That whenever there are interfering registered trade-marks, any person interested in any one of them may have relief against the interfering registrant, and all persons interested under him, by suit in equity against the registrant; and the Court, on notice to adverse parties and other due proceedings had according to the course of equity, may adjudge and declare either of the registrations void in whole or in part according to the interest of the parties in the trade-mark, and may order the certificate of registration to be delivered up to the Commissioner of Patents for cancellation."

This Sec. 22, applicable to trade-marks, corresponds to Section 4918 R. S., which provides, when there are *interfering patents*, that any person interested in any one of them may bring suit in equity for relief and the Court may adjudge and declare either of the patents void in whole or in part, or inoperative, or invalid, according to the interest of the parties in the invention patented.

The Trade-Mark Act fully provides for every case, both when the Commissioner wrongfully refuses to register a trade-mark, and when he erroneously grants registration.

No trade-mark registration has ever been cancelled under Sec. 4915 *R. S.; no patent has ever been cancelled under Sec.* 4915 *R. S.*

Except in the case of interfering patents, it is settled law that patents for inventions may be cancelled *only* by the

United States, and *only* under the general principles of equity, and this right is *solely* within the power of the United States. It has been settled that Sec. 4915 R. S. does *not* authorize an action to *cancel* a patent, even by the United States.

Mowry v. *Whitney, 14 Wall,* 434, 439;
United States v. *Bell Tel. Co.,* 128 U. S. 315, 368-370;
United States v. *Amer. Bell Tel. Co.,* 159 U. S. 548, 555;
Briggs v. *United Shoe Mach. Co.,* 239 U. S. 48.

In *United States* v. *Bell Tel. Co.,* 128 U. S. 315, 369, referring to *Mowry* v. *Whitney, supra,* and the right of a private citizen to prosecute an action to cancel a patent, the Court said:

> "It is true that what the Court was called upon to decide (in *Mowry* v. *Whitney*) was that a private citizen could not bring such suit, but evidently the reason given for it must be held to establish the principle upon which the Court acted, and that reason was that the private citizen could not do it because the right lay with the Government".

In *United States* v. *Am. Bell Tel. Co.,* 159 U. S., 458, this Court held that an action by the United States to *cancel* a patent was *not* a suit "arising under the patent law"; but that such an action must be prosecuted under the general principles of equity. *United States* v. *Bell Tel. Co.,* 128 U. S. 315, 359, 368-370.

To "interpret" Sec. 4915 R. S. as authorizing the action at bar, which is *to enjoin the cancellation of a trade-mark registration,* requires a rewriting of Section 4915 R. S., and the incorporation into the Section of both words and subject-matter entirely foreign to its present plain language; such an interpretation

"is not to be attained by striking out or disregarding words that are in the section, but by inserting those that are not there now. This is no part of our duty". (*Trade-Mark Cases,* 100 U. S. 82, 99; *Hill* v. *Wallace,* 259 U. S., 44, 71).

In *United States* v. *Temple,* 105 U. S., 97, 99, this Court said:

"When the language is plain, we have no right to insert words and phrases, so as to incorporate in the statute a new and distinct provision".

Bate Refrigerator Co. v. *Sulzberger,* 157 U. S. 136. *Conona Coal Co.* v. *United States,* O. T. 1923, No. 42.

In *United States* v. *First Nat. Bank,* 234 U. S. 245, 262, the Court said:

"The responsibility for the justice or wisdom of legislation rests with Congress, and it is the province of the Courts to enforce, not to make, the laws. *St. Louis Iron Mt. & S. Ry. Co.* v. *Taylor,* 210 U. S. 281, 294, 295; *Texas Cement Co.* v. *McCord,* 233 U. S., 157, 163".

As far as counsel has been able to discover, there has been only one decision which even touches the question at bar, *by any Court,* during the years since trade-marks have been registered, and that was in the recent case of *Loughran* v. *Quaker City Chocolate Co.,* 286 Fed. 694, (Feb. 15, 1923) in which the Court held that Sec. 4915 R. S. did *not* authorize an action to *cancel* a trade-mark registration, although it held that Sec. 4915 authorized an application to secure registration of a trade-mark. The Court said (p. 698):

"The other prayer for the cancellation of defendant's trade-mark, although reserved as a trial question, (same case 281 Fed. 23), was reserved with the plain intimation that this Court was without jurisdiction to interfere with the Patent Office disposition made of applications which had been granted.

"To this opinion we adhere, and this prayer should be denied. We do not regard *Baldwin* v. *Howard,* 256 U. S. 35; 41 Sup. Ct. 405; 65 L. ed. 816. as in conflict with this ruling, but on the contrary as in line with it."

It is respectfully submitted that *Atkins* v. *Moore,* 212 U. S. 285, and *Am. Steel Founderies* v. *Robertson,* 262 U. S. 209, have no application to the case at bar, because those cases have to do *solely* with *securing* the *registration* of a Trade-Mark, while the case at bar has to do with the *cancellation* of a registration; that is, to *enjoin* a cancellation.

If Sec. 4915 R. S. does not authorize an action to *cancel* a *patent,* much less can it be interpreted to authorize an action to *cancel* the *registration* of a mark; and much less still to authorize an action to *enjoin* the cancellation of a registration of a mark which the Court of Appeals of the District of Columbia has adjudged should be cancelled.

In *Westinghouse Elec. Mfg. Co.* v. *Ohio Brass Co.* 186 Fed. 518, 520, which was an action for a patent under Sec. 4915 R. S., the Court said:

"The right to retry the merits of an application for a patent, by bill in equity, * * * is purely statutory, and is subject to such restrictions as Congress may prescribe."

III.

The Supreme Court of the District of Columbia is without Authority of Law to Adjudicate upon the Subject-Matter of this Action.

The jurisdiction of the Supreme Court of the District of Columbia is challenged on the ground that it is *without cognizance of this case* or *of the class of cases* to which this case belongs; that it is without authority or power to hear and determine this cause or to adjudicate concerning the subject-

matter here involved (*Cooper* v. *Reynolds,* 10 Wall. 308, 316; *In re Sawyer,* 124 U. S. 200).

There is no *presumption* of jurisdiction where a Court, although it is one of general jurisdiction, is called upon to exercise *special statutory powers* (*Galpin* v. *Page,* 18 Wall. 350, 370-372), nor is there ever any *presumption* that Congress intended to provide a further review or a re-trial. (*Ferry* v. *United States,* 85 Fed. (C.C.A.) 550, 555).

> "Jurisdiction may be defined to be the right to adjudicate concerning the subject-matter in the given case. To constitute this there are three essentials: First, the Court must have cognizance of the class of cases to which the one to be adjudged belongs; second, the proper parties must be present; third, the point decided must be, in substance and effect, within the issue." *Reynolds* v. *Stockton,* 140 U. S., 254, 268.

Respondent contends that all provisions provided by Congress for the cancellation of trade-mark registrations are contained in Sections 13 and 9 of the Trade-Mark Act of 1905, and that *these provisions are exclusive,* whether regarded as judicial or administrative (except as provided by Section 22 of said Act which is applicable only when there are interfering registrations).

It is familiar doctrine that where a right, privilege or remedy is created by statute, the provisions therein provided by the statute govern, limit and control the right or remedy, and that the provisions thus provided by the statute are *exclusive. Wilder Mfg. Co.* v. *Corn Products Co.,* 236 U. S. 165, 174, 175, and cases cited.

By the Trade-Mark Act itself Congress regulated the whole subject of cancellation of trade-mark registrations, which was a subject-matter entirely within its control and discretion (*United States* v. *Bell Tel. Co.,* 167 U. S. 224; *United States* v. *Duell,* 172 U. S. 576, 589); the provisions which Congress

made are comprehensive; they embrace the whole subject; it is respectfully submitted that these provisions are exclusive.

It is plain that the cancellation provision "was a new remedy", provided as a part of the registration statute itself, "and as the mode of pursuing it was specially pointed out, that mode must be pursued", and that "the remedy thus prescribed is exclusive of all others".

Arnson v. *Murphy,* 109 U. S. 238;
Middletown Nat. Bank v. *Toledo A. A. & N. M. Ry,* 197 U. S. 394;
Cook County Bank v. *United States,* 107 U. S. 445, 451;
Jackson v. *Cravens,* 238 Fed. (C. C. A.) 117, 120.

In *Butterworth* v. *Hoe,* 112 U. S. 50, 63, which was a proceeding to mandamus the Commissioner to issue a patent, wherein this Court *denied* that the Secretary of the Interior had the right to review the decisions of the Commissioner, the Court said:

> "the principle applies that where a special proceeding is expressly ordained for a particular purpose it is presumably exclusive * * *
>
> (p. 64) "The true conclusion, therefore, is, that in matters of this description in which the action of the Commissioner is quasi-judicial, the fact that no appeal is expressly given to the Secretary is conclusive that none is to be implied".

In *Cook Co. Bank* vs. *United States,* 107 U. S. 445, 451, the Court said, referring to the National Banking Act:

> "A law embracing an entire subject, dealing with it in all its phases, may thus withdraw the subject from the operation of a general law as effectively as though, as to such subject, the general law were in terms repealed".

Jackson v. *Cravens,* 238 Fed. (C. C. A.) 117, 120, involved the granting of an injunction to restrain the enforcement of a State statute under Sec. 266 of the Judicial Code:

> "We think the contention of appellants also conflicts with the rule of construction that when a statute provides a new, specific, and complete remedy, and fully covers the subject-matter, the provisions of the statute will be looked to alone, and resort will not be had to prior existing general remedies as cumulative". (*Cumberland Tel. Co.* vs. *Louisiana Pub. Serv. Comm.,* 260 U. S. 212).

> *Brown* v. *United States,* 171 U. S. 631;
> *Laurel Oil Co.* v. *Morrison,* 212 U. S. 291;
> *Central Trust Co.* v. *Sneders,* 239 U. S. 11;
> *United States* v. *Chase,* 135 U. S. 255, 260;
> *Townsend* v. *Little,* 109 U. S. 504, 512.

In *Globe Newspaper Co.* v. *Walker,* 210 U. S. 356, 363, 367, an action for infringement of copyright of a map, a demurrer was sustained on the ground that the *copyright law gave no such action,* and dismissed the bill for want of jurisdiction; this Court affirmed, saying:

> "Congress not only created a new right in the copyright statute, but that the remedies therein given are the only ones open to those seeking the benefits of the statutory right thereby created. * * *
>
> "It thus appears that Congress has prescribed the remedies it intends to give, this being true, 'however inadequate,' as Lord Kenyon said in *Beckford* v. *Hood, supra,* 'no others can be resorted to'."

In *Hills & Co.* v. *Hoover,* 220 U. S. 329, 337, this Court said:

> "The copyright statutes of the United States afford all the relief to which a party is entitled, and no action outside of those provided therein will lie. *Globe Newspaper Co.* v. *Walker,* 210 U. S. 356".

In *Blumenstock Bros.* v. *Curtis Pub. Co.*, 252 U. S. 436, 440, 441, an action under the Sherman Anti-Trust Act which was dismissed for want of jurisdiction because the complaint failed to state a cause of action within the provisions of the Act, this Court, in affirming the dismissal, said:

> "In order to maintain a suit under this Act the complaint must state a substantial case arising thereunder. The action is wholly statutory, and can only be brought in a District Court of the United States, and it is essential to the jurisdiction of the Court in such cases that a substantial cause of action *within the statute* be set up".
>
> "In cases where, as here, the controversy concerns a subject-matter limited by federal law, for which recovery can be had only in the federal courts, the jurisdiction attaches only when the suit presents a substantial claim *under an Act of Congress.* This rule has been applied in bankruptcy cases (*Grant Shoe Co.* v. *Laird Co.*, 212 U. S. 445); in copyright cases (*Globe Newspaper Co.* v. *Walker*, 210 U. S. 356); in patent cases (*Healy* v. *Sea Gull Specialty Co.*, 237 U. S. 479); in Admiralty cases. (The Jefferson, 215 U. S. 130)". (Italics Ours)

Also, as to the Sherman Anti-Trust Act: *Geddes* vs. *Anaconda Mining Company*, 254 U. S. 590; *Paine Lumber Co.* vs. *Neal*, 244 U. S. 459, 471.

Also, "applied to establishment and government of National Banks as in a separate Code by itself, neither limited nor enlarged by other statutory provisions". *Cook County Bank* vs. *United States*, 107 U. S. 445, 451; also, *Farmers Nat. Bank* vs. *Dearing*, 91 U. S. 29, 33; *Barnett* vs. *Nat. Bank*, 98 U. S. 555, 558.

Also, under the Revenue Laws, *Arnson* vs. *Murphy*, 109 U. S. 238.

Also, as to Pension Laws, *United States* vs. *Black*, 128 U. S. 40 and cases cited.

Also, as to many provisions of the Public Land Laws. *Cameron* vs. *United States*, 252 U. S. 450; *Maxwell Land Grant case*, 121 U. S. 325, 380, and cases cited; Indian Land cases, *McKay* v. *Kalyton*, 204 U. S. 258.

Also, as to the immigration statutes, *Japanese Immigration case*, 189 U. S. 86, and cases cited.

Also, as to the postal laws, *United States* v. *Wright*, 11 Wall, 648; *Bates & Guild Co.* vs. *Payne*, 194 U. S. 106.

Also, as to the Interstate Commerce Act, *Croninger case*, 225 U. S. 491; *Louisville & Nashville R. R. Co.* v. *Rice*, 247 U. S. 201.

If the Trade-Mark Registration statutes are to be regarded as administrative provisions, the Courts have no jurisdiction to review their quasi-judicial decisions beyond what is *expressly* conferred by the Trade-Mark Acts themselves. *Keller* v. *Potomac Elec. Co.*, 261 U. S. 428, 443.

In *United States* vs. *Duell*, 172 U. S. 576, 588, 589, the plaintiff applied to mandamus the Commissioner to issue a patent to him after the Court of Appeals of the District of Columbia had decided against him in a patent interference case. Referring to *Butterworth* v. *Hoe*, 112 U. S. 50, the Court said:

> "We perceive no ground for overruling that case or dissenting from the reasoning of the opinion; and as the proceeding in the Court of Appeals on an appeal in an interference controversy presents all the features of a civil case, a plaintiff, a defendant and a Judge, and deals with a question judicial in its nature, in respect

of which the judgment of the Court is final so far as the particular action of the Patent Office is concerned, such judgment is none the less a judgment 'because its effect may be to aid an administrative or executive body in the performance of duties legally imposed upon it by Congress in execution of a power granted by the Constitution'. *Interstate Commerce Commission* vs. *Brimson*, 154 U. S. 147".

(p. 589) "By the Acts of 1839 and 1852 an appeal was given, not to the Circuit Court of the District of Columbia, but to the Chief Judge or one of the Assistant Judges thereof, who was thus called on to act as a special tribunal. The competency of Congress to make use of such an instrumentality or create such a tribunal in the attainment of the ends of the Patent Office seems never to have been questioned and we think could not have been successfully.

(p. 583) "it will be seen that from 1790 Congress has selected such instrumentalities, varying from time to time, and since 1870, has asserted the power to avail itself of the Courts of the District of Columbia in that connection. It follows that Congress may provide such instrumentalities as in its judgment would be best calculated to effect that object".

United States v. *Coe*, 155 U. S. 76.

Ness v. *Fisher*, 223 U. S. 683, 693, 694, was a petition for a mandamus to compel the Secretary of the Interior to accept an application to purchase public timberland, which application was refused because it failed to disclose that applicant had personally examined the land and had failed to state that it was unfit for cultivation. The rejection was based upon the construction of the Act of Congress governing the sale of such land (concerning which there had been different Court constructions) which required the statement to be verified by the oath of the applicant. The Court said:

"So, at the outset we are confronted with the question, not whether the decision of the Secretary was right or wrong, but whether a decision of that officer, made in the discharge of a duty imposed by law and involving the exercise of judgment and discretion, may be reviewed by mandamus, and he be compelled to retract it, and to give effect to another not his own and not having his approval." (The Court said this question had often been answered in the negative, citing cases; continuing, said):

"The Court could not entertain an appeal from the decision of one of the secretaries, nor revise his judgment in any case where the law authorized him to exercise discretion or judgment, nor can it by mandamus, act directly upon the officer, and guide and control his judgment or discretion in the matter committed to his care, in the ordinary discharge of his official duties. * * * Whether he decided right or wrong is not the question. * * *

"Nor does the fact that no writ of error will lie in such a case as this, by which to review the judgment of the Secretary, furnish any foundation for the claim that mandamus may therefore be awarded. The responsibility as well as the power rests with the Secretary, uncontrolled by the Courts".

Congress in numerous instances has provided for final termination by executive or administrative officers or quasi-judicial tribunals, and in such cases their decision, or the sufficiency of the evidence on which they act, cannot be reviewed by any Court unless expressly provided by statute. *Fong Yue Ting* v. *United States*, 149 U. S. 698, 714, 715 and cases cited.

In *Bates & Guild Co.* vs. *Payne*, 194 U. S. 106, 109, which was an action to enjoin the enforcement of an order denying classification of mail as second-class matter, this Court said:

"In the early case of *Decatur* v. *Paulding,* 14 Pet. 497, it was said that the official duties of the head of an executive department, whether imposed by Act of Congress or by resolution, are not merely ministerial duties; and as was said in the recent case of *Riverside Oil Co.* v. *Hitchcock,* 190 U. S. 316, 324: 'Whether he decided right or wrong is not the question. Having jurisdiction to decide at all, he had necessarily jurisdiction, and it was his duty to decide as he thought the law was, and the Courts have no power whatever under those circumstances to review his determination by mandamus or injunction'.

"In *Marquez* v. *Frisbie,* 101 U. S. 473, which was a bill in equity to review the decision of the Land Department in a preemption case, Mr. Justice Miller remarked (p. 476): 'This means, and it is a sound principle, that where there is a mixed question of law and fact, and the Court cannot so separate it as to show clearly where the mistake of law is, the decision of the tribunal to which the law had confided the matter is conclusive'.

"In *Gaines* v. *Thompson,* 7 Wall. 347, it was held that the Court would no more interfere by injunction than by mandamus to control the action of the head of a department; and in *United States ex rel. Dunlop* v. *Black,* 128 U. S. 40, it was said that the Courts will not interfere by mandamus with the executive officers of the Government in the exercise of their ordinary official duties, even when those duties require interpretation of the law, no appellate power being given them for that purpose. See also *Redfield* v. *Windham,* 137 U. S. 636."

In *United States* vs. *Wright,* 11 Wall. 648, 650, in an action under an act of Congress to allow extra compensation when approved by the Postmaster General, the Court said:

"It may be safely laid down, says Story, Judge, 'that where a particular authority is confided to a public officer

to be exercised by him in his discretion, upon an examination of facts, of which he is made the appropriate Judge, his decision upon the facts is, in the absence of any controlling provisions, absolutely conclusive as to the existence of those facts.'" Held: that the decision of the Postmaster General was not subject to review anywhere.

Questions of fact determined by an administrative or executive department of the Government, unless clearly wrong, is conclusive. *Japanese Immigration case,* 189 U. S. 86, 97, 98, and cases cited.

In *Murrys Lessee* v. *Hoboken Land Co.,* 18 How. 272, 284, (cited and quoted from, with approval, *United States* vs. *Duell,* 172 U. S., 576, 582, 583) the Court said:

"There are matters, involving public rights, which may be presented in such form that the judicial power is capable of acting on them, and which are susceptible of judicial determination, but which Congress may or may not bring within the cognizance of the Courts of the United States, as it may deem proper. * * * Thus it has been repeatedly decided in this class of cases that, upon the trial, the acts of executive officers, done under the authority of Congress, were conclusive, either upon particular facts involved in the inquiry or upon the whole title. *Foley* v. *Harrison,* 15 How. 433; *Burgess* v. *Gray,* 16 How. 48;———v. *The Minnesota Mining Company* at the present term.

"It is true, also, that even in a suit between private persons to try a question of private right, the action of the executive power, upon a matter committed to its determination by the Constitutional laws, is conclusive. *Luther* v. *Borden,* 7 How. 1; *Doe* v. *Braden,* 16 How, 635."

It is respectfully submitted that a cancellation adjudication is a case where Congress has expressly "confided to

a special tribunal the authority to hear and determine certain matters arising in the course of its duties, the decision of that tribunal, within the scope of its authority, is conclusive upon all others", it is clearly unassailable for mere errors of judgment.

The Court of Appeals of the District of Columbia has adjudged, after full review, that the two trade-mark registrations here involved should be cancelled. It is respectfully submitted that this statutory review is exclusive; that all review provided by Congress has been exhausted. Therefore, the decree below should be affirmed for want of jurisdiction of the trial Court.

IV.

Action at Bar was not Brought in Time.

This is a Jurisdictional Question.

If it be held that Section 4915 R. S. authorizes this action, it is respectfully submitted that the case at bar was not brought in time.

This is a jurisdictional question because it is a question of statutory power which goes directly to the jurisdiction of the Court limited, as it is, by the statutory provisions.

It has been settled by the decisions of this Court that an action under Sec. 4915 MUST BE BROUGHT WITHIN ONE YEAR from the date of the decision of the Court of Appeals of the District of Columbia in the Patent Office proceeding, unless excuse "to the satisfaction of the Court" is *pleaded* and *shown*. None is here pleaded.

The action at bar was not brought until more than *two years and two months* after the decision of the Court of Appeals of the District of Columbia in the Patent Office proceedings (Rec. pp. 11, 65).

Gandy v. *Marble,* 132 U. S. 432, was an action for a patent under Sec. 4915 R. S. after refusal by the Commissioner and the Supreme Court of the District of Columbia where the only question considered or decided was whether the action had been begun in time. *The Court dismissed the Complaint* holding that an action under Sec. 4915 R. S. is "in fact and necessarily a part of the application for a patent"; that such action is subject to the requirement of Sec. 4894 R. S.; that the action must be begun within two years (now one year) from the *decision* of the Court refusing the patent and by "otherwise complying with the requirements of law". The Court said (pp. 432, 439, 440):

> "One requirement of law is, by Sec. 4894, that the application shall be regarded as abandoned if the applicant fails to prosecute the same within two years after action therein of which notice shall have been given to him 'unless it be shown to the satisfaction of the Commissioner of Patents that such delay was unavoidable'. * * *
>
> "In the present case, there would be no compliance with the requirement of law, in view of the delay for more than two years, unless it be shown to the satisfaction of the Court that the delay was unavoidable. The jurisdiction of the application being transferred, *pro tanto,* to the Court, by virtue of the bill in equity, it cannot adjudge that the applicant is entitled, according to law, to receive a patent, unless he shows to the satisfaction of the Court that the delay was unavoidable, under an allegation to that effect in the bill." * * *
>
> "No excuse for the laches or delay is set up in the bill nor is it alleged that the delay was unavoidable."

This holding was repeated in *Butterworth* v. *Hoe,* 112 U. S. 50, and quoted with approval in *American Steel Foundries Co.* v. *Robertson,* 262 U. S. 209; any claim to the contrary would be without color of merit.

Coleman v. *American Mach. Co.*, 235 Fed. 531, 532, 537.
McKnight v. *Metal etc. Co.*, 128 Fed. 51.

In *American Steel Foundries* vs. *Robertson*, 262 U. S. 209, 212, 213, this Court cited *Gandy* v. *Marble, supra*, and said:

> "That Court dismissed the bill on the ground that the applicant had failed to prosecute his application within two years (now one year) after the dismissal of his appeal from the Commissioner by the Supreme Court of the District, basing it on Sec. 4894 of the Revised Statutes, reading as follows": (quoting the statute).

Sec. 4894 was amended by Act of March 3rd, 1897, Ch. 391, 29 Stat. 694, whereby the "two-year" period was reduced to one year.

In re Hien, 166 U. S. 432, 438, this Court said:

> "It was held (in *Gandy* v. *Marble, supra*) that the bill in equity (under Sec. 4915 R. S.) was *sub modo* a branch of the application for the patent and was governed by the rule as to laches and delay declared by Sec. 4894".

Sec. 4894 reads in part as follows:

> "upon failure of the applicant to prosecute the same within one year after any action therein, of which notice shall have been given to the applicant, they shall be regarded as abandoned by the parties thereto, unless it can be shown to the satisfaction of the Commissioner of Patents that such delay was unavoidable".

In *Westinghouse Elec. Co.* v. *Ohio Brass Co.*, 186 Fed. 518, where a bill in equity brought under Sec. 4915 for a patent was dismissed, because not brought in time, the Court said:

> "The failure of complainants to institute the present proceedings within one year after the last official action

on their application for Letters Patent, viz: the adverse decision of the Court of Appeals of the District of Columbia, is a bar to such proceedings". * * *

"The right to retry the merits of an application for a patent, by bill in equity, * * * is purely statutory, and is subject to such restrictions as Congress may prescribe.

In *McKnight* v. *Metals Co.,* 128 Fed. 51, there had been no action in the Patent Office after the decision of the Court of Appeals of the District of Columbia prior to bringing action under Sec. 4915 R. S.; this held to be immaterial "since the decision of the Court of Appeals is to govern further proceedings in the case, as provided by Section 4914." No case modifying or to the contrary has been found.

Sutton v. *Wentworth,* 247 Fed. (C. C. A.) 493, 502.

The decision, order and decree of the Court of Appeals of the District of Columbia in said Patent Office proceedings were made and entered March 3, 1919, (Rec. p. 65), and the bill of complaint at bar was filed May 7, 1921 (Rec. p. 11).

The appeals of the Baldwin Company to the Supreme Court of the United States, which were dismissed for want of jurisdiction and its applications for writs of certiorari which were denied (256 U. S. 35), cannot be held to have extended the time within which to file the bill of complaint at bar (*Westinghouse Elec. Co.* v. *Ohio Brass Co.,* 186 Fed. 518; *McMillan Contracting Co.* v. *Abernathy,* O. T. 1923, Nos. 167, 168; 68 L. ed. 210, 212). Obviously, a litigant, by choosing a wrong Court or a wrong remedy, cannot continue a litigation indefinitely when the statutes provide otherwise, as might be done if the time limit could be extended by selecting the wrong Court. If this could be done, the statute which limits the time would be a dead letter. (*Credit Co.* v. *Arkansas Cent. Rwy. Co.,* 128 U. S. 258, 261; *Conroy* v. *First National Bank,* 203 U. S. 141, 145; *Blaffer* v. *New Orleans*

Water Co., 160 Fed. (C. C. A.) 389). It is the date of the *decision* of the Court refusing the patent which is the controlling date (*Gandy* v. *Marble, supra*, pp. 439, 440).

In *Westinghouse Elec. Co.* v. *Ohio Brass Co.*, 186 Fed. 518, where proceedings for a patent under Sec. 4915 R. S. were first brought in the wrong district, and afterwards brought in the right district but not until more than one year had elapsed after the decision of the Court of Appeals of the District of Columbia, the Court dismissed the bill of complaint, and said:

> "Nor did the institution of proceedings within the year in the United States Circuit Court for the Western Division of the Northern District of Ohio satisfy the requirements of Sec. 4894. That requirement is to prosecute the application, and that presupposes that action be taken in the right tribunal and against the right party".

Mattullath Aeroplane Co. v. *Newton*, 1921 C. D. 103; 279 O. G. 730 (Supreme Court of District of Columbia, Gould, J., April 10, 1920), was an action under Section 4915 R. S., where the action was begun on February 23, 1918, and the *decision* of the Court of Appeals of the District of Columbia was rendered on February 5, 1917. Plaintiff's contention was "that by reason of having filed on February 21, 1917, a motion for reargument, which was denied on February 24, 1917, the year during which he might file his bill under Section 4915 did not begin to run until the latter date", that is, February 24, 1917, when the motion for reargument was denied. *In dismissing the complaint,* the Court said:

> "The contention of the plaintiff that the motion for reargument extended the time for appeal is answered by the decision of the Court of Appeals in *Ross* v. *Loewer* (9 App. D. C. 563) where it was held that a motion for rehearing does not suspend or extend the time for taking appeals from the Commissioner of Patents to that Court.

"In this case the patent was finally refused on February 5, 1917, by the Court of Appeals and this action not being brought within one year from that date as required by Section 4894, the motion to dismiss must be sustained". (See same case, 1921 C. D. 105 Hoehling, J., to same effect).

In *Colman* v. *American Co.*, 235 Fed. 531, 532, 537, the decision of the Court of Appeals of the District of Columbia was on June 3, 1913; the Supreme Court refused certiorari on Oct. 29, 1913; on February 24, 1914, the Commissioner gave to the applicant a formal notice that the case had been disposed of in accordance with the Court of Appeals' decision; the bill under Section 4915 was filed on Feb. 1, 1915. The Court held that the date of the decision of the Court of Appeals of the District of Columbia was the controlling date and that the formal notice by the Commissioner to the applicant on Feb. 24, 1914, was not the "action therein", which Sec. 4894 R. S. contemplated.

In re Hien, 166 U. S. 432, 438, 439, in adjudging that an appeal not taken in forty days to the Court of Appeals of the District of Columbia from a *decision* of the Commissioner of Patents was too late, the Court said:

"These proceedings, if they had been in time, amounted to the taking of an appeal, but as they were not initiated and prosecuted within the time limited they were ineffective".

When the time is limited by Act of Congress it is absolute when the right is strictly statutory. It is jurisdictional. (*The Bayonne*, 159 U. S. 687; *Stevens* vs. *Clark*, 62 Fed. (C. C. A.) 321; *Credit Company* vs. *Arkansas Cent. Rwy. Co.*, 128 U. S. 258).

In re McCall, 145 Fed. (C. C. A.) 898, 901, 902, which involved discharges under the Bankruptcy Act and appeals therefrom "within ten days after the judgment appealed from has been rendered", Lurton, J., said:

"The time limit upon the appeal from a judgment allowing or denying a discharge is 10 days and the language of the provision is 'that such appeal shall be taken *within ten days after the judgment appealed from has been rendered'*. The italics are ours (the Court's).

"Statutes which provide that writs of error or appeal shall be taken within a given time from the 'rendition' of the judgment or decree have been generally construed as stating the time limit from the date of the decision of the Court and not from the date of its subsequent entry in the Journal or signing by the Judge."

Rules or orders of the Courts do not enlarge the time limited by Acts of Congress, *Conroy* v. *First National Bank*, 203 U. S. 141, 145; *Credit Co.* v. *Arkansas Cent. Rwy.*, 128 U. S. 258; *United States* v. *Fidelity & Deposit Co.*, 155 Fed. (C. C. A.) 117.

In *Arnson* v. *Murphy*, 109 U. S. 238, 243, which was a suit to recover duties erroneously exacted, the Court held that Congress had regulated the matter

"by express statutory provision. And among them are the conditions which fix the time when the suit may begin, and prescribe the period at the end of which the right to sue shall cease. Congress having undertaken to regulate the whole subject, its legislation is necessarily exclusive".

The record at bar shows that the decision and decree of the Court of Appeals of the District of Columbia were made and entered March 3, 1919, (Rec. pp. 65, 66). The complaint in this action was filed May 7, 1921 (Rec. p. 11), more than two years and two months after the date of the decree in the Patent Office proceeding.

"Upon a writ of error, or appeal, the transcript from the records of the lower Court imparts absolute verity,

and it is not competent to contradict or extend the recital of the record by evidence dehors the record". *In re McCall,* 145 Fed. 898, 902.

As an action under Sec. 4915 R. S. is "a part of the application for a patent" (*Am. Steel Foundries Co.* v. *Robertson,* 262 U. S. 209) it is governed by the rules applicable thereto.

The time to take appeals from the Patent Office to the Court of Appeals of the District of Columbia (40 days) is strictly enforced (*Burton* v. *Bently,* 14 App. D. C. 471; *Ross* v. *Loewer,* 9 App. D. C. 563; *In re Hien,* 166 U. S. 432). Time is reckoned from the date of the *decision* of the Court of Appeals of the District of Columbia and *not* from the time that notice of the decision is sent to, or received by, the party against whom made (*Burton* v. *Bentley, supra*) and the running of the time is not suspended by filing a petition for a rehearing. (*Ross* v. *Loewer,* 9 App. D. C. 563).

V.

Jurisdiction is Wanting Because Appellant's Claim of Right and that it is being Deprived of Property "Without Due Process of Law" is Without Color of Merit.

Respondent contends that the claim set forth in the Complaint is so unsubstantial as to be plainly without color of merit, and for that reason jurisdiction is wanting.

In *Merriam Co.* v. *Syndicate Pub. Co.,* 237 U. S. 618, 621, an action for infringement of a registered trade-mark consisting of the personal name "Webster", it was held that if jurisdiction is invoked on a claim of right arising under the constitution or statute which is

> "unsubstantial and without real merit, either because of its frivolous character upon its face, or from the fact

that reliance was based upon a claim of Federal or statutory right denied by former adjudications of this Court, then the appeal to this Court must be dismissed".

Brolan v. *United States*, 236 U. S. 216;
de Bearn v. *Safe Deposit Co. of Baltimore*, 233 U. S. 24;
Equitable Life Ins. Co. v. *Brown*, 187 U. S. 308, 311, 315.

To determine appellant's constitutional claim that it is about to be deprived of property without due process of law, it is necessary to consider the nature and basis of appellant's claim of right, for if the claim is a mere allegation, without color of merit, the action should forthwith be dismissed for want of jurisdiction. *United States* v. *Am. Bell Co.*, 159 U. S. 546, 554. All constitutional rights depend upon what the facts are. (*Prentis* v. *Atlantic Coast Line*, 211 U. S. 210, 228).

Jurisdiction, as this Court has not infrequently said, must often be determined upon consideration of the nature of the case and the grounds upon which jurisdiction is invoked, and this Court may decide questions of merits so far as they bear upon the question of whether the trial Court has or had not jurisdiction.

Brown vs. *Lane*, 232 U. S. 598, 600;
St. Joseph & Grand Island Ry. Co. v. *Steele*, 167 U. S. 659, 662.

The bill of complaint, stripped of its surplusage, is reduced to a single claimed right, and that claimed right is the right to have a common personal name (Howard) registered as a trade-mark under the Trade-Mark Laws. As such a "right" has been repeatedly denied and positively foreclosed by this Court, such a claim obviously cannot be the basis for an injunction, or for any relief.

Howe Scale Co. v. *Wyckoff etc.*, 198 U. S. 118; *Merriam Co.* v. *Syndicate Pub. Co.*, 237 U. S. 618, and cases cited.

The matter in dispute is not the right to the name "Howard" as a name for a piano, but the "right" to have it registered.

> "But the only question we have, or can have, presently before us, is the right to register, 'not the value or worthlessness of what is registered' ". *Hercules Powder Co.* v. *Newton, Commissioner*, 266 Fed. (C. C. A.) 169, 171.

A suit based upon a claim which has been foreclosed is manifestly frivolous. *Equitable Life Ins. Co.* v. *Brown*, 187 U. S. 308, 311, 315.

The "ten-year" clause of Sec. 5 of the Trade-Mark Act of 1905 (33 Stat. 724 et. seq.) is not involved here because appellant does not claim use for the requisite ten-year period; appellant does not claim use prior to December 15, 1896. (Complaint, par. 3, Rec. p. 2).

A mark is not registrable unless its controlling or dominant features are registrable. A non-registrable name, word or term does not become registrable by combining it with registrable subject-matter; non-registrable matter must be disclaimed.

> *Beckwith* v. *Commissioner of Patents*, 252 U. S. 538, 541.

If the mark was incapable of exclusive appropriation when adopted, or when registered, the question of priority of use is immaterial. *The statutory prohibition relates back to the date of adoption.* (Sec. 1 and 2 of both Trade-Mark Acts).

Appellant's claim that "Howard" is Printed in a "Particular" or "Distinctive" Manner is Wholly Without Merit.

Nothing is added to the force or effect of appellant's contentions by its pretence that this personal name "Howard", as registered, is printed in a "particular and distinctive manner". The "particular or distinctive" proviso of Section 5 of the Trade-Mark Act of 1905 (c. 592, 33 Stat. 724 et seq.), on which appellant appears to rely, reads:

> "*Provided*, that no mark which consists merely in the name of an individual, firm, corporation, or association not written, printed, impressed or woven in some particular or distinctive manner, * * * shall be registered under the terms of this Act;"

What the First Registration Shows.

As all provisions respecting registration of trade-marks are statutory, it should be noted that this earlier registration was made under the Trade-Mark Act of 1881 (c. 138, 21 Stat. 502, et. seq.), which contained no provision for registering a mark printed in a "particular" or "distinctive" manner; such a registration was first authorized by the Trade-Mark Act of 1905.

Section 2 of the Trade-Mark Act of 1881 reads as follows:

> "Section 2.—That the application prescribed in the foregoing section must, in order to create any right whatever in favor of the party filing it, be, accompanied by a written declaration verified by the person, or by a member of a firm, or by an officer of a corporation applying, to the effect that such party has at the time a right to the use of the trademark sought to be registered, and that no other person, firm or corporation has the right to such use, either in the identical form or in any such near resemblance thereto as might be calculated to

deceive, that such trademark is used in commerce with foreign nations or Indian tribes, as above indicated, and that the description and fac-similes presented for registry truly represent the mark sought to be registered".

Thus, the Trade-Mark Act of 1881 expressly required, *as a prerequisite to a valid registration,* that the applicant must be the owner (Sec. 1),

> "That the application * * * must, in order to create any right whatever in favor of the party filing it, be accompanied by a written declaration verified * * * that such trademark is used in commerce with foreign nations or Indian tribes, as above indicated, and that the description and fac-similes presented for registry truly represent the mark sought to be registered".
>
> *Elgin Watch Co.* v. *Ill. Watchcase Co.,* 179 U. S. 665, 671.

The earlier registration (Rec. pp. 53-r, 53-s) contains the verified declaration and statement of applicant's president submitted to the Patent Office as the basis for registration, which set forth (Rec. p. 53-s) that the trade-mark

> "consists of the word 'Howard' in connection with the initials 'VGPCo.' in the form of a monogram".

and, continuing, stated:

> "the form of lettering of 'Howard' may be differently arranged without materially altering the character of the trade-mark, the principal feature of which is the word 'Howard' in connection with the initials 'VGPCo.' arranged monogrammatically".

It is respectfully submitted that this affidavit and statement of registrant's president, forming the basis for the registration itself, positively and conclusively controverts appellant's

claim that the name "Howard" was printed, claimed or registered in a "particular" or "distinctive" manner; in fact, the registration record itself renders such a claim positively without merit.

In *A. Leschen Rope Co.* v. *Broderick Co.*, 134 Fed. (C.C.A.) 571, 572, 573; 201 U. S. 166, 170, 171, the main questions involved were (1) What was adopted?; (2) Was what was adopted distinctive? All the Courts held that what was adopted was shown by what was declared in registrants' statement for registration, and not what they may have used, and held that what was declared was "too indefinite to be the subject of a valid trade-mark". The application to register (under Act of 1881) described the mark as consisting

> "of a red or distinctively colored streak applied to or woven in a wire rope".
>
> "The essential feature of the trade-mark is the streak of distinctive color produced in or applied to a wire rope". • • •
>
> "This mark is usually applied by painting one strand of the rope a distinctive color, usually red".

The drawing and the exhibits furnished showed one strand red.

The Circuit Court of Appeals (Circuit Judge Vandeventor sitting) quoted from *Smith* v. *Reynold*, 10 Blatch. 85, and said (p. 572):

> "Their registration must stand or fall as a whole, for that to which they declare in their registration they intend to appropriate". And at p. 573:
>
> "It is quite likely that they have confined themselves to a distinctive color of one of the several strands of the rope. This, however, is not the language in which their claim is embodied in the statement filed with the Commissioner of Patents, and the Court is compelled to look to that statement, rather than to the manufacture, for we are not dealing with a common-law trade-mark, based

upon use, but a trade-mark claimed and described in a written statement".

This Court (201 U. S. 166, 170, 171) unanimously affirmed the Courts below, using, in substance, their language, and said:

> "the trade-mark must stand or fall in its entirety, and if the description therein be too broad, it cannot be sustained by showing that defendant imitated its color and its method of applying it". It is the description "which would be answered by a streak of any color", which "was held by both Courts, and we think properly, too indefinite to be the subject of a valid trade-mark".

The Court's consideration is particularly requested to the *whole* of the masterly opinion in ***Ex parte Engelhard & Sons Co.***, 1904 C. D., 122, 124, 125, which was to register "Engelhard" printed on a cloud-bank in script letters "arranged on a line ascending from the left to the right, and a stroke, beginning at the letter 'd', drawn at an angle to the line on which the letters are arranged and terminating in a curve. * * * On the light side of the letters, a white border and on the shaded side a dark border is provided". Commissioner Allen said:

> "If the mere name printed in the ordinary way would create so nearly the impression created by the mark as to render the user of the mere name an infringer, then to protect this mark as a trade-mark would be to protect the mere name, to which the statute expressly refuses protection. If accessories are to save the mere name from the inhibition of the statute they must rise into such relative importance and must so dwarf the mere name as to render this latter of minor importance in the whole effect produced upon the mind of the observer and to prevent such result of infringement as just mentioned. In fact, it seems to me that a due regard to the spirit of

the statute requires the reduction of the name element in the mark to be carried so far that the name becomes a negligible or non-essential factor in the whole effect produced, so that if the rest of the mark should remain and the name should be changed it would not present a substantially different appearance". * * *

"It must be a rare case—one in which the elements are blended with unusual skill—when the name can be said to enter into the effect produced by the mark and not constitute a mere label upon it".

In *Ex parte Haines Knitting Co.*, 1913 C. D 205, Commissioner Moore cited *Ex parte Engelhard & Sons Co., supra,* and quoted with approval most of the above excerpt as applicable to the Trade-Mark Act of 1905.

As there was no direct review, judicial or administrative, by appeal or otherwise, of decisions of the Commissioner of Patents upon applications to register trade-marks under the Trade-Mark Act of 1881 (*So. Carolina* v. *Seymour,* 153 U. S. 353, 355) only opinions of the Commissioner can be cited.

What the second registration record shows.

The Record contains a photographic copy of the entire file of the Patent Office pertaining to the later registration. (Rec. pp. 53-a to 53-q).

Section 2 of the Trade-Mark Act of 1905 reads as follows:

"Sec. 2. That the application prescribed in the foregoing section, in order to create any right whatever in favor of the party filing it, must be accompanied by a written declaration verified by the applicant, or by a member of the firm or an officer of the corporation or association applying, to the effect that the applicant believes himself or the firm, corporation, or association in whose behalf he makes the application to be the owner of the trade-mark sought to be registered, and that no

other person, firm or corporation, or association, to the best of the applicant's knowledge and belief, has the right to use such trade-mark in the United States, either in the identical form or in such near resemblance thereto as might be calculated to deceive; that such trade-mark is used in commerce among the several States, or with foreign nations, or with Indian tribes, and that the description and drawing presented truly represent the trade-mark sought to be registered. * * *"

Thus, the Trade-Mark Act of 1905 also expressly requires, *as a prerequisite to a valid registration,* "in order to create any right whatever", that the applicant must be the owner, that the application must be accompanied by a verified declaration

"that such trade-mark is used in commerce among the several States, or with foreign nations, or with Indian tribes, and that the description and drawing presented truly represent the trade-mark sought to be registered."

In applying to register the later registration, appellant submitted as the basis for the registration the verified declaration and statement of its president which set forth the following (Rec. p. 53-a):

"The trade-mark sought to be protected * * * is shown in the accompanying drawing and consists of the arbitrary word 'Howard' in conjunction with the initials 'VGPCo.' in the form of a monogram".

and, continuing, stated:

"and the form of lettering of 'Howard' may be differently arranged without materially altering the character of the trade-mark, the principal feature of which is the word 'Howard'.

The drawing filed with this affidavit *was a fac-simile of the drawing of the earlier application,* and this drawing is repro-

duced on page 53-o of the record. Nothing could be more conclusive than this sworn statement of appellant's president to establish that the name "Howard" *was not adopted* or claimed to be printed in a "particular" or "distinctive" manner.

About two months after the application was filed, the drawing was changed to that which now appears in the registration, and during the same period the statement and description of the mark was changed and modified several times before it reached the form appearing in the registration, but *no new declaration was filed* and no proof whatever was offered to the Patent Office (as the Patent Office file shows) that the mark as shown in this later registration was ever used by appellant or any predecessor in business. Consequently, the registration was wholly unauthorized in law and was made in face of the positive prohibition of the Trade-Mark Act, as plainly appears from the application file itself. *Ex parte Newman*, C. D. 1910, 194; *Ex parte Felton, etc.*, C. D. 1910, 7. See also the following Patent Office Rules:

Rules 33 and 39 of the Patent Office governing the registration of Trade-Marks, effective April 1, 1905, read as follows:

> "33. Amendment of the declaration will not be permitted. If that filed with the application be faulty or defective, a substitute declaration must be filed".
>
> "39. The statement may be amended to correct informalities, or to avoid objections made by the office, or for other reasons arising in the course of examination, but no amendments to the description or drawing of the trade-mark will be permitted unless warranted by something in the specimens (or facsimiles) as originally filed".

Patent Office Rule 33 is now Rule 35 and Rule 39 is now Rule 41, but there has been no change in their language since their adoption April 1, 1905.

"Howard" in the Second Registration is not Printed in a "Particular" or "Distinctive" Manner.

The drawing of the second registration speaks for itself. Does it signify "Howard", is the name "Howard" the striking feature, or does it signify something "particular" or "distinctive"? What impression would it convey to the mind of the "ordinary observer", for "the law is not made for the protection of experts, but for the public,—the vast multitude which includes the ignorant, the unthinking and the credulous". (*Florence Mfg. Co.* v. *Dowd*, 178 Fed. (C.C.A.) 73). What will it signify to people in foreign countries? Does the form of the lettering make it the arbitrary sign of something else than the personal name "Howard"? If not, it is unregistrable.

Is it "particular" or "distinctive" in the sense that it could not "cause confusion" with "Howard" in script letters, for example, or, in fact, with "Howard" in almost any form of common lettering? If not, it is unregistrable.

A glance at the drawings of the two Registrations shows a different form of lettering of the name "Howard". Furthermore, a comparison of these marks with the marks reproduced on pages 42-d and 42-f of the record (which marks appellant claims to have used since 1912), shows further differences in the form of lettering of "Howard".

Now these four marks are all the same, and signify nothing except the personal name "Howard", or they are different.

If appellant claims that they are all the same, that the second Registration is the same as the first, and that the other two marks are not only like each other, but that both are the same as the two marks shown in the Registrations, it must follow that there is nothing of the "particular" or "distinctive" attained by the different forms of lettering used by appellant, in which case appellant would be claiming "Old English" in any style and every style if slightly twisted, flourished, curved or slanted, and some other trader could

claim "script", and some other "block" lettering, and so on.

But if appellant claims that the four marks are different, each from the others, then the mark in the second Registration is a different mark from that covered by the first Registration, and *the second Registration cannot be based upon the use of the mark in the first Registration.* Under such a claim, the other two marks are not only different from each other, but also different from both of the marks in the Registrations, and it follows that the two marks *not* registered might have been adopted and registered by other traders and would not interfere with appellant's Registrations; that is, if the contention is that all are different, all four marks are registrable as "particularly and distinctively" printed.

If four marks could thus be appropriated and registered, why not forty, or four hundred, for there are over one hundred "Howard" individuals listed in the Washington Telephone Directory and printers are easily found who could put a different twist to the lettering, or add a different flourish, curve, or slant, and no one of these marks would infringe any of the others or

> "be likely to cause confusion or mistake in the mind of the public". (Sec. 5, Trade-Mark Act of 1905).

In *A. Leschen Rope Co.* v. *Broderick Co.,* 134 Fed. (C. C. A.) 571, 572, 573, the Court held that if any color could be taken as a trade-mark it would be without value unless it could be varied, and

> "a right to vary the color indefinitely would destroy that distinctive character which must inhere in a valid trade-mark".

The same, in substance, was said by this Court, in the same case (201 U. S. 166, 170); it is respectfully submitted that *the same principle holds as to varying the lettering of "Howard".*

In the Equity Action, *The Baldwin Co.* v. *R. S. Howard Co.,* 233 Fed. 439, the Court referred to the hundreds of pianos

bearing the name "Howard" made and sold PRIOR to 1896, the date appellant claims that it or any of its predecessors first used "Howard", and the Court said (Rec. p. 47):

> "There is no doubt that from the time any variant of 'Howard' was inscribed upon pianos the retail trade, the user, and the public generally spoke of them as 'Howard' pianos."

In *Mansfield Tire Co.* v. *Ford Motor Co.*, 44 App. D. C. 205, 206, which involved an application to register "Ford", which applicant claimed was displayed in a "particular" and "distinctive" manner, the Court, affirming the Patent Office refusing registration, said:

> "Whether the word is to be written or printed in a peculiar manner is of no consequence, for however it is written, the letters will spell 'Ford' and the domain of the appellee will be encroached upon".

In *Oliver Plow Works* vs. *Wm. J. Oliver Mfg. Co.*, 40 App. D. C. 125, 128, 129, the opinion contained a reproduction of the mark which consisted of a large "O" in the center of which is a "V", on top and to the left of the "V" are the letters "li", to the bottom and to the right of the "V" are the letters "er", and over the top of the "O" is "The Wm. J." The registration was refused, the Court holding that the mark was not "particularly" or "distinctively" displayed within the meaning of the Trade-Mark Act, repeated previous rulings, and *formulated the test,* which has ever since been followed by that Court and other Courts, in the interpretation of the "particular" and "distinctive" proviso of Sec. 5 of the Trade-Mark Act of 1905, and said:

> "It is believed that the controlling principle underlying the requirement of the statute that a mere name unless written in a distinctive manner, may not be registered, is that the distinctive manner in which the name is displayed must be of a character as to give such a dis-

tinctive impression to the eye of the ordinary observer as to outweigh the significance of the mere name".

In *Johns-Manville Co.* v. *Am. Steam Packing Co.*, 33 App. D. C. 224, the mark was the word "Asbestos" printed in an embellished manner, the letters appearing as if formed of asbestos fiber; registration was refused, the Court saying:

"the predominating characteristics of appellant's mark is the same word (asbestos), merely in embellished letters. * * *

"The impression given one who sees it on the goods must be that they are to be identified by the word 'Asbestos', and not by the shape of the letters representing it". * * *

"Peculiarities in printing cannot lend trade-mark properties to an otherwise unregistrable descriptive word (or personal name). If it were otherwise, an unregistrable non-technical word could be appropriated and registered as a trade-mark as many times as the form of its printing could be varied".

In *Tinker* v. *Patterson Dental Supply Co.*, 287 Fed. 1014, the mark consisted of the name "Tinker", with a large "T" to the left of which were the letters "in" in much smaller letters and to the right of which were the letters "ker" in letters similar in size to those on the left, and was registered for a dental composition known as "Tinker's Gold" originally prepared by Dr. Tinker and donated to the dental profession. The Court held that the mark was not "particularly" or "distinctively" displayed, "it was not sufficiently distinguished", within the meaning of the Trade-Mark Act, and this registration was cancelled.

In *DuPont* v. *Ginter Co.*, C. D. 1921, 79, the mark sought to be registered "consists of the words 'DuPont' above a fanciful design resembling a coat-of-arms on which are the letters 'DP'." The registration was refused because

"it seems clear that 'the mark under consideration presents an appearance so little modified from the name used alone as to make the modification comparatively insignificant'. * * * it is admitted in the opposition papers that the opposer has not applied the mark to any goods; but under the clear words of Section 5 of the statute it would seem that the name is not registrable, irrespective of use. (Citing *Mansfield Tire & Rubber Co.* v. *Ford Motor Co.*, 44 App. D. C. 205, and *Ex parte A. Engelhard & Sons Co.*, 109 O. G. 1886; 1904 C. D. 122).

"It may be that applicant has the common law right to its mark, but it cannot be registered under the statute".

In re Artesian Mfg. Co., 37 App. D. C. 113, the mark consisted "of the words 'Deacon Brown' printed in script type, with a scroll extending across all of the letters except the 'D', and having the letters 'D' and 'B' connected across the top by two 'flourishes'." This mark was held *not registrable* as it was the name of an individual and not printed in a "particular" or "distinctive" manner within the meaning of the Trade-Mark Act.

In *Ex parte Pittsburgh Valve Foundry Co.*, C. D. 1907, 137, the mark consisted of the word "Atwood" associated with a large arrowhead and the letter "A"; held *not registrable* because "the name 'Atwood' is a predominating feature of the mark * * *. The association with the name, of the fanciful symbol is not considered sufficient to render the mark registrable as a whole".

In *Ex parte Mills & Gibbs*, C. D. 1913, 164, the mark consisted of the name "Longfellow, which is a name commonly found in City directories", written in script, arranged in a curved line and enclosed in quotation marks. The Commissioner said:

"Writing the mark in script type, in a curved line, and enclosing it in quotation marks is not such a par-

ticular or distinctive manner of displaying the same as would justify registration".

In *Morgan Drug Co.* v. *Palmer,* 13 T. M. Rep. 479 (Nov. 5/23) the mark was "Palmer" written in script, said to be in the handwriting of registrant (but not his signature). Held, registration should be cancelled on the ground that the mark is merely a name and is not written in a particular or distinctive manner.

In *Ex parte Kellogg Toasted Corn Flake Co.,* (5 T. M. Rep. 428) where "Kellogg" was printed in a so-called "emphasized signature" it was held not registrable although it may have been in the handwriting of an individual.

In *Dunlop & Co.* v. *The Jackson & Gutman Co.* (Jan. 9, 23) 13 T. M. Rep. 66, 67, the mark consisted of "Dunlop" in block type, printed so that there is a slight reduction in the height of the letters toward the middle of the word, surrounded by an outline of substantially upright ends, a downward curved top and upward curved bottom", claimed to be distinctively displayed. Held, not distinctively displayed, the Ass't Commissioner saying:

> "It seems clear that any reasonable interpretation of the language of the 1905 statute would preclude the registration of the present mark. To say that by placing a border of simple lines about a name removes it from being merely a name seems an unreasonable bending of common sense."

In *Ex parte The Rainier Co.,* C. D. 1907, 168, it was held that the word "Rainier" written in "large script letters with a flourish extending from the letter 'R' beneath certain letters of the word" is not such a distinctive display of the same as is required by the Trade-Mark Act.

In *Ex parte United States Brewing Company,* C. D. 1906, 437, it was held that a family name printed in script on a diagonal line, the letters being shaded so as to appear in per-

spective and with a paraph under the word, is *not* such a distinctive display as to justify registration.

In *Ex parte Alden Co.*, C. D. 1907, 423, the mark comprised the words "The Alden Shoe", enclosed within a circle together with some descriptive matter, the letters of the word "Alden" were

> "of different size, so that the word 'Alden' has the general form of an ellipse. The real question to be determined is this case is whether the word 'Alden' is printed in such a distinctive manner as to warrant registration under the provisions of Section 5 of the Act of 1905, above noted".

Registration was refused, the Court holding that

> "The peculiarities must dominate the mere name and reduce it to a position of relative obscurity".

In *Ex parte Churchill* v. *Alden Co.*, 120 Mis. Dec. 34, the mark consisted of the name "Farnam", the "F" of which was in large script, shaded, and the other letters in similar script shaded. Held: not distinctively displayed.

In *Ex parte O'Bannon Corporation*, 123 Mis. Dec. 82, May 25, 1917, the mark consisted of the name "O'Bannon" over and above the word "Moleskin", marking a general oval figure, with a heavy dash under the middle of the bottom word. This mark held not "distinctively" displayed and *registration refused.*

In *Ex parte Morton Samuels*, 121 Mis. Dec. 169, Dec. 6, 1916, the mark consisted of "New-ark" in large brush letters with the words "Save a Dollar" above in small light black letters. *Registration refused* as the mark was not "particularly" or "distinctively" displayed within the meaning of the Trade-Mark Act.

In *Ex parte Sunderland*, 120 Mis. Dec. 441, the mark consisted of the name "Fisher" in heavy round script. Held not "distinctively" displayed and *not registrable.*

In *Ex parte S. F. Bowser & Co.*, 117 Mis. Dec. 340, the mark consisted of the name "Bowser", the letters being connected at the top and bottom by a line, the letters being shorter at the end than in the middle. Held not "distinctively" displayed and *registration refused.*

In *Fairmount Mining Machine Co.*, 120 Misc. Dec. 388, the mark consisted of the word "Fairmount" displayed with the "F" and the "T" abnormally large and connected with a bar at the top. *Held: not registrable.*

In *Heath* v. *Wallace*, 138 U. S. 573, 582, the Court said:

> "the construction given to a statute by those charged with its execution of it is always entitled to the most respectful consideration, and ought not to be overruled without cogent reasons."

Bate Refrigerator Co. v. *Sulzberger*, 157 U. S. 136.
National Lead Co. v. *United States*, 252 U. S. 140.
United States v. *Hermanos & Co.*, 209 U. S. 337, 339.

The Fifth Amendment does not apply.

The Court of Appeals of the District of Columbia, (a "special tribunal entrusted with full power in the premises" (*Morgan* v. *Daniels*, 153 U. S. 120. 124), "a Court of high authority endowed with all machinery of Superior Courts of Jurisdiction" (*Greenwood* v. *Dover*, 194 Fed. (C. C. A.) 90, 94) has adjudged, after full review upon a record covering nearly three thousand pages, that the two registrations here involved should be cancelled. Every allegation made at bar was there made, urged and *determined.*

In *Ballard* v. *Hunter*, 204 U. S. 241, 255, this Court, in determining "due process", said:

> "Its fundamental requirement is an opportunity for a hearing and defense, but no fixed procedure is demanded. The process or proceeding may be adapted to the nature of the case. (cases cited) * * * and if found

to be suitable or admissible in the special case it will be adjudged to be 'due process of law', but if found to be arbitrary, oppressive and unjust it may be declared to be not 'due process of law', * * * Errors or irregularities in the suit do not take from it or its decree the attribute of due process". *Central Land Co.* v. *Laidley*, 159 U. S. 103, 112; *Iowa Central R. R. Co.* v. *Iowa*, 160 U. S. 389, 393.

Whether a property right is to be taken away without "due process of law" depends, at the outset, upon the existence of the property right and if it is obvious that no property right exists, the constitutional claim is a mere pretense and, in effect, no claim at all.

In *United Surety Co.* v. *Am. Fruit Co.*, 238 U. S. 140, the Court said, where

> "The constitutional point is a mere pretext put forward in order to open other questions that otherwise could not come here. That pretext is not allowed to succeed. *Goodrich* v. *Ferris*, 214 U. S. 71, 79".

A registrant cannot be deprived, in a legal sense, of the benefit of registrations, or be damaged by the cancellation of registrations, if the registration were unlawfully obtained or obtained without authority of law, as is self evident. A "right" which legally never existed cannot be taken away.

Something cannot be made out of nothing, and that which is void *ab initio* cannot be made the basis of a valid Constitutional claim.

There is no vested right, or vested right of property, in a Trade-Mark Registration. The registration of a Trade-Mark creates no new right or title.

Trade-Mark Cases, 100 U. S. 82, 92, 93;
Elgin Watch Co. v. *Illinois Watchcase Co.*, 179 U. S. 665;
United Drug Co. v. *Theo. Rectanus Co.*, 248 U. S. 90;
Merrian Co. v. *Syndicate Pub. Co.*, 237 U. S. 618;

Hanover Star Milling Co. v. *Metcalf*, 240 U. S. 403;
Stephano Bros. v. *Stamatopoulos*, 238 Fed. (C. C. A.) 89, 91;
Walders v. *International Mfg. Agency*, 237 Fed. (C. C. A.) 502, 506;
Aunt Jemima Mills Co. v. *Rigney*, 247 Fed. (C. C. A.) 407, 409.

Chief Justice Fuller, speaking for this Court in *Howe Scale Co.* v. *Wyckoff, Seamans & Benedict*, 198 U. S. 118, 134, said:

> "As the name 'Remington' is an ordinary family surname, it was manifestly incapable of exclusive appropriation as a valid trade-mark, and its registration as such could not in itself give it validity".

In *Elgin Watch Co.* v. *Illinois Watchcase Co.*, 179 U. S. 665, 672, this Court said:

> "the benefits of the Act cannot be availed of if the alleged trade-mark is not susceptible of exclusive ownership as such, and not, therefore, of registration".

In *Ex parte Edwin C. Burt Co.*, 1901 C. D. 108, wherein applicant and its predecessor had used "Burt" since 1860, Commissioner Moore in refusing registration said:

> "A technical trade-mark is essentially a vested right. A proper name is not a technical trade-mark for the very reason that in the nature of things it never was and never can be a vested right. It belongs equally to all persons bearing that name. This doctrine was as well settled prior to 1881 as it is at the present time".

In *United Drug Co.* v. *Rectanus Co.*, 248 U. S. 90, 97, this Court said:

> "It is not contended, nor is there ground for the contention, that registration of the Regis trade-mark under

either the Massachusetts statute or the Act of Congress, or both, had the effect of enlarging the rights of Mrs. Regis or of petitioner beyond what they would be under common-law principles."

In *Sarrazin* v. *Irby Cigar Co.*, 93 Fed. (C. C. A.) 624, 626-628, the Court said:

> "Secs. 10 and 11 of the Act (of 1881) make it as clear as possible that the Act does not in any manner 'prevent, lessen, impeach or avoid' any remedy or right, or 'unfavorably affect any claim to a mark' either before registry, after registry, or even after the term of registry has expired".
>
> "The registration of a trade-mark under this law adds nothing to the right of ownership therein and takes nothing away from such ownership."

The right of property in a trade-mark is gained by adoption and use and not by registration. If the trade-mark is *registrable* and registered, "the method of proof differs, the tribunal which passes upon the right may differ, and the form of relief may differ. The essential right, however, is the same". *Loughran* v. *Quaker City Chocolate Co.*, 286 Fed. 694, 698; *Columbia Mill Co.* v. *Alcorn*, 150 U. S. 460.

In *Given* v. *New York Athletic Club*, 42 App. D. C. 558, 559, the Court said:

> "In *Einstein* v. *Sawhill*, 2 App. D. C. 10, it was pointed out that the trade-mark Act creates no rights in the mark registered, but merely provides evidence of the ownership of the right. This we have repeatedly emphasized since."

Registration is a privilege for the encouragement of industry and is purely voluntary on both sides; there is no pledge or duty that the registration Act will not be repealed and it is subject to repeal at any time as is a tariff or drawback

provision for the protection of certain manufactures. It depends solely upon the discretion of Congress. *Salt Company* v. *East Saginaw,* 13 Wall. 373; *Welch* v. *Cook,* 97 U. S. 541; *Grand Lodge* v. *New Orleans,* 166 U. S. 143, 147, and cases cited.

As no vested right is created by the registration, no constitutional right can be impaired by its cancellation.

In *Kline* v. *Burke Const. Co.,* 260 U. S. 226, 234, the Court said:

> "A right which thus comes into existence only by virtue of an Act of Congress, and which may be withdrawn by an Act of Congress after its exercise has begun, cannot well be described as a constitutional right".

In *Excelsior Wooden Pipe Co.* v. *Pacific Bridge Co.,* 185 U. S. 282, 287, the Court said:

> "In *Robinson* v. *Anderson,* 121 U. S. 522, it was held that when it appeared, after all the pleadings were filed, that the averments in the declaration which alone gave the Court jurisdiction, were immaterial and made for the purpose of creating a case cognizable by the Court, it was the duty of the Circuit Court to dismiss the bill for want of jurisdiction".

In *Brown* v. *Lane,* 232 U. S. 598, 600, where jurisdiction was claimed because "involving the construction or application of the Constitution of the United States", this Court said:

> "But it is elementary that where the jurisdiction depends upon the presence of controversies of a particular character or the existence of prescribed questions or conditions, substance and not mere form is the test of power and therefore even in a case when the requisite for jurisdiction formally exists the right to review does not obtain when it is evident that the formal questions presented by the record are so wanting in substance as

to cause them to be frivolous and devoid of all merit. *Consolidated Turnpike Co.* v. *Norfolk &c. Ry Co.*, 228 U. S. 596, 600, and cases cited".

When the federal question is so unsubstantial as not to require argument, motion to affirm or dismiss should be granted. *Milheim* v. *Moffat Tunnel Dist.*, 262 U. S. 710, 716, 717.

Jurisdiction cannot be conferred by mere allegations or by argumentative statements. *Shulthis* v. *McDougal*, 225 U. S. 561, 569; *St. Joseph & Grand Island Ry. Co.* v. *Steele*, 167 U. S. 659, 662; *Hanford* v. *Davies*, 163 U. S. 273, 279; *Sarragen* v. *Irby Cigar & Tob. Co.*, 93 Fed. (C. C. A.) 624.

The claim that the Fifth Amendment to the Constitution is to be violated is obviously without merit.

VI.

Appellant's Claim Under the "Full Faith and Credit" Clause of the Constitution Is Wholly Without Merit.

This claim is made in par. 8 of the Complaint (Rec. p 6) on the ground that the Court of Appeals of the District of Columbia failed to give full faith and credit to the decree in a former Equity Action in the Second Circuit between the same parties.

The decree in that action is pleaded at bar and the Complaint contains several allegations respecting that Action (Complaint, pars. 7, 8, 10, Rec. pp. 4-8).

The record of said former Equity Action (*The Baldwin Co* vs. *R. S. Howard Co.*, 233 Fed. 439; 238 Fed. 154; 243 U. S 636) is a part of the records of this Court (No. 916 October Term 1916), and was included in the Cancellation record

submitted in support of the motion to dismiss the complaint at bar.

Said former Equity Action of *The Baldwin Company* vs. *R. S. Howard Company* involved three separate and distinct issues:

First issue in the Equity Action.

For infringement of the said two registered trade-marks, No. 31,411 and No. 46,993, at bar, praying for three-fold damages for their infringement. The Baldwin Company withdrew this issue at final hearing and there was no adjudication respecting it. The Court of Appeals, in its opinion, said (Rec. p. 53):

> "At the final hearing below, plaintiff did not claim infringement of its registrations and confined its charge of infringement solely to its common law right in the name 'Howard', * * *".

Second issue in the Equity Action.

To enjoin unfair trade competition based on appellant's common law right to the name "Howard" as a name for a piano. Both Courts based their decisions "solely to its common law rights", decreeing that the Baldwin Company had the right to use "Howard", *simpliciter,* as a name for its pianos, and that the R. S. Howard Company had the right to use "Howard" with the prefix "R. S." or "Robert S." and the suffix "Company" or "Co.", on its pianos and as its business and corporate name (Rec. pp. 4, 5).

It may be noted that in the decree (Rec. pp. 4, 5,) the word "mark" or "trade-mark" does *not* appear.

The Federal Courts have repeatedly held that decisions "confined solely to questions of unfair competition" are "a matter of no concern * * * either by way of estoppel or otherwise" in actions or proceedings relative to trade-mark regis-

trations. The case of *Hercules Powder Co.* v. *Newton, Commissioner,* 266 Fed. (C. C. A.) 169, and the many cases therein cited, thoroughly covers this point, the opinion in that case being written by the same Judge who decided the Baldwin-Howard former Equity Action in the District Court in New York.

The distinction is clearly shown in *Standard Paint Co.* v. *Trinidad Asphalt Co.,* 220 U. S. 446.

In *Hercules Powder Co.* v. *Newton, supra,* which was an action to register a trade-mark under Sec. 4915 R. S., the Court said (pp. 170, 171):

> "Plaintiff has, we think, sought to complicate the issue by pressing upon us as a fact proven beyond doubt, that dealers and buyers of powder do not associate 'Infallible' with that explosive except as indicative of its origin—'Infallible' means made by Hercules Co.
>
> * * *
>
> "The Commissioner cannot base approval or denial of application on an inquiry into the nature of petitioner's business, or a finding as to how the public regards the product thereof; he can but examine the article and the mark, and declare whether the statute prohibits their registered union.
>
> "Therefore, the evidence offered by plaintiff (as to its common law rights, for protection against unfair trade, the extent and value of its business or good-will, etc.) is immaterial, and we regard the case as presenting nothing but an inquiry as to the meaning of a statute".

In *Elgin Watch Co.* v. *Illinois Watchcase Co.,* 179 U. S. 665, 677, the distinction between an unfair trade action and an action for the infringement of a registered trade-mark is plainly shown; the Court said:

> "In the instance of a lawfully registered trade-mark, the fact of its use by another creates a cause of action. In the instance of the use in bad faith of a sign not in

itself susceptible of being a valid mark but so employed as to have acquired a secondary meaning, the whole matter lies *in pais.*

"It is to be observed, however, that the question we are considering is not whether this record makes out a case of false representation, or perfidious dealing or unfair competition, but whether appellant had the exclusive right to use the word 'Elgin' as against all the world. Was it a lawfully registered trademark?"

Lawrence Mfg. Co. v. *Tenn. Mfg. Co.*, 138 U. S. 537.

What was said in *Chapman* v. *Goodnow*, 123 U. S. 540, 548, applies to the decision of the Court of Appeals of the District of Columbia in the Cancellation proceedings, and positively and conclusively answers appellant's claim:

"The Court did not refuse to give faith and credit to the (unfair trade) decree (in the Equity Action), but it acted upon a new cause of action with which the decree had no legal connection".

Third issue in the Equity Action.

To enjoin the R. S. Howard Company from further prosecuting the then pending cancellation proceedings to cancel the two trade-mark registrations involved at bar, "or any other application for the cancellation" of said registrations. Appellant prayed:

"3. That said defendant (R. S. Howard Company), its officers, attorneys, agents, servants, clerks, employees, workmen and confederates and all persons claiming through or under them and all in privity with them and each and every of them, may be perpetually restrained and enjoined by an order of this Honorable Court as follows:

* * *

(c) From prosecuting or causing to be prosecuted in the United States Patent Office the pending applications or any other applications for the cancellation of your orator's trade-mark 'Howard' for pianos, Certificates of Registration No. 31,411, dated March 8, 1898, and No. 46,993, dated October 17, 1905". (Cancellation Record p. 2607; Eq. Rec. p. 15, 16).

Both Courts, in the Equity Action in the Second Circuit, *although expressly urged, denied the injunction,* the District Court saying (Rec. p. 50):

"I am inclined to think if this Court has the power, it is inadvisable to seek to prevent the continuance of the cancellation proceedings in the Office.

"It is plain to me that the object of these proceedings is primarily to get rid of something which constitutes an obstacle to the extension into certain foreign countries (e. g. Cuba and Uraguay) of the business of the R. S. Howard Company".

This was directly responsive to the prayer for relief.

This respondent contends, as claimed in its motion to dismiss (Rec. p. 66), that said adjudication in said former Equity Action between the same parties *is res adjudicata of the injunction issue which is the only issue and the whole contention involved in the case at bar,* and that this controversy, now and here, should be terminated by a dismissal of the bill of complaint.

In the recent case of *United Shoe Mach. Co.* vs. *United States,* 258 U. S. 451, this Court, after quoting from the masterly opinion in *Cromwell* vs. *County of Sac,* 94 U. S. 351, 352, said (p. 459):

"In other words, to determine the effect of a former judgment pleaded as an estoppel, two questions must be answered: (1) Was the former judgment rendered on the same cause of action? (2) If not, was some

matter litigated in the former suit determinative of the matter in controversy in the second suit?"

Appellant's former Equity Action had for its object the identical purpose and the identical result which it now seeks here. All material allegations, every material fact, condition and circumstance, at bar, were pleaded in the former Equity action, and the only subject matter added here are the Court proceedings which have since occurred, all of which are immaterial; besides, all have been adverse to this appellant. The demand for an injunction was made in the former Equity Action, the same injunction both in substance and effect as is demanded at bar, and this demand was distinctly put in issue, adjudicated and determined in the former Equity Action and the injunction denied. It is respectfully submitted that such determination constitutes a complete estoppel and absolute bar to the present action.

But if the action at bar is not the same cause of action as was involved in the former Equity Action, it is most respectfully submitted that the same facts, the same subject-matter, the same circumstances, the same conditions, and the prayer for the same relief, both in substance and effect, were in *controversy,* were *litigated* and were *determined* in the former suit. The decision in the former action was essential to and "determinative" of the injunctive issue, which was "the matter in controversy"; it is also "determinative of the matter in controversy" in the action at bar, which is the injunctive issue. There is complete identity, "(1) Identity in the thing sued for; (2) Identity of the cause of action; (3) Identity of persons and parties to the action" (*Lyon* v. *Penn & Gaff Mfg. Co.,* 125 U. S. 698, 700); "identity of the thing demanded, the identity of the cause of the demand, and of the parties in the character in which they are litigants" (*Washington Packet Co.* v. *Sickles,* 24 How. 333, 341); "1. by a Court of competent jurisdiction upon the same subject-

matter; 2. between the same parties; 3. for the same purpose;" (*Aspden* v. *Nixon*, 4 How. 466, 498).

Cromwell vs. *County of Sac.*, 94 U. S. 351, 352, 353;
Fayerweather v. *Ritch*, 195 U. S. 277;
New Orleans v. *Citizens Bank*, 167 U. S. 371, 396.

The opinions of the Courts in said former Equity Action may be referred to for the purpose of showing what was actually decided. The opinions of both Courts are a part of the record at bar (Rec. pp. 44-54). *Courtney* v. *Pradt*, 196 U. S. 89; *Carson* v. *Three States Lumber* Co., 142 Fed. 893; 149 Fed. (C. C. A.) 377.

VII.

On Appeal, Even from an Interlocutory Order, this Court May Direct the Complaint to be Dismissed.

In the action at bar no appeal would lie to this Court from a decree on the merits (*Chott* v. *Ewing* 237 U. S. 197; *Durham* v. *Seymour, Commissioner* 161 U. S. 235) which was the situation in *Denver* v. *New York Trust Co.* 229 U. S. 123, 133. Under such a situation this Court may consider all the grounds of the motion to dismiss.

In *Denver* v. *New York Trust Co., supra,* the Court said:

> "We come, then, to the objections made to the orders granting temporary injunctions and as these objections are addressed, not merely to the injunction, but to the merits of both the bill and the cross-bill, it is well to observe at the outset that our power of review like that of Circuit Court of Appeals is not confined to the act of granting the injunctions, but extends as well to determining whether there is any insuperable objection, in point of jurisdiction or merits, to the maintenance of

either bill, and if so, to directing a final decree dismissing it. *Smith* v. *Vulcan Iron Works,* 165 U. S. 518, 525; *Mass. Foos & Co.* v. *Stover Manufacturing Co.,* 177 U. S. 485, 494; *Harriman* v. *Northern Securities Co.,* 197 U. S. 244, 287; *United States Fidelity & Guaranty Co.* v. *Bray,* 225 U. S. 205, 214."

If it is apparent from the record that the injunction sought must be denied, the decree below dismissing the Complaint should be affirmed. (*Beasley* v. *Texas & Pac. Rwy Co.,* 191 U. S. 492, 498).

If this Court differs from the Court below on the question of jurisdiction, the failure of the Court below to consider the other grounds of the motion to dismiss the Complaint presents no reason why this Court should not consider the other grounds. (*Billings* v. *United States,* 232 U. S. 261, 276, 277; *McGowan* v. *Parish,* 237 U. S. 285, 291, 292; *Cole* v. *Ralph,* 252 U. S. 286).

VIII.

Whether or not the R. S. Howard Company is Damaged by the Registrations at Bar is Wholly Immaterial.

The Complaint, at bar, alleges that the R. S. Howard Company is not and cannot be damaged by said registrations and this is a reason alleged by appellant why the Cancellation Action should be re-tried under Sec. 4915 R. S.

It is respectfully submitted that whether or not the R. S. Howard Company is or may be damaged is wholly immaterial.

Unless the R. S. Howard Company's claim of damage in the Cancellation proceedings was frivolous, or a pretense, it gave the Court of Appeals of the District of Columbia juris-

diction; that it was not frivolous or a pretense is obvious on the face of the pleadings and decree.

The Fair v. *Kohler Die & Specialty Co.*, 228 U. S. 22, 24, 25;
Healy v. *Sea Gull Specialty Co.*, 237 U. S. 479.

If the Cancellation Action was an administrative proceeding and there was some evidence to support the decision, a decision "based upon some evidence to that effect would be conclusive and final, and not subject of review by any Court." (*School of Magnetic Healing* v. *McAnnulty*, 187 U. S. 94, 109.

It was not necessary for the R. S. Howard Company to establish damage; it was sufficient to show *probable* interference with its trade or business, or "to be likely to cause confusion or mistake in the mind of the public or to deceive purchasers." Both Trade-Mark Acts (Secs. 2, 3 and 5), by their terms, look to the future as well as the past.

However, if it be held that whether or not the R. S. Howard Company is or can be damaged by said registrations is material, it is respectfully submitted that it not only affirmatively appears in the Record that this fact has been adjudicated between the parties and fully established, but also that it affirmatively appears on the face of the Record, as a matter of law and fact.

Grounds of Damages to R. S. Howard Co.

The elements or grounds of injury and damage to the R. S. Howard Company may be summarized under the following six heads:

1. The Record shows that The Baldwin Company admits sending threatening and intimidating letters to respondent's customers, claiming rights under trade-marks "duly regis-

tered by us in the United States Patent Office," and "will take all necessary steps to protect our rights against infringement." Samples of these threatening and intimidating letters are set out in the Record pp. 43, 44, although no justifiable claim could be made that respondent was using appellant's style of lettering.

It is respectfully submitted that any use by The Baldwin Company of unlawful registrations which threatens damage is a continuing menace, injury and damage to respondent; that the direct and obvious purpose of the letters was to intimidate respondent's customers, threaten them with litigation, and cause them to cease to deal in respondent's pianos.

American Wells Works Co. v. *Layne & Bowler Co.*, 241 U. S. 257;

Panay Shaw Jar Co. v. *Oridor*, 292 Fed. (C. C. A.) 858, 859;

Racine Paper Goods Co. v. *Dittgen*, 171 Fed. (C. C. A.) 631;

Kidd v. *Horry*, 28 Fed. 773 (Mr. Justice Bradley);

Seattle Brewing Co. v. *Hansen*, 144 Fed. 1011 and cases cited.

2. The Baldwin Company's suit and threatened suits against respondent and respondent's customers for infringement of said registrations constitute a continuing threat of serious and permanent damage to respondent's business and an intimidation of its customers. The Trade-Mark statutes look to the future.

"The registration is itself a standing threat". *Denny Tag Co.* v. *Dennison Mfg. Co.*, 256 O. G. 221; aff. 48 App. D. C. 213.

Elgin Nat'l Watch Co. v. *Illinois Watchcase Co.*, 179 U. S. 665.

Suing or threatening to sue has been repeatedly held to be "injury" and "damage".

International Bedding Co. v. *Ostermoor & Co.*, (Feb. 13, 1923) 319 O. G. 235;
Familton v. *Alonzo Bliss Co.*, 1908 C. D. 189;
Hydraulic Brick Co. v. *Hocking Valley Products Co.*, 120 Ms. Dec. 196;
Needham Tire Co. v. *Hood Rubber Co.*, 124 Ms. Dec. 396.

If appellant's registrations are allowed to remain, it would give appellant opportunity to stir up litigation which is positively contrary not only to the purpose and spirit of equity but also to the statutory provisions of the Trade-Mark Acts.

Old Lexington Club D. Co. v. *Kentucky D. & W. Co.*, 234 Fed. 464, 469; aff. on Opinion below 247 Fed. 1005;
Crown Die & Tool Co. v. *Nye Tool Co.*, 202 U. S. 453, 458;
Electro Steel Co. v. *Lindenburg Steel Co.*, 43 App. D. C. 270.

If appellant's contentions at bar prevail, it would mean that by prostituting the forms of law it may obtain a record bearing the authority of the Government of the United States which can be used to respondent's damage and injury particularly in foreign countries.

To permit said registrations to remain of record is equivalent to ruling that The Baldwin Company has the *exclusive right* to the personal name "Howard" (*McIlhenny Sons* v. *Trappey*, 278 Fed. 562), and would, in substance, give to the personal name "Howard" "the full effect of a trade-mark while denying its validity as such", for a claim to a registered trade-mark is a claim "to appropriate the exclusive use of the term" (*Standard Paint Co.* v. *Trinidad Asphalt Co.*, 220 U. S., 446) either with or without accessory symbols or words. (*Thad Davids Co.* v. *Davids*, 233 U. S. 461

Walter Baker & Co. v. *Delapenha,* 160 Fed. 746, 750, and cases cited).

3. Respondent has been adjudged entitled to use "R. S. Howard Co." as its business and corporate name and so to mark its pianos (Rec. p. 5).

Pianos bearing the name "Howard" or any name of which the name "Howard" formed a part, have always been called "Howard" pianos by everybody, because "Howard" was the dominant feature of the name on the pianos. Prefixes and suffixes are entirely disregarded by the trade and public generally. (Judge Hough's opinion, Rec. p. 47); Mr. Steinway's testimony, Rec. p. 27; Mr. Dickinson's testimony, Rec. p. 34.)

> "It is the surname which catches the public, and few purchasers would notice the difference between one form and the other. In the nature of things confusion was inevitable." "Guth Chocolate Company" held to be an infringement and colorable imitation of "Guth". *Guth* vs. *Guth Chocolate Co.*, 224 Fed. (C. C. A.) 932.

"C. I. Davids Co.." and "Davids Mfg. Co." were held by this Court to be infringements of the registered mark "Davids", registered under the "ten-year" clause. This Court said:

> "The use of the name in this manner was a mere simulation of the complainant's mark which it duly registered; it constituted a 'colorable imitation' within the meaning of the Act. * * * We agree with the Circuit Court that infringement is shown". *Thad. Davids Co.* v. *Davids,* 233 U. S. 461, 469.

"William P. Stark Nurseries" held to infringe the registered trade-mark "Stark Trees". *William P. Stark* vs. *Stark Bros.*, 257 Fed. (C. C. A.) 9.

"Tucker" and "J. C. Tucker" held similar and confusing. *Brown-Forman Co.* v. *Beech Hill Dist. Co.*, 30 App. D. C. 485.

"Taylor", "Old Taylor", "G. A. Taylor", "Kentucky Taylor", are all held to be similar and confusing. *In re Wright*, 33 App. D. C. 510.

"Hoff" and "Leopold Hoff" held so similar as to create confusion. *In re Hoff*, 30 App. D. C. 233.

4. Said registrations being *prima facie* evidence of *exclusive* ownership of a *valid trade-mark* of the personal name "Howard", The Baldwin Company would *prima facie* be entitled to the exclusive use of "Howard" *in any form, and in every form*, whether used with or without prefixes or suffixes.

Thad. Davids Co. v. *Davids*, 233 U. S. 461;

Shredded Wheat Co. v. *Humphrey Cornell Co.*, 250 Fed. (C. C. A.) 960;

Elgin Nat'l Watch Co. v. *Illinois Watchcase Co.*, 179 U. S. 665.

5. Respondent is damaged by the registration of the personal name "Howard", the dominant feature of its corporate name.

As the Baldwin Company has no exclusive right to the personal name "Howard", damage and injury to respondent is implied and presumed, as a matter of law, by the improper registration of the dominant and distinguishing feature of respondent's corporate name. Respondent was incorporated in 1902, appellant did not make statutory use of "Howard" prior to 1912. (Sargent's testimony Rec. pp. 31, 32).

Mansfield Tire & Rubber Co. v. *Ford Motor Co.*, 44 App. D. C. 205;

Investor Pub. Co. v. *Dobinson*, 72 Fed. 603, 606, and cases cited.

6. Respondent is irreparably damaged in its foreign business by The Baldwin Company's foreign registrations of "Howard" which foreign registrations The Baldwin Company admits in its complaint (Rec. p. 8, par. 11) it has regis-

tered, basing such foreign registrations in some fifteen foreign countries on certified copies of said Registration No. 46,993 (Donegan's testimony, Rec. p. 30).

In refusing the injunction (same as now sought) in the former Equity Action between appellant and respondent, the Court said (Rec. p. 50):

> "It is plain to me that the object of these (Cancellation) proceedings is primarily to get rid of something which constitutes an obstacle to the extension into certain foreign countries (e. g. Cuba and Uruguay) of the business of the R. S. Howard Company."

The Record shows, without contradiction, that respondent since 1902 has been doing an extensive foreign business in a long list of foreign countries (Marken's testimony, Rec. p. 26; Stower's testimony, Rec. p. 26; Barber's testimony, Rec. p. 28). The undisputed testimony is that in most, if not all, Spanish speaking and South American countries infringement of a registered trade-mark is a criminal and penal offense, subjecting dealers to the penalty of fine and imprisonment and the goods bearing the infringing mark to confiscation (Stower's testimony, Rec. p. 26; Barber's testimony, Rec. p. 28); that in Spanish speaking countries the distinction between a trade-mark and a trade-name is not understood or not recognized; that this same confusion and failure to distinguish between a trade-mark and a trade-name is found in all countries; that "the timidity of dealers in the handling of goods, the trade-name or trade-mark on which is questioned, or is the subject of dispute, is very well recognized in all countries"; that in Spanish speaking and South American countries what may be considered a "similar" marking is quite indefinite and undeterminable, but that any mark bearing any dominant feature of a registered mark would probably be considered "similar" and an infringement, with little hope of securing from any Court the right to sell under a business or trade-name which in any degree bore resemblance to a registered trade-mark. (Barber's testimony, Rec. pp. 27-30).

There is no practical dsitinction between Trade-Marks and Trade-Names.

The distinction pointed out in some American and English decisions between a trade-name and a trade-mark is not generally recognized by dealers, the public or even by the Courts; even the American and English Court decisions are full of such confusion.

> "The terms 'trade-mark', 'trade-name' and 'technical trade-mark' are confused constantly, both in Court opinions and in the public press. This confusion is natural, and arises out of the manner in which the law of trade-marks has been developed in English and American jurisprudence * * * Much confusion exists due to the loose use to which it (the term 'Trade-mark') is constantly put in legal literature." *Nims, on Unfair Competition and Trade-Marks,* pp. 372-5 (2nd Ed).

IX.

The Decree Below Should be Affirmed on the Ground that, in Trade-Mark Cancellation Proceedings, Congress has made the Review by the Court of Appeals of the District of Columbia the Exclusive and Final Remedy; that Sec. 4915 R. S. does not Authorize the Action at Bar, and, even if it did, that this Action was not Brought Within the Statutory time;

or

The Decree Below Should be Affirmed on the Ground that Appellant's Claim is so Unsubstantial as to be Without Color of Merit.

SAMUEL S. WATSON,
Attorney for R. S. Howard Company.

FILED
MAY 14 1923
WM. R. STANSBU
CLE

IN THE

Supreme Court of the United States

OCTOBER TERM, 1922.

No. 918. 251

THE UNITED STATES OF AMERICA, *ex relatione*, THE BALDWIN COMPANY,

Appellant,

vs.

THOMAS E. ROBERTSON, as Commissioner of Patents, and R. S. HOWARD COMPANY, intervenor.

APPEAL FROM THE COURT OF APPEALS OF THE DISTRICT OF COLUMBIA.

MOTION TO AFFIRM OR DISMISS WITH BRIEF ON BEHALF OF R. S. HOWARD COMPANY.

SAMUEL S. WATSON,
Attorney for R. S. Howard Company,
2 Rector Street,
New York City, N. Y.

MOTION TO AFFIRM OR DISMISS.

Now comes the R. S. Howard Company, one of the above-named appellees, and moves for an order affirming the decree appealed from or dismissing the appeal.

The motion is based upon the allegations and admissions contained in the bill of complaint and the matters appearing of record of which the Court will take judicial notice, and upon the following specific grounds:

1. That the bill of complaint fails to state a cause of action, and is bad in substance;

2. That the Supreme Court of the District of Columbia is without power or authority to grant the relief prayed for, or any relief in the premises;

3. That all issues involved in the action at bar are *res adjudicata*, as a matter of law, as appears from the allegations and admissions contained in the bill of complaint and in the matters of record of which the Court will take judicial notice.

R. S. Howard Company,
By Samuel S. Watson,
Its Attorney.

To:

The Baldwin Company, John E. Cross, Esq., John Spaulding Flannery, Esq., Frederic D. McKenney, Esq.:

Please Take Notice that the undersigned will submit the foregoing motion to the Supreme Court of the United States on Monday, June 4, 1923, at twelve o'clock, noon, or as soon thereafter as counsel can be heard.

Samuel S. Watson,
Attorney for R. S. Howard Company.